(23,748)

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1914.

No. 194.

THE UNITED STATES *EX REL.* EDWARD L. CHOTT, PLAINTIFF IN ERROR,

vs.

THOMAS EWING, COMMISSIONER OF PATENTS, AND A. G. WILKINSON, PRIMARY EXAMINER, UNITED STATES PATENT OFFICE.

IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

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1 In the Court of Appeals of the District of Columbia.

No. 2536.

E. B. MOORE, Commissioner of Patents, et al., Appellants,
vs.
U. S. ex Rel. EDWARD L. CHOTT.

Supreme Court of the District of Columbia.

At Law. No. 55492.

UNITED STATES ex Rel. EDWARD L. CHOTT, Petitioner,
vs.
E. B. MOORE, Commissioner of Patents, and A. G. WILKINSON, Primary Examiner, United States Patent Office, Respondent.

UNITED STATES OF AMERICA,
District of Columbia, ss:

Be it remembered, that in the Supreme Court of the District of Columbia, at the City of Washington, in said District, at the times hereinafter mentioned, the following papers were filed and proceedings had, in the above-entitled cause, to wit:

Filed February 10, 1913.

In the Supreme Court of the District of Columbia.

At Law. 55492.

UNITED STATES ex Rel. EDWARD L. CHOTT
vs.
E. B. MOORE, Commissioner of Patents, and A. G. WILKINSON, Primary Examiner, United States Patent Office.

Petition for Mandamus.

To the Supreme Court of the District of Columbia:

Your petitioner, Edward L. Chott, respectfully represents:

1. That he is a citizen of the United States, and resides at Chicago, in the County of Cook and State of Illinois.

2. That prior to the 24th day of February, 1911 he was the true, original and first inventor and discoverer of certain new and
2 useful improvements in Dental Broach Holders, not known or used by others in this country and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, and not in public use or on sale in this country for more than two years prior to his hereinafter mentioned

application for Letters Patent therefor; and so being the true, original and first inventor thereof, he, on the said 24th day of February, 1911, filed in the United States Patent Office an application for Letters Patent of the United States for said invention.

3. That said application was made by your petitioner, in writing and addressed to the Commissioner of Patents in due form, as required by the statutes of the United States and by the Rules of Practice in the United States Patent Office in such case made and provided and with said application was filed by your petitioner a written description of his said invention, and of the manner and process of making, constructing, practicing and using the same, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which said invention appertains or with which it is most closely connected, to make, construct, practice and use the same; and in such written description the principle of your petitioner's said invention and the best mode in which your petitioner contemplated applying the same were explained; and your petitioner particularly pointed out and distinctly claimed in his said application the parts, improvements, and combinations which he claimed as his invention; and the specification and claims of said application were signed by your petitioner and attested by two witnesses.

4. That your petitioner did further furnish with said application drawings of his said invention signed by his attorney and attested by two witnesses.

5. That your petitioner did further make oath before a proper officer, according to law that he verily believed himself to be the original and first and sole inventor and discoverer of said invention for which he solicited a patent, that he did not know and did not believe that the same was ever known or used, and did state of what country he was a citizen.

6. That your petitioner at the time of the filing of his said application did pay to the said Commissioner of Patents, $15.00 the fee required by law and did in all other respects fully comply with the statutes of the United States and with the Rules of Practice in the United States Patent Office in such cases made and provided and the said application became known and designated as application Serial No. 610,571.

7. That said application contained and contains the following claims of invention to which your petitioner believes himself entitled, viz:

1. A dental broach handle consisting of two sections joined together by a comparatively weak union, substantially as described.

2. A dental broach handle having a reduced portion intermediate the ends thereof whereby said handle may be readily fractured at said reduced portion, substantially as described.

3 3. A dental broach handle comprising two integral cylindrical sections, the juncture of said sections being reduced in cross section, substantially as described.

4. A dental broach handle comprising two cylindrical metallic

sections in axial alignment with each other, and a reduced portion connecting said sections, substantially as described.

5. In a dental broach, the combination with a cylindrical metallic handle composed of two sections, a broach inserted in the end of one of said sections, and a reduced metallic portion connecting said sections and formed integral therewith, substantially as described.

6. A metallic dental broach handle of cylindrical form and having a circumferential groove intermediate the ends thereof, substantially as described.

7. A dental broach handle formed of comparatively brittle metal comprising a knurled cylindrical section and a co-axial plain cylindrical section, each formed integral with a connecting reduced portion provided in the handle, substantially as described.

8. An aluminium dental broach handle having a broach inserted in one end thereof, said handle being cylindrical in form and co-axial with said broach, and there being a V-shaped peripheral groove formed in said handle adjacent the center thereof, said handle being knurled adjacent said broach, substantially as described.

9. A metallic dental broach handle having a broach inserted in one end thereof, said handle being cylindrical in form and provided with a substantially V-shaped groove, the side of said groove adjacent said broach being substantially perpendicular to the periphery of said handle, substantially as described.

8. That on or about the 23rd day of August, 1911, the said A. G. Wilkinson, Primary Examiner, to which, according to law, your petioner's said application was referred by the Commissioner of Patents, for examination, examined and considered said application and finally rejected the same and notified your petitioner of said decision.

9. That on or about the 9th day of October, 1911, your petitioner feeling himself aggrieved by the decision of the Primary Examiner rejecting said application, appealed therefrom by written petition, to the Board of Examiners-in-Chief, in accordance with the statutes in such case made and provided and with the Rules of Practice in the United States Patent Office regulating such appeals and paid to the Commissioner of Patents, the statutory fee of $10.00 required for such appeal.

10. That on or about the 31st day of January 1912, the Board of Examiners-in-Chief in the Patent Office rendered a decision reversing the decision of the Primary Examiner.

11. That on or about the 21st day of February, 1912, the said A. G. Wilkinson, Primary Examiner, of his own motion, and without authority or jurisdiction, and contrary to the well established rules of practice of the Patent Office, reopened said application for further consideration by him and rejected the same.

12. That afterwards and on or about the 13th day of March,
4 1912, at the instigation of the said A. G. Wilkinson, Primary Examiner, and without legal authority, and contrary to the rules of practice of the United States Patent Office, the said E. B. Moore, Commissioner of Patents, took up said application for per-

sonal consideration and approved the action of the said A. G. Wilkinson, Primary Examiner.

13. That afterwards and on or about April 13th, 1912, your petitioner, petitioned the said E. B. Moore, Commissioner of Patents, and requested the said Commissioner of Patents, to command the said A. G. Wilkinson, the Primary Examiner in charge of petitioner's said application, to issue said patent to your petitioner, and at the same time paid to the said Commissioner of Patents, the final government fee of $20.00 as required for such issue.

14. And that afterwards, and on or about the 26th day of April, 1912, the said E. B. Moore, Commissioner of Patents, refused and declined to so command the said A. G. Wilkinson, Primary Examiner and rejected your petitioner's application over the protest and against the objection of your petitioner.

15. That, under the Rules of Practice of the United States Patent Office, it became and was the duty of the said A. G. Wilkinson, Primary Examiner, to allow your petitioner's said application, and to cause a patent to be issued therefore, and because of the refusal of the said A. G. Wilkinson, Primary Examiner so to do, your petitioner was and is deprived of a legal right vested in him by the laws of the United States relating to the granting of Letters Patent for inventions and is entirely without redress or remedy in the premises, unless this Honorable Court by writ of mandamus shall interpose in his behalf.

16. That under the Rules of Practice of the United States Patent Office, and the well established rules of law pertaining to such a case, it became and was the duty of the said E. B. Moore, Commissioner of Patents, to direct and command the said A. G. Wilkinson, Primary Examiner to allow your petitioner's said application, and to cause a patent to be issued therefore, and because of the refusal of the said E. B. Moore, Commissioner of Patents, so to do, your petitioner was and is deprived of a legal right vested in him by the laws of the United States relating to the granting of Letters Patent for inventions and is entirely without redress or remedy in the premises, unless this Honorable Court by writ of mandamus shall interpose in his behalf.

Wherefor- your petitioner prays that a writ of mandamus may be issued to the said E. B. Moore, Commissioner of Patents, and to the said A. G. Wilkinson, Primary Examiner in the United States Patent Office, commanding the said E. B. Moore, Commissioner of Patents, to cause a patent to be issued on your petitioner's said application and to direct and command the said A. G. Wilkinson, Primary Examiner to allow your petitioner's said application, and to cause a patent to be issued therefor, and to the said A. G. Wilkinson, Primary Examiner, commanding him to allow your petitioner's said application, and to cause a patent to be issued therefore.

5 And as in duty bound your petitioner will ever pray, etc.

EDWARD L. CHOTT, *Petitioner.*

JOSHUA R. H. POTTS,
Attorney for Petitioner.

55,492.

STATE OF ILLINOIS,
County of Cook, ss:

Edward L. Chott, being duly sworn, deposes and says, that he has read the foregoing petition, by him signed and knows the contents thereof; that the terms therein contained are true of his own knowledge except as, to those matters therein stated to be on information and belief and as to such matters he verily believes it to be true.

EDWARD L. CHOTT.

Subscribed and sworn to before me this 26th day of November, A. D. 1912.

[L. S.]

HELEN F. LILLIS,
Notary Public.

Rule to Show Cause.

Filed February 10, 1913.

* * * * * * *

Upon consideration of the Petition for Mandamus in the above entitled cause, it is ordered, on this 11th day of February, 1913, that the respondents herein show cause, on the 24 day of February, 1913, at ten o'clock a. m. before me at the special term of the court, why a writ of mandamus should not issue, as prayed in said petition; provided a copy of this order and of said petition be served upon the respondents on or before the 12th day of February, 1913.

JOB BARNARD,
Asso. Justice Supreme Court of the District of Columbia.

Marshal's Return.

Served copy of within rule to show cause together with copy of petition on E. B. Moore, Commissioner of Patents, and A. G. Wilkinson, Primary Examiner, United States Patent Office, personally, Feb'y 11, 1913.

AULICK PALMER, *Marshal,*
C. R. S.

6 *Answer to Rule to Show Cause.*

Filed February 24, 1913.

* * * * * * *

The Honorable the Judges of the Supreme Court of the District of Columbia:

The respondents, E. B. Moore, Commissioner of Patents, and A. G. Wilkinson, Primary Examiner, United States Patent Office, paragraph for paragraph, to the order to show cause why the writ of mandamus should not issue and in answer to relator's petition, say upon information and belief:

1. Concerning the allegations respecting the relator contained in this paragraph of the petition, respondents are not informed and can neither affirm nor deny the truth of the same.

2. Respondents admit the allegation in this paragraph that relator filed in the United States Patent Office on February 24, 1911, an application for letters patent of the United States for alleged new and useful improvements in dental broach holders.

Respondents deny the remaining allegations of this paragraph of the petition in the manner and form set forth therein, and assert that at the time relator filed his application some of the features embodied in certain claims of said application were well known in the art to which his device belongs, and that the other features of the claims were adapted for use in many situations, were old in other arts and were well known expedients. Respondents further assert that the device of relator's application is not broadly new with relator, that it did not involve invention, and that it is not patentable, for reasons fully set forth in the letter dated February 21, 1912, of A. G. Wilkinson, Primary Examiner, and in the decision of E. B. Moore, Commissioner, dated July 5, 1912, copies of which are annexed hereto and made a part hereof, and marked respectively, Respondents' Exhibits A and D.

Further answering the allegations of paragraph 2, respondents aver more specifically that the feature of a handle made in two sections joined together by a comparatively weak union, as applied to a dental broach holder, so far as they are informed had not been patented or described in any publication in this or any foreign country before relator's alleged invention thereof, that before the filing of relator's application this feature was a well known expedient in other arts, and that its application to dental broach holders did not involve invention. Whether the said specific application to dental broach holders was known or used by others in this country or was in public use or on sale in this country for more than two years prior to the filing of relator's application, respondents are not informed, and can neither affirm nor deny the same.

3. 4. 5. 6. 7. 8. 9. 10. Respondents admit that the allegations of paragraphs 3 to 10, inclusive, are true.

Further answering paragraph 10, respondents aver that the
7 examiners-in-chief reversed the primary examiner upon the ground that the references which had been cited by him were from non-a-*lagous* arts and that the claims were deemed allowable over the art cited.

11. Respondents deny the allegations of paragraph 11 and aver that the said A. G. Wilkinson, Primary Examiner, made an additional search, the result of which he embodied in a letter dated February 21, 1912, and that this action was made by him with the authority of the Commissioner, as shown by the said letter of the examiner and the decisions of the Commissioner dated March 13, 1912, and April 26, 1912, copies of which are annexed hereto and made a part thereof and marked, respectively, Respondents' Exhibits A, B, and C.

12. Respondents admit that the same E. B. Moore, Commissioner of Patents, took up the application for personal consideration and in his action dated March 13, 1912 (Respondents' Exhibit B), approved the action of the said A. G. Wilkinson, Primary Examiner, but deny that this was without legal authority and contrary to the rules of practice of the United States Patent Office, and further state that the case was taken up by the Commissioner upon reference by the primary examiner in view of applicant's communication filed March 4, 1912.

13. Respondents admit that the allegations of paragraph 13 are true. Respondents state that the $20 mentioned in this paragraph was filed by Joshua R. H. Potts, petitioner's attorney, and the amount has been placed to his credit and will be returned or applied to other cases, as requested by him.

14. Respondents admit the allegation of this paragraph, that on April 26, 1912, the said E. B. Moore, Commissioner of Patents refused and declined to command the said A. G. Wilkinson, Primary Examiner, to issue said patent to petitioner as requested in relator's petition, mentioned in paragraph 13, and denied said petition (Respondents' Exhibit C).

Respondents further aver that the Commissioner did not on April 26, 1912, finally reject the petitioner's application, but gave him notice that on May 8, 1912, at 10 o'clock, a. m., he would be heard upon the question of the patentability of the claims over the art of record; that pursuant to said notice relator waived oral argument but filed a brief and that in a decision rendered by the Commissioner on July 5, 1912, the claims were finally rejected and a patent refused; also, that in the Commissioner's decision of April 26, 1912, and July 5, 1912, applicant was informed that it was believed that he had an appeal direct to the Court of Appeals of the District of Columbia, and that such appeal should be taken within the time prescribed by the rules of that court, as fully appears from Respondents' Exhibits C and D.

15. Respondents deny the allegations of this paragraph and aver that it was the duty of the said A. G. Wilkinson, Primary Examiner, to follow the ruling of the Commissioner of Patents in this matter, and that petitioner had a remedy by direct appeal from the decision of the Commissioner of Patents, as fully set forth in paragraph 16 of respondents' answer.

8 16. Respondents deny the allegations of this paragraph. Respondents aver that Section 481 of the Revised Statutes provides:

The Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office.

Respondents further aver that under the above statute and also Sections 483, 4883 and 4893, the Commissioner is the head of the Patent Office and is responsible for and must sign all patents issued by that bureau, and that if there be any ground within the knowl-

edge or cognizance of the Commissioner why a patent should not issue, it is the duty to refuse the patent whether or not the specific objection has been raised and acted upon by the lower tribunals and irrespective of their holding. Respondents aver that in view of the conclusion of the Commissioner of Patents that the alleged invention of relator was not new and patentable for the reasons set forth in his decisions, it was his duty to reject the claims and to refuse a patent.

Respondents further aver that petitioner was not without redress or remedy except by writ of mandamus, as alleged in this paragraph and also in paragraph 15, but that, as pointed out in the Commissioner's decisions dated April 26, 1912, and July 5, 1912 (Respondents' Exhibits C and D), he had a direct appeal from the decision of the Commissioner denying him a patent to the Court of Appeals of the District of Columbia under Section 9 of the Act of February 9, 1893, 27 Stats. L. 434, creating said Court of Appeals; also that he had a further remedy by bill in equity under the provisions of Section 4915 of the Revised Statutes.

And for further answer respondents show that the question of whether a patent shall issue, under the law, is one within the discretion of the Commissioner of Patents subject to a direct appeal to the Court of Appeals of the District of Columbia; that in the present case the Commissioner has not refused to act thereon; but, on the contrary, he has acted to the best of his judgment and fully set forth in his decision the reasons for his action, from which action relator had a right to appeal directly to the Court of Appeals of the District of Columbia; and that under these circumstances a writ of mandamus will not lie to review and control his action.

Respondents in further answer to the rule to show cause aver that under the ruling of this court in U. S. ex rel. Hodgins v. Simpson, 82 O. G., 1898 C. D., 296, and inasmuch as the Commissioner of Patents is the responsible head of the Patent Office through whom, if through any one, the relief prayed for should be obtained, while the said A. G. Wilkinson is a primary examiner in the Patent Office and subordinate to and subject to the official control and direction of the Commissioner of Patents, the said A. G. Wilkinson improperly has been made a party respondent and that for this reason, in addition to those heretofore mentioned, the rule to show cause should be discharged and the petition dismissed as to him.

9 And, now having fully answered the said petition, respondents pray that the rule to show cause issued against them be discharged and that respondents be hence dismissed with their reasonable costs.

E. B. MOORE,
Commissioner of Patents.
A. G. WILKINSON,
Primary Examiner.

W. S. RUCKMAN, *Attorney.*

DISTRICT OF COLUMBIA, *ss:*

I, E. B. Moore, being first duly sworn, on oath, depose and say that I am the Commissioner of Patents; that I have read the foregoing answer by me subscribed and know the contents thereof; that the matters and things therein stated of my own knowledge are true and those stated on information and belief I believe to be true.

E. B. MOORE.

Subscribed and sworn to before me this 20th day of February, 1913.

[SEAL.]

WILLIAM OSBORN,
Notary Public in and for D. C.

STATE OF NEW JERSEY,
Atlantic City and County, ss:

I, A. G. Wilkinson, being first duly sworn, on oath, depose and say that I am a Primary Examiner in the United States Patent Office; that I have read the foregoing answer by me subscribed and know the contents thereof; that the matters and things therein stated of my own knowledge are true, and those stated on information and belief I believe to be true.

A. G. WILKINSON.

Subscribed and sworn to before me this 21st day of February, 1913.

[SEAL.]

JOHN STILLE,
Notary Public.

(Com. ex. Sept. 5, 1916.)

RESPONDENTS' EXHIBIT A.

Filed February 24, 1913.

Div. 20, Room 179.

Address only "The Commissioner of Patents, Washington, D. C."

Paper No. 16.

All communications respecting this application should be given the serial number, date of filing, and title of invention.

10 A. G. W. C. H.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, February 21, 1912.
Mailed " " "

Edward L. Chott, c/o Joshua R. H. Potts, Chicago, Illinois:

Please find below a communication from the Examiner in charge of your application for Dental Broach Holders, filed Feb. 24, 1911, Serial No. 610,571.

E. B. MOORE,
Commissioner of Patents.

This application was appealed to the Board of Examiners-in-Chief who decided that the nine claims of applicant were allowable. The examiner relying upon the well known principle in law that even an appellate tribunal can take knowledge of matters of common knowledge, did not as fully as he should have done, furnish references showing how common was the expedient of filing or cutting a groove in any and all sorts of articles, forgetting that matters of common knowledge to one person may not be so as to another.

By direction of the Honorable Commissioner of Patents the Examiner has made additional and prolonged search for instances of the use of the common workshop expedient in question, in, if possible, a closely analogous art.

The following patents cited below show how very common it is to make use of the old expedient of a groove, cut, or file mark to assist in separating two parts of an article. No claim, however, seems to have been allowed for this expedient per se, but only combined with some structural change in the article to be divided. There is no semblance of any structural change in the well known dental broach.

Patents Nos. 99,955 } Class 120, Sub. 83.
555,341 }

159,015 } Class 85, Sub. 17.
200,839 }

190,575 }
188,355 }
243,602 } Class 85, Sub. 18.
315,070 }

182,140 Class 59, Sub. 62.

Presumably it is a matter of common knowledge that a dentist in using such broaches in his own mouth, never inserts the handle,
11 short or long, in the mouth and it would make no difference whether it was short or fully as long as an ordinary wooden lead pencil when held in the hand of the dentist. Also in the matter of using the same broach in different mouths, &c., each instrument after use is dropped in liquid anticeptic receptacles before a second use and such receptacle will be seen on nearly every careful dentist's bracket.

The Examiner would also consider that it is a matter of common knowledge that gas fitters can be commonly seen shortening a long gas pipe to get a short piece for use by means of making the circumferential groove like applicant's and then breaking off the part needed.

Also that in most large steel works, samples of steel are in a single long straight piece with "weak unions" made by "means of a re-

duced portion." If the Examiner is wrong in this he will be set right by the Honorable Board of Appeals.

Attention is called to patent to Schultz, Nov. 7, 1899, 636,359,—Fig. 6 of his drawing, simply to show how broaches and drills are usually used with handle outside the mouth. Whether this handle be a little longer or shorter is thought to be a matter of indifference.

Some weight seems to have been given (in claims 7 and 8) to a part of the handle being knurled. The Examiner did not take this matter as seriously as he ought, knowing personally that an unknurled tool used in the mouth by a dentist is the exception rather than the rule.

He should have called attention to the patents of E. M. Fredericks, Sept. 15, 1896, 567,589, Dentistry, Tools, and Ivory, Oct. 10, 1899, 634,732, Dentistry, Tools.

If the Taylor patent of 1889, cited in this case, were now before the present Examiner he would reject claims 4 and 5. It is more common to insert the broach in the end of the handle than to have the two parts integral. See applicant's claim 5. See also patent of Donaldson, Apr. 2, 1878, 202,006, Dentistry, Tools.

A. G. WILKINSON,
Examiner, Duv. 20.

RESPONDENTS' EXHIBIT B.

Filed February 24, 1913.

S. M. B.

Serial No. 610,571, Paper No. 19.

Recorded, Vol. 104, Page 462.

In the United States Patent Office.

Ex Parte EDWARD L. CHOTT.

Application for Patent.

Reference.

Dental Broach Holders.

Application filed February 24, 1911, No. 610,571.

Mr. Joshua R. H. Potts for Applicant.

This case has been referred to me by the primary examiner in view of a communication by the applicant filed March 4, 1912, in
12 which attention is directed to Rule 142, it being urged that under this rule the examiner has no authority to reopen a case without the consent of the Commissioner upon a showing of suffi-

cient cause, and arguing that the letter of the examiner dated February 21, 1912, rejecting the claims in view of certain patents, was therefore improper.

It appears from the record that appeal was taken to the board of Examiners-in-chief from the rejection of this application. The examiners-in-chief reversed the decision of the examiner upon the ground that the references cited were from a nonanalogous art. The examiner thereupon made a further search and rejected the claims upon other references and reasons.

In view of the fact that the decision of the examiners-in-chief was based wholly upon the ground that the references originally cited were not found in an analogous art, I am of the opinion that the action of the examiner in making a further search in the art was justified and his action reopening the case for the purpose of introducing additional references is accordingly approved.

E. B. MOORE,
Commissioner.

March 13, 1912.

RESPONDENTS' EXHIBIT C.

Filed February 24, 1913.

S. M. B.

Serial No. 610,571, Paper No. 22.

Recorded, Vol. 105, Page 195.

In the United States Patent Office.

Ex Parte EDWARD L. CHOTT.

Application for Patent.

Petition.

Dental Broach Holders.

Application filed February 24, 1911, No. 610,571.

Mr. Joshua R. H. Potts for Applicant.

The applicant in this case has petitioned the Commissioner to direct the primary examiner to pass the case to issue in view of the decision of the examiners-in-chief herein of record to the effect that the claims are patentable.

13 This case has been taken up under the supervisory authority of the Commissioner for personal consideration and the additional search for prior art evidenced by the examiner's letter

of February 21, 1912, was made upon the authority of the Commissioner and approved by me on March 13, 1912. Such approval was made of record in response to applicant's communications of March 2 and March 4, 1912, and under the impression that the examiner has specifically held that the claims were unpatentable.

It is well settled that the Commissioner has authority to review a case personally and withhold a patent ever after a favorable decision by the examiner or the examiners-in-chief. (Hull v. Commissioner of Patents, 2 McArthur 90 & 125.) The Court of Appeals of the District of Columbia is on record as holding this view, in the case of Drawbaugh v. Seymour, Com. of Pats., 77 O. G., 313, 9 App. D. C., 219, in which it is stated:

"The Commissioner is the head of the Bureau, and he is responsible for the general issue of that Bureau. If, therefore, there may be any substantial, reasonable ground, within the knowledge or cognizance of the Commissioner, why the patent should not issue, whether the specific objection be raised and acted upon by the Examiners or not, it is his duty to refuse the patent."

Commissioner Duell in the case of Anderson and Dyer v. Lowry, 89 O. G., 1861, fully discussed the question and considered the authorities and arrived at the same conclusion. Commissioner Simonds made a similar statement in the case of ex parte Strong, 57 O. G., 274.

In the petition it is stated that a reconsideration of the Commissioner's ruling is requested for the reason that applicant has never been heard by the Commissioner in the matter. If the applicant desires a hearing upon the patentability of the claim over the art now of record, before the case is finally disposed of by me, he will be given such hearing on May 8, 1912, at 10 o'clock a. m. At that time applicant may appear and argue the case orally or file a brief, or both, as he may desire. If no appearance is made the case will be disposed of on the record. In view of the holding of the Court of Appeals in the case of Moore, Com. of Pats., v. Heany, 149 O. G., 831, 34 App. D. C., 31, it is believed that applicant will have an appeal direct to that court in case of an adverse decision.

The petition is denied.

E. B. MOORE,
Commissioner.

April 26, 1912.

14 RESPONDENTS' EXHIBIT D.

Recorded, Vol. 106, Page 85.

Serial No. 610,571, Paper No. 26.

S. E. T.

In the United States Patent Office.

Ex Parte EDWARD L. CHOTT.

Application for Patent.

Dental Broach Holders.

Application filed February 24, 1911, No. 610,571.

Mr. Joshua R. H. Potts for applicant.

This case has been taken up by me for personal consideration of the merits of the alleged invention claimed. A day of hearing was set at which applicant might be heard upon the question of patentability, but he waived an oral hearing and filed a brief discussing only the jurisdiction of the Commissioner.

The claims in the case which have been found allowable by the examiners-in-chief are as follows:

1. A dental broach handle consisting of two sections joined together by a comparatively weak union, substantially as described.

2. A dental broach handle having a reduced portion intermediate the ends thereof whereby said handle may be readily fractured at said reduced portion, substantially as described.

3. A dental broach handle comprising two integral cylindrical sections, the juncture of said sections being reduced in cross section, substantially as described.

4. A dental broach handle comprising two cylindrical metallic sections in axial alignment with each other, and a reduced portion connecting said sections, substantially as described.

5. In a dental broach, the combination with a cylindrical metallic handle composed of two sections, a broach inserted in the end of one of said sections, and a reduced metallic portion connecting said sections and formed integral therewith, substantially as described.

6. A metallic dental broach handle of cylindrical form and having a circumferential groove intermediate the ends thereof, substantially as described.

7. A dental broach handle formed of comparatively brittle metal comprising a knurled cylindrical section and a co-axial plain cylindrical section, each formed integral with a connecting reduced portion provided in the handle, substantially as described.

8. An aluminium dental broach handle having a broach inserted

in one end thereof, said handle being cylindrical in form and co-axial with said broach, and there being a V-shaped peripheral groove formed in said handle adjacent the center thereof, said handle being knurled adjacent said broach, substantially as described.

9. A metallic dental broach handle having a broach inserted in one end thereof, said handle being cylindrical in form and provided with a substantially V-shaped groove, the side of said groove adjacent said broach being substantially perpendicular to the periphery of said handle, substantially as described.

The supposed invention consists in notching the handle of a dental tool so that it can be more easily broken off if it should be desired to have the handle shorter. Two of the claims include the tool itself—a broach—as an element, and one specifies that the handle is knurled. These features, however, manifestly have no patentable relation to the idea of notching the handle for the purpose specified. The breaking off is accomplished by the means provided for that purpose, regardless of what tool is attached to the handle or whether any tool is attached, and regardless of whether the bar of metal which constitutes the handle is knurled or not. Moreover, each is old in the art, the broach is found in the patent to Donaldson, No. 202,006, April 2, 1878, and the knurling in the patents to Fredericks, No. 567,589, September 15, 1896, and Ivory, No. 634,732, October 10, 1899.

The only question, therefore, which the claims present is whether it is patentable invention to notch the handle of a tool to make it easier to break off if it is found too long for convenience.

I am clearly of the opinion that this involves no invention. The practice of notching articles to facilitate the breaking off of a part is so customary in a multitude of arts that it is a matter of common knowledge of which judicial notice may be taken. The natural instinct of a boy who wants to shorten a stick is to notch it with his knife before breaking it off. Blacksmiths notch steel bars with a cold chisel to enable them to break off a piece with a blow of the hammer. Workmen customarily cut notches around iron water-pipe and other similar articles to enable them to be broken off at the desired point. Glass is notched with a diamond or steel tool so that it may easily be broken at the desired point. Strips of paper, such as tickets, stamps, etc., are notched or perforated for the same purpose. Candies, notably the prepared chocolates, are formed in the same way for the same purpose, and scores of other examples will readily occur to the mind which might be cited. It is the ordinary and well known expedient for accomplishing the result mentioned wherever desired, and is so universal that it can not be said to relate to any particular art. The use of it in breaking off a tool handle certainly has no peculiar relation to the art of dentistry. It is an eminent example of that class of things to which the Court of Appeals made reference in the case In re Morgan, 179 O. G., 292, in which quoting from a decision of the examiners-in-chief, they said:

Certain devices are common to the arts as a whole because they are adapted for use in many situations.

In the record are two patents showing elongated metal articles which are notched in order that they may be broken off to the desired length; one is a sash weight and the other is a part
16 of a lock which is to be broken off to accommodate it to different thicknesses of doors. These patents are:

Cornell, No. 26,416, December 13, 1859,

Taylor, No. 405,057, June 11, 1889.

Either of them is believed to be a full anticipation of the supposed invention. Claim 9, it will be noted, is specific to a notch, one side of which is "substantially perpendicular." Even this detail is shown by Cornell cited, and, furthermore, is known to be a common way of notching a stick for the purpose intended.

I am clearly of the opinion that the application sets forth nothing upon which a patent can properly be based. The claims are therefore rejected and the patent refused. Appeal from this decision to the Court of Appeals should be taken, if at all, within the time prescribed by the rules of that court..

E. B. MOORE,
Commissioner.

July 5, 1912.

Motion for Judgment of Relator.

Filed February 27, 1913.

* * * * * * *

And now comes the relator, by Joshua R. H. Potts, his attorney, and moves the court for judgment for a peremptory writ of mandamus against the respondents, notwithstanding the return of the respondents herein.

JOSHUA R. H. POTTS,
Attorney for Relator.

Proof of Service.

W. S. Ruckman, Law Examiner, United States Patent Office, Washington, D. C.

DEAR SIR: Please take notice that the above motion will be presented to his Honor Judge Barnard, in the room usually occupied by him as a court room, in the City of Washington, D. C. on the 27 day of February, 1913 at 10 o'clock A. M. or as soon thereafter as counsel may be heard. You are invited to be present.

JOSHUA R. H. POTTS,
Attorney for Relator.

Receipt of a copy of the above notice acknowledged this 25th day of February, 1913.

W. S. RUCKMAN,
Attorney for Respondents.

17 *Opinion of Court.*

Filed March 14, 1913.

* * * * * * *

This is an application for a writ of mandamus to be directed to the Commissioner of Patents, and to one of the Primary Examiners, commanding the said Commissioner to cause a patent to be issued to the relator, and commanding the said Primary Examiner, to allow the relator's application, and to cause a patent to be issued therefor.

It is stated in the petition that the relator was the inventor of certain new and useful improvements in dental broach holders, and that he filed in the United States Patent Office, on February 24, 1911, an application, in due form, for letters patent therefor; that he paid the fee required by law, and in all respects complied with the statutes and rules of practice.

That on August 23, 1911, the respondent, A. G. Wilkinson, Primary Examiner, examined and considered the said application, and finally rejected the same. That on October 9, 1911, the relator appealed from his decision to the Board of Examiners-in-Chief, and paid the required fee therefor.

That January 31, 1912, the Board of Examiners rendered a decision, reversing the decision of the said Primary Examiner. That February 21, 1912, said Primary Examiner, of his own motion, and without authority or jurisdiction, and contrary to the well established rules of practice, reopened said application, and again rejected the same.

That March 13, 1912, at the instigation of said Primary Examiner, and without legal authority, and contrary to the rules, the respondent, E. B. Moore, Commissioner of Patents, took up said application for personal consideration, and then approved the said action of said Primary Examiner.

That April 13, 1912, the relator petitioned the said Commissioner, and requested him to command said Wilkinson, Primary Examiner, to issue said patent; and the relator paid the final government fee of $20, as required for such issue, at the same time.

That April 26, 1912, said Commissioner refused and declined to so command the said Primary Examiner, and rejected your petitioner's application, over his protest and objection.

That under the rules of practice of the said Patent Office, it was the duty of said Primary Examiner to allow the relator's said application, and to cause a patent to be issued therefor; and because of his refusal, the relator is deprived of the legal right vested in him by the laws of the United States, and is entirely without redress, unless a writ of mandamus shall be issued.

On filing the petition, a rule was issued, requiring the respondents to show cause why the writ of mandamus should not be granted, as prayed.

18 In response to this petition, and rule, the respondents filed a joint answer, in which they state that the relator's application for patent did not disclose a patentable invention, for rea-

sons set forth in the letter of February 21, 1912, signed by the said Primary Examiner, and for reasons stated in the decision of said Commissioner, dated July 5, 1912, copies of which letter and decision are annexed to the answer.

They aver that the Examiners-in-Chief reversed the Primary Examiner upon the ground that the references which had been cited by him were from non-analagous arts, and they deemed the claims allowable, over the references cited.

They state that the said Commissioner did not finally reject petitioner's application on April 26, 1912, but gave him notice, that on May 8, 1912, he could be heard upon the question of the patentability of the claims. That relator waived oral argument, and filed a brief; and that on July 5, 1912, the claims were finally rejected, and the patent refused, the Commissioner stating, in his decision, that it was believed the relator had an appeal direct to the Court of Appeals of the District of Columbia, to be taken within the time prescribed by the rules of that court.

Under Section 481 of the Revised Statutes of the United States, the Commissioner, under the direction of the Secretary of the Interior, is required to superintend all duties respecting the granting and issuing of patents. That under Sections 483, 4883, 4893, the said Commissioner is the head of the Patent Office, and responsible for all patents issued; and if there be any ground, within his knowledge, why a patent should not issue, it is his duty to refuse the same, whether the lower tribunals raise and act upon the point, or not.

That as the Commissioner had decided that the invention was not new and patentable, for the reasons set forth in his decision, it was his duty to reject the claims, and to refuse the patent.

That the relator had a direct appeal from such decision to the Court of Appeals, under act of February 9, 1893, (27 Stat., 434,) and that he had a further remedy by a bill in equity, under Section 4915 of the Revised Statutes.

That the question whether a patent shall issue under the law, is one within the discretion of the Commissioner of Patents, subject to a direct appeal to the Court of Appeals of the District of Columbia; and having exercised that discretion and judgment, and refused the application, respondents claim no writ of mandamus can issue. They also contend and claim, in their answer, that the said Primary Examiner is only a subordinate officer in the Patent Office, and that he has been improperly joined as a respondent.

In the letter from the Commissioner, transmitting to the applicant the action of the Primary Examiner, marked exhibit A, and annexed to the answer, it is stated that by direction of the Commissioner the Examiner has made additional and prolonged search for instances of the use of the common workshop expedient in question, in, if possible, a closely analagous art. He then cites certain patents by which he undertakes to show that the applicant's invention is not patentable, because of its want of novelty; and he also apologizes or excuses himself for not having made a more thorough ex-
19 amination in the first instance, and for his failure to call attention to certain other patents.

In exhibit B, attached to the answer, the Commissioner says, that this case had been referred to him by the Primary Examiner, in view of a communication by the applicant, filed March 4, 1912, in which attention is directed to Rule 142, the applicant claiming that under this rule the Examiner had no authority to reopen the case, and that, therefore, his letter of February 21, 1912, rejecting the claims, was improper.

He then says that the Examiners-in-Chief reversed the decision of the Examiner, upon the ground that the references cited were from a non-analagous art; and that the Examiner thereupon made a further search, and rejected the claims, upon other references and reasons; and the Commissioner concludes that the Examiner was justified, and approves his action in reopening the case for the purpose of introducing additional references.

Exhibit C is the decision of the Commissioner, dated April 26, 1912, wherein he cites as his authority the case of Hull v. Commissioner of Patents, 2 MacArthur, 90; and Drawbaugh v. Seymour, Commissioner of Patents, 9 Appeals D. C., 219, wherein he contends it was determined that the Commissioner is the head of the bureau, and responsible for the general issue of the bureau; and if there is any substantial, reasonable ground, within the knowledge of the Commissioner, why a patent should not issue, whether specific objection be raised or not, it is the duty of the Commissioner to refuse the patent.

He also cites as authority for his action, the case of Moore, Commissioner of Patents, v. Heany, 34 Appeals D. C., 31; and says it is believed that applicant has an appeal direct to the Court of Appeals.

Exhibit D, annexed to the answer, is a copy of the Commissioner's final decision, dated July 5, 1912, in which he rejects and refuses the patent, because the alleged invention, in his judgment, is not patentable. He says he is clearly of the opinion that the claims involved no invention.

It is contended by counsel for the relator, that the Primary Examiner, after rejecting his claims, and after his appeal to the Examiners-in-Chief, for which he paid the fee provided by statute, had no further duty to perform under the statute or rules of practice, except to obey the order made by the Examiners-in-Chief, in reversing his decision. That no appeal was allowed to the Commissioner on behalf of the Primary Examiner, and that he could not of his own motion refuse to be guided by the judgment of the Board of Examiners-in-Chief.

That the application for patent having been considered on its merits by the Primary Examiner, and having been rejected by him, and that decision having been reversed on the appeal to the Examiners-in-Chief, there was no lawful way in which the Commissioner, or the Primary Examiner, could question the case and consider it a second time on its merits; and that the only way in which the Commissioner could consider the application upon its merits, would be in case of an appeal by the applicant from an adverse decision of the Board of Examiners-in-Chief.

This being the law, as shown by the statutes and rules of practice, he contends that no appeal will lie to the Court of Appeals of this District from the decision of the Commissioner of Patents upon the merits of his application, unless the Commissioner took jurisdiction by an appeal from the Examiners-in-Chief; and that therefore the facts, as recited in this case, deprive him of a legal right to his patent which is granted him by the law, unless he shall have the benefit of the extraordinary remedy of mandamus, to compel the Commissioner to enforce the decision in his favor, which was rendered by the Examiners-in-Chief.

It seems that the first question which it is necessary for the court to determine is, has the relator the right to appeal to the Court of Appeals, from the decision of the Commissioner, finally rejecting his application?

If there is no question about his right to such an appeal, that would be his remedy, and not by way of application for a writ of mandamus; but if no such right of appeal is given by the law, then the court must consider whether or not the writ of mandamus can issue to secure the applicant in his alleged right to receive a patent.

Before the establishment of the Court of Appeals, by the act of February 9, 1893 (27 Stat., 434), appeals were taken directly to the Supreme Court of the District of Columbia, under Sections 4911 and 4912, R. S. U. S., provided such appeal was taken by the applicant after the three tribunals in the Patent Office had rejected his application.

In the case of Hull v. Commissioner of Patents, 2 MacArthur, 90, the court was divided on the question of the right of the applicant, to have a writ of mandamus in a case very similar to this. That was a case where the Primary Examiner decided that the applicant was not entitled to a patent, and the Examiners-in-Chief decided he was. The report on the patentability of the invention, was presented to the Commissioner for the issue of the patent, and the Commissioner, of his own accord, came to the conclusion that the patent ought not to be issued, and refused to sign the patent.

The majority of the court held that he had this right. The opinion for the majority of the court was delivered by Justice Wylie, Justices Olin and Humphreys concurring with him, and Chief Justice Cartter and Justice MacArthur dissenting, Justice MacArthur filing a dissenting opinion.

The question was raised in that case as to the right of the applicant to appeal from the Commissioner, and the court held he had no right of appeal (page 107). The court also held that the Commissioner had power, under the statutes, to reverse, without appeal, a favorable decision rendered by the Examiners-in-Chief, allowing a patent; that the Commissioner had authority to withhold a patent for any reason satisfactory to himself; and that the claimant had the right to file a bill in equity, as provided by Sec. 4915 R. S. U. S., and having such right, the writ of mandamus was refused.

21 A re-hearing was had in that case, and Mr. Justice Humphreys announced the decision of the majority, again refusing the mandamus. 2 MacArthur, 125.

The dissenting opinion held that the Commissioner, by virtue of his supervisory powers, could withhold a patent, where fraud was discovered, or where any gross irregularity appeared; but that when the case had been regularly presented, and duly examined, and decided favorably to the applicant, on its merits, that it was the duty of the Commissioner to prepare the patent, and that the law makes it mandatory upon him to do so.

Justice MacArthur further points out that the Examiners-in-Chief are independent officers appointed by the President, by and with the consent of the Senate, and that they are selected from persons of competent legal knowledge and scientific ability, and that their duties are judicial in their nature. That their judgment is to be taken as to the merits of an application for a patent, and if they decide against the applicant, the Commissioner, on appeal by the applicant from such adverse decision, has jurisdiction to consider the merits; but if they decide that the applicant is entitled to a patent on the merits, there is no method provided by which that judgment can be reviewed or reversed by the Commissioner.

To quote from the opinion:

"The law is mandatory upon him in case the applicant presents a favorable decision, and he cannot evade it without dispensing with the law itself. He has no right to take up a case, except by appeal, overrule decisions, suspend proceedings, and refuse patents, at his own will and pleasure."

Justice MacArthur points out that in order to give the applicant the right to file a bill in equity, as provided by Section 4915 R. S. U. S., his application must have been adversely acted upon by all three tribunals in the Patent Office.

That the refusal of the Commissioner to allow a patent, which will give the applicant the right to file his bill in equity, can only occur in cases which regularly come before him on appeal from an adverse decision of the Examiners-in-Chief.

In the case cited by the Commissioner, in Re Drawbaugh, 9 Appeals D. C., 219, it appears that the applicant's claims for a patent had all been rejected by the Primary Examiner, and his rejection was duly confirmed by the Board of Examiners-in-Chief, and the applicant's appeal to the Commissioner, therefore brought before the Commissioner properly all the questions which could be raised in the said case.

In such a case as that, the language of Chief Justice Alvey was properly applicable, where, on page 240, he says:

"The Commissioner is the head of the bureau, and he is responsible for the general issue of that bureau. If, therefore, there be any substantial, reasonable ground, within the knowledge or cognizance of the Commissioner, why the patent should not issue, whether the specific objection be raised and acted upon by the examiners or not, it is his duty to refuse the patent; and especially is it so when the Primary Examiner and the Examiners-in-Chief have found such ground for refusal to exist."

22 The Chief Justice had just stated that the subordinate officers of the Patent Office, to wit, the Primary Examiner,

Examiners of Interferences, and the Examiners-in-Chief, were all subject to the official direction of the Commissioner, except in the free exercise of their judgment in the matters submitted for their examination and determination.

That case is certainly to be distinguished from the case at bar, for there can be no question but what the Commissioner had jurisdiction by proper and regular appeals in that case, to refuse the patent for any reason which he might deem just and proper. The case, therefore, does not help us in determining whether the relator in this case had an appeal to the Court of Appeals from the refusal of the Commissioner to grant him the patent.

In the Heany case, 34 Appeals D. C., 31, the Court of Appeals entertained an appeal from the Supreme Court of the District of Columbia, sitting in Equity, wherein a preliminary injunction had been granted, restraining the Commissioner from further proceedings in an investigation initiated by him in the Patent Office, wherein charges were made that applications for patents had been tampered with.

In that case Chief Justice Shepard said, in the opinion:

"The Commissioner of Patents is the official head and administrator of a great and important office. The duties devolved upon him are both executive and judicial in their character. As an executive officer, it is his duty to see that the business of the office is carried on honestly, methodically, and with reasonable despatch. As regards every application for a patent, there are two interests involved,—that of the applicant, and that of the public. It is the duty of the Commissioner to see that the formal requirements of the statutes relating to applications are complied with. When an application is found to be sufficient in form, it then becomes his duty to inquire and determine if the applicant is justly entitled to the patent, as claimed. The investigation of the claim involves the adjudication of disputed questions of fact, upon scientific or legal principles. The proceeding is essentially judicial in its character."

The investigation instituted by the Commissioner in that case was one involving his executive duties, and one within his discretion; and the court held that

"The power to enjoin the action of an executive officer, or of a subordinate tribunal, in a given case, rests upon the same foundation as that to compel action by mandamus."

"The courts are invested with no power to interfere with or to supervise the practice of the Patent Office. It is only in cases where a hearing is refused a party, or the Commissioner refuses to perform a plain duty, or where he undertakes to do an unwarranted act, for which there is no other remedy, that the courts are authorized to interfere by mandamus or injunction."

I am unable to see any authority in this case for the right of appeal by the relator in the case at bar.

My attention has been called to the case, In Re Fullagar, 32
23 Appeals D. C., 222. Chief Justice Shepard, in delivering the opinion in that case, says:

"The jurisdiction of this court to entertain appeals from decisions of the Commissioner of Patents, in proceedings relating to patents, is limited to two classes of cases. The first is where the claims of an applicant for a patent, or the reissue of a patent, after having been twice rejected, have been finally rejected on an appeal to the Commissioner in due course of procedure. The second is where on an appeal to the Commissioner in an interference proceeding, there has been a final decision of priority in favor of one of the parties thereto."

Sections 4909-4911, R. S. U. S.
Westinghouse v. Duncan, 2 Appeals D. C., 131.
Allen v. U. S., 26 Appeals D. C., 8.
Union Distilling Company v. Schneider, 29 Appeals D. C., 1.

The appeal in that case was from the Commissioner rejecting certain claims, but the court held that it had no jurisdiction of the appeal, and added:—

"Upon the return of the case to the Patent Office, Fullagar will be entitled to have his application remanded for re-examination, and if again rejected, he will be entitled to his successive appeals in due course, if it should become necessary to resort thereto."

In the case of Westinghouse v. Duncan, 2 Appeals D. C., 131, Chief Justice Alvey said, in rendering the opinion:—

"An appealable decision of that officer," (the Commissioner,) "can only be made after the finding of the Primary Examiner, and the determination of the Board of Examiners-in-Chief upon appeal, and thence upon appeal to the Commissioner of Patents."

The Court of Appeals has again announced the cases in which it can entertain an appeal from the Commissioner, in the recent case. In Re Mygatt, decided early in the year 1913, being Patent Appeal No. 828.

In that case, Chief Justice Shepard said:—

"In ex parte cases the appellate jurisdiction is limited to those where the claims of an applicant for a patent, or the reissue of a patent, after having been twice rejected, have been finally rejected on an appeal to the Commissioner, in due course of procedure", citing as authority, In Re Fullagar, 32 Appeals D. C., 222, and cases there cited.

He then adds:—

"The due course of procedure described by statute and rules, is first an appeal to the Examiners-in-Chief, and from them to the Commissioner."

It is true this decision was made in a case where the applicant sought to get a patent for a design, but it is well settled by the authorities that the application for such patent, and the procedure thereon, are to be governed by the same rules and statutes as an application for a patent for an invention, so far as the same are applicable.

24 There is perhaps no new legislation that affects the question involved in this case, since the decision of the said case reported in 2nd MacArthur; but there have been a number of decisions

of the Court of Appeals, and of the Supreme Court of the United States, that appear to modify or in effect to reverse the ruling of the majority of the court in that case.

I have great respect for the judgment of the men composing this court at that time, all of whom were personally well known to me, but I think the logic of the dissenting opinion is more in harmony with the proper construction of the statutes, and with the later decisions, than the majority opinion, and I do not feel that this court should be now bound thereby.

Perhaps the leading case on this subject, since that decision, is that of United States ex rel. Hoe v. Butterworth, 112 U. S., 50.

In that case the Supreme Court held that a writ of mandamus issued by this court was proper to compel the Commissioner to issue a patent, notwithstanding the Secretary of the Interior had been appealed to by the party opposing the patent, and had directed the Commissioner not to issue the same.

In that case the court refers to the judicial system provided for by statute, for the determination of patents, to wit, the examination of the claims by the Primary Examiner, and if twice rejected by him, the appeal by the applicant to the Examiners-in-Chief, who are constituted a tribunal for that purpose; and if their decision is adverse, the appeal to the Commissioner in person; and if his decision is adverse, the final appeal to the Court of Appeals of the District of Columbia.

Mr. Justice Matthews rendered the opinion in that case, and said, beginning on page 60:—

"Congress has thus provided four tribunals for hearing applications for patents, with three successive appeals, in which the Secretary of the Interior is not included, giving jurisdiction in appeals from the Commissioner to a judicial body independent of the Department, as though he were the highest authority on the subject within it; and to say that under the name of direction and superintendence the Secretary may annul the decision of the Supreme Court of the District, on appeal from the Commissioner, by directing the latter to disregard it, is to construe a statute so as to make one part repeal another, when it is evident both were intended to co-exist without conflict."

The court reviews the history of the patent legislation, saying that the act of 1861, (12 Stat., 246,) created the office of Examiners-in-Chief, for the purpose of securing greater uniformity of action in the grant and refusal of letters patent, and to be composed of persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the applicant for that purpose being filed, to revise and determine upon the validity of decisions made by examiners when adverse to the grant of letters patent; and from their adverse decision appeals may be taken to the Commissioner of Patents in person, upon payment of the fee prescribed.

25 On page 67, the court says:—

"The conclusion cannot be resisted, that to whatever else supervision and direction on the part of the head of the Department

may extend, in respect to matters purely administrative and executive, they do not extend to a review of the action of the Commissioner of Patents in those cases in which, by law, he is appointed to exercise his discretion judically. It is not consistent with the idea of judicial action that it should be subject to the direction of a superior in the sense in which that authority is conferred upon the head of an executive department in reference to his subordinates. Such a subjection takes from it the quality of a judicial act."

This case was again referred to by the Supreme Court, and approved, in an opinion by Chief Justice Fuller, in the case of United States v. Duell, 172 U. S., 576.

The reasoning of the court of last resort on this subject may be applied to the case at bar, and if applied to the case of Hull v. Commissioner of Patents, 2 MacArthur, would have been in conflict with the opinion of the majority of the court in that case, and would be in conformity with the strong dissenting opinion filed by Justice MacArthur.

Some confusion seems to have existed in the mind of that court, as to the rights and powers that were possessed by the Commissioner of Patents as the head of the Patent Office, in his executive and administrative capacity; the majority holding that such powers should also apply to and be exercised by him when acting in a judicial capacity.

It might well be that his duties as an executive officer and superintendent of the Patent Office, would require him to examine all patents as to form, and if frauds or mistakes were discovered, to withhold the issue of patents, and to see generally this his subordinate officers were acting in an orderly, honest, and proper manner; but the whole scheme of the Patent Office tribunals, as indicated by the statutes, was to preserve independent judgment in the primary examiners, in the examiners-in-chief, and in the Commissioner of Patents, when acting in a judicial capacity; and the Commissioner had no more right or authority to reverse the Board of Examiners-in-Chief in a case not appealed to him by the applicant, than would an appellate court have the right to reverse an inferior court in any of its judgments, when not appealed to by one or more of the parties in interest.

The duties of superintending and supervising the Patent Office are executive and administrative duties; but the duty of deciding on the merits of an application for patent is clearly a judicial duty; and in order that an applicant may have the remedy provided by Section 4915 R. S. U. S., the Commissioner must receive the case by proper appeal from the Board of Examiners-in-Chief, and must have acted upon the same so as to deny the applicant's claim for patent. Such appeal only can confer jurisdiction on him to discharge such judicial duty.

He could not by main strength take up a case that had been favorably acted upon by the proper tribunals selected for that pur-
26 pose, and reverse them, and refuse to issue a patent, because, in his judgment, the claims were not patentable.

The question of patentability must in all cases depend upon the judgment of some authority, either the Primary Examiner, the Ex-

aminers-in-Chief, the Commissioner, or the Court of Appeals of the District of Columbia; and that judgment must be exercised in a legal manner by them in the order named.

If the relator in this case is to be refused a patent under the facts shown, such patent is to be refused notwithstanding the special tribunal, selected as such because of supposed legal and scientific qualifications, has decided that it is allowable. In other words, the Primary Examiner and the Commissioner of Patents, have ignored the judgment of the Examiners-in-Chief, by assuming to take action of a judicial character, when jurisdiction was not obtained by them by any appeal or statutory authority.

If the judgment of the Board of Examiners-in-Chief can be thus ignored, why was the appeal to them provided? And why was the applicant required to pay the fee provided by statute, for such appeal?

It must be assumed, I think, from the facts in this case, that the decision of the Primary Examiner in the first instance, for whatever reason assigned, wholly rejected the applicant's claim for a patent. It must also be assumed that the decision of the Board of Examiners-in-Chief set aside that judgment and decision, because they found, in their judgment, it was wrong, and that the applicant was entitled to a patent.

Notwithstanding this judgment, the Primary Examiner, who like "the man convinced against his will, is of the same opinion still," cast about for additional reasons to show why his judgment, as first rendered, was correct; and by applying to the Commissioner, and the two conferring together, he secured the agreement of the Commissioner to his original judgment; and this case, while both of these officers probably acted with entire honesty of purpose, only illustrates the undesirability of having matters of a judicial character determined in an irregular way.

If a Primary Examiner and the Commissioner, for any reason, can combine in their judgment against an inventor who has applied for a patent, and has obtained a favorable decision from the Board of Examiners-in-Chief, he may never succeed in obtaining his patent.

The action, therefore, of the Primary Examiner, and of the Commissioner, seems to be unwarranted, and whether right or wrong in their judgment as to the patentability of the claims, their action so irregularly had, ought not to be sustained.

If the Primary Examiner, with or without the consent of the Commissioner, can open a case once after being reversed, may he not do so any number of times, if subsequent appeals be taken? When would a determination of applicant's claims be had if that were true?

As already indicated, there seems to be no right of appeal to the Court of Appeals, from such decision of the Commissioner, (In Re Frasch, 192 U. S., 566,) and there seems to be no right even
27 to file a bill in equity, because the action of the Commissioner was taken in the absence of any appeal to him, as provided by statute; and therefore, it is contended that there is no other

remedy by which the applicant can secure the right that was granted to him by the Board of Examiners-in-Chief, than to apply to a court having authority to issue the writ of mandamus, and by such writ to require the judgment of the Examiners-in-Chief to be made effectual.

It may be that this could be fully accomplished by issuing the writ against the Commissioner alone, for as to the ministerial duty of having the patent prepared and signed, he would have control of the other subordinate officers in the Department; but the Primary Examiner, having been made a respondent, and having answered, the court can see no objection to allowing the writ to be directed to both the respondents.

In addition to the cases cited which in my judgment authorize the granting of the writ of mandamus in this case, the following have been examined.

U. S. ex rel. Steinmetz v. Allen, 192 U. S., 543.
U. S. ex rel. West v. Hitchcock, 19 Appeals D. C., 333.
Roberts v. U. S., 176 U S., 221.
Interstate Commerce Com. v. U. S., 224 U. S., 474.

I will sign an order directing the writ to issue, as prayed in the petition.

JOB BARNARD, *Justice.*

Order.

Filed March 18, 1913.

* * * * * * *

This cause coming on to be heard upon the petition, rule to show cause and return of respondent thereto, and the motion for judgment, after argument of counsel, it is, this 18th day of March, 1913, considered that the prayer of the petition be, and the same is hereby granted, and the writ of peremptory mandamus is hereby ordered to issue in conformity with the petition, and that the relator recover against the respondents his costs of this proceeding, to be taxed by the Clerk and have execution thereof.

JOB BARNARD, *Justice.*

Notice of Appeal and Waiver of Citation.

Filed March 18, 1913.

* * * * * * *

The Clerk of said Court will enter an appeal to the Court of Appeals of the District of Columbia.

W. S. RUCKMAN,
Attorney for Respondents.

March 18, 1913.

28 Service of copy acknowledged and notice of appeal by citation waived.

JOSHUA R. H. POTTS,
Attorney for Respondents.

Assignments of Error.

Filed March 21, 1913.

* * * * * * *

Now come the respondents and assign the following errors in the action and proceedings of the said Supreme Court of the District of Columbia in the said cause.

The court erred:

1. In granting relator's petition for writ of mandamus and in ordering said writ to issue.

2. In holding that the Commissioner of Patents had no right or authority to reverse the judgment of the Examiners-in-Chief in a case not appealed to him by the applicant.

3. In holding that the Commissioner of Patents could not lawfully take up a case that had been favorably acted upon by a primary examiner or the Examiners-in-Chief in the Patent Office and reverse them and refuse a patent when in his judgment the claims were not patentable.

4. In holding that the Commissioner of Patents is without jurisdiction and statutory authority to take action of a judicial character in an application which is not before him upon appeal.

5. In holding that the actions of the primary examiner and of the Commissioner of Patents in relator's application No. 610,571 were unwarranted and whether right or wrong in their judgment as to the patentability of the claims, their actions were irregular and ought not to be sustained.

6. In not holding that if there is any ground within the knowledge of the Commissioner why a patent should not issue it is within his supervisory authority and is his duty to refuse the patent, whether or not the specific objection has been raised and acted upon by the primary examiner or Examiners-in-Chief and irrespective of their holdings.

7. In holding that relator had no right of appeal to the Court of Appeals of the District of Columbia from the Commissioner's decision rejecting the claims of his application and refusing a patent.

8. In holding that "in order that an applicant may have the remedy provided by Section 4915 R. S. U. S., the Commissioner must receive the case by proper appeal from the Board of Examiners-in-Chief, and must have acted upon the same so as to deny the applicant's claim for patent."

9. In holding that the relator had no right of appeal to the Court of Appeals of the District of Columbia or to file a bill in equity under Section 4915 of the Revised Statutes because the action of the
29 Commissioner was taken in the absence of a statutory appeal to him.

10. In holding that the relator had no other remedy except by writ of mandamus.

11. In failing to dismiss the petition of relator because he had other remedies.

12. In not dismissing the petition for mandamus upon the ground that primary examiner Wilkinson has been improperly made a party respondent.

13. In not holding that the respondent Wilkinson was an employeee of the Patent Office and subordinate to and subject to the official control and direction of the Commissioner of Patents, who is the responsible head of the Patent Office and through whom, if through any one, the relief prayed for should be obtained.

Wherefore, the respondents pray that the judgment of the Supreme Court of the District of Columbia be reversed with costs, and that the cause be remanded with directions to vacate the order directing the writ of mandamus to issue, to discharge the rule to show cause and to dismiss the petition.

W. S. RUCKMAN,
Counsel for Respondents.

March 21, 1913.

Order for Transcript.

Filed March 18, 1913.

* * * * * * *

The Clerk of said Court will prepare a transcript of record for appeal to the Court of Appeals of the District of Columbia, to include the following papers:

Petition of relator and rule to show cause on respondents.
Return of respondents and attached Exhibits A, B, C and D.
Motion for judgment of relator.
Decision of Justice Barnard.
Decree or order of Justice Barnard.
Instructions to clerk to enter appeal to Court of Appeals.
Waiver of citation of notice of appeal by relator.
Assignments of error.

W. S. RUCKMAN,
Attorney for Respondents.

Supreme Court of the District of Columbia.

UNITED STATES OF AMERICA,
District of Columbia, ss:

I, John R. Young, Clerk of the Supreme Court of the District of Columbia, hereby certify the foregoing pages numbered from 1 to 52, both inclusive, to be a true and correct transcript of the record according to directions of counsel herein filed, copy of which is made
30 part of this transcript, in cause No. 55,492 at Law, wherein United States ex rel. Edward L. Chott is Petitioner and E. B. Moore, Commissioner of Patents, et al. are Respondents, as the same remains upon the files and of record in said Court.

In testimony whereof, I hereunto subscribe my name and affix the seal of said Court, at the City of Washington, in said District, this 25th day of March, 1913.

[Seal Supreme Court of the District of Columbia.]

JOHN R. YOUNG, *Clerk.*

Endorsed on cover: District of Columbia Supreme Court. No. 2536. E. B. Moore, Commissioner of Patents, et al., appellants, vs. U. S. ex rel. Edward L. Chott. Court of Appeals, District of Columbia. Filed Mar. 25, 1913. Henry W. Hodges, clerk.

31 WEDNESDAY, May 14th, A. D. 1913.

No. 2536.

E. B. MOORE, Commissioner of Patents, and A. G. WILKINSON, Primary Examiner, United States Patent Office, Appellants,
vs.
UNITED STATES ex Rel. EDWARD L. CHOTT.

The argument in the above entitled cause was commenced by Mr. W. S. Ruckman, attorney for the appellants, and was continued by Mr. Joshua R. H. Potts, attorney for the appellee.

THURSDAY, May 15th, A. D. 1913.

No. 2536.

E. B. MOORE, Commissioner of Patents, and A. G. WILKINSON, Primary Examiner, United States Patent Office, Appellants,
vs.
UNITED STATES ex Rel. EDWARD L. CHOTT.

The argument in the above entitled cause was continued by Mr. Joshua R. H. Potts, attorney for the appellee, and was concluded by Mr. W. S. Ruckman, attorney for the appellants.

32 In the Court of Appeals of the District of Columbia.

No. 2536.

E. B. MOORE, Commissioner of Patents, and A. G. WILKINSON, Primary Examiner, United States Patent Office, Appellants,
vs.
UNITED STATES ex Rel. EDWARD L. CHOTT, Appellee.

Opinion.

(Mr. Justice VAN ORSDEL delivered the opinion of the Court:)

This is an appeal by the Commissioner of Patents and one of the examiners of the Patent Office as joint respondents from the judg-

ment of the Supreme Court of the District of Columbia ordering the issuance of a writ of mandamus to compel them to issue a patent to relator.

It appears that relator applied for letters patent for alleged improvements in dental broach holders. The claims were rejected by the primary examiner, from whose decision relator appealed to the board of examiners-in-chief. The board reversed the primary examiner, and sustained the claims. Acting by authority of the Commissioner, the primary examiner made an additional investigation, and cited to the Commissioner additional patents showing the alleged invention to be old. Whereupon, the Commissioner personally took up the case, and approved the action of the primary examiner. He did not, however, finally reject the claims, but asserted in a communication to relator his authority to review the case personally, although it had been acted upon favorably by the board of examiners-in-chief. He notified relator that on May 8, 1912, a hearing would be had upon the patentability of his claims over the prior art. Relator appeared by brief, contesting the authority of the Commissioner to withhold the application from issue after a favorable decision from the board of examiners-in-chief. The Commissioner, in a
33 carefully considered opinion on the merits of relator's alleged invention, decided that relator was not entitled to a patent, and finally disallowed the claims.

The questions presented are, whether the decision of the board of examiners-in-chief was binding upon the Commissioner to the extent that nothing remained for him to do except to perform the mere ministerial act of issuing the patent. If this contention is correct, it disposes of the case; but, if not correct, the further question arises whether the official action of the Commissioner constituted such a final order as would have entitled relator to prosecute an appeal to this court.

The jurisdiction of the Commissioner of Patents is defined by statute in the Revised Statutes of the United States, as follows:

"SEC. 481. The Commissioner of Patents, upon the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office."

"SEC. 483. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office."

"SEC. 4883. All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Commissioner of Patents," etc.

"SEC. 4893. On the filing of any such application and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is

sufficiently useful and important, the Commissioner shall issue a patent therefor."

"SEC. 4903. Whenever, on examination, any claim for a
34 patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection," etc.

The jurisdiction of the board of examiners-in-chief is conferred by section 482, R. S., as follows: "The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for reissues of patents, and in interference cases; and when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them."

It will be observed that nothing appears in the Act conferring jurisdiction upon the board of examiners-in-chief in any way depriving the Commissioner of the general power conferred upon him by law to satisfy himself before issuing a patent "that the claimant is justly entitled to a patent under the law." Unquestionably, the decision of the board of examiners-in-chief, when favorable to the claimant, is final, unless the Commissioner, in the exercise of his general supervisory power, has authority, upon his own independent investigation, to determine finally whether a patent shall issue. The same would be true of a decision by the primary examiner in favor of an applicant. When an application is made for a patent, it is the duty of the Commissioner to cause an examination to be made, and "if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor." The examination here required to be made may or may not lead to an appeal to the board of examiners-in-chief, but whether it does or not, in order to determine that a patent should issue, when it ultimately comes back to the Commissioner after the examination ordered under the statute has been made, he may, upon inspection and review of the examination made pursuant to his order, find that the alleged invention is neither novel nor meritorious. In such a case he would be bound to violate his
35 official obligation. There is nothing in the law to prevent him from exercising this supervision.

Considering this subject the court in Hull vs. Commissioner of Patents, 2 MacA., 90, said: "Had Congress intended that the decision of the examiners, when favorable to the applicant, should be final and conclusive, we would suppose to greatly an anomoly in executive administration would have been introduced into the law by the use of terms of the clearest import. A certified copy of the decision would have been a mandate to the Commissioner, requiring him to issue the patent by authority, it might be, of a second assistant examiner, who had been appointed at his instance, and subject to removal in the like manner."

In the same case, the court, referring to section 4915, R. S., where an aggrieved party, when a patent is refused by the Commis-

sioner of Patents or this Court, may go into a court of equity, said: "This action recognizes the authority of the Commissioner to withhold a patent — in any case, for any reason satisfactory to himself, it shows that the decisions of the examiners are in no case obligatory as to his action. In that it supplies a remedy under which his judgment in withholding a patent may be revised, it is decisive against a remedy by mandamus applied for in the present instance; for this writ will not lie where the law furnishes the party with any other adequate specific remedy."

In ex parte cases, the public is represented by the Commissioner. No right of appeal is provided from the decision of the primary examiner or the board of examiners-in-chief in behalf of the public. It can not be that one or both of these tribunals is given final jurisdiction to an extent which forbids any review by the Commissioner; for appeal only lies from the action of the Commissioner, when the Commissioner, as the executive head of the bureau, has been satisfied that an error has been committed, by which the public will be damaged. In the case of In re Drawbaugh, 9 App. D. C.,
36 219, Chief Justice Alvey, speaking for the court, said: "The patent should not issue as an experiment upon the public, nor to embarrass or infringe the use of other inventions having just priority. To every application for a patent the public is a party in an important sense, more than that of mere formal grantor. It is substantially interested in preventing the people from being harassed by the claims of a monopoly, when in fact there may be no just grounds for such claims. It is the duty of the Commissioner of Patents, representing the public, and also the private rights of the inventor involved in the pending application, as well as all other inventors having the sanction of the Patent Office, to see that entire justice be done to all concerned. The law has provided certain official agencies to aid and advance the work of the Patent Office, such as the primary examiner, the examiner of interferences and the examiners-in-chief; but they are all subordinate, and subject to the official direction of the Commissioner of Patents, except in the free exercise of their judgments in the matters submitted for their examination and determination. The Commissioner is the head of the bureau, and he is responsible for the general issue of that bureau. If, therefore, there be any substantial, reasonable ground within the knowledge or cognizance of the Commissioner why the patent should not issue, whether the specific objection be raised and acted upon by the examiners or not, it is his duty to refuse the patent; and especially is it so, when the primary examiner and the examiners-in-chief have found such ground for refusal to exist." This general supervisory power of the Commissioner has been upheld by this court in numerous cases. Podlesak vs. McInnerney, 26 App. D. C., 399; Sobey vs. Holsclaw, 28 App. D. C., 65; Moore vs. Heany, 34 App. D. C., 31; In re Locke, 17 App. D. C., 314; U. S. ex rel. Hoe vs. Butterworth, 3 Mack., 229, 112 U. S. 50.

This brings us to the remedy. We are of opinion that relator had a right of appeal to this court from the decision of the Commissioner. Relator can not complain that this remedy was not

pointed out to him, for the decision of the Commissioner con-
37 cludes as follows: "I am clearly of the opinion that the application states nothing upon which a patent can properly be based. The claims are therefore rejected and a patent refused. Appeal from this decision to the Court of Appeals should be taken, if at all, within the time prescribed by the rules of that court."

The right of appeal granted by section 4911, R. S., is very broad, and embraces every application for patent, "except a party to an interference" who "is dissatisfied with the decision of the Commissioner." We have held this to include any official action of the Commissioner which was decisive of an applicant's right to a patent, or which, in effect, operated as a rejection of the claims of the application. In the case of In re Mattullath, 38 App. D. C., 497, the court, speaking through its chief justice, said: "The right to appeal from a final decision of the Commissioner of Patents is determinable by its substance and effect, rather than its form. Moore vs. Heany, 34 App. D. C., 31-39; Re Selden, 36 App. D. C., 428-431. The appeal in Selden's case was from a decision holding that the application had been abandoned for lack of prosecution within two years. The right to appeal was maintained. Discussing the point, Mr. Justice Robb, delivering the opinion of the court, said: 'The question, is whether the striking down of an application on the ground of abandonment amounts to a rejection of the claims thereof, within the meaning of the statute. Of course, if such action on the part of the Commissioner is in effect a rejection of the claims of the application, the court will look to such result rather than to the manner in which it is reached. Substance should never be sacrificed for form.'" See also In re Mygatt, 26 App. D. C., 366; Cosper vs. Gold, 36 App. D. C., 302; General Railway Signal Co. vs. Thullen, 32 App. D. C., 575; New Departure Mfg. Co. vs. Robinson, present term.

Mandamus cannot be substituted for the remedy afforded by ap-
peal. Neither can it be invoked for the purpose of reviewing or controlling the action of the Commissioner in refusing to issue re-
38 lator a patent. The judgment is reversed with costs, and cause remanded for further proceedings.

Reversed.

39 MONDAY, June 2nd, A. D. 1913.

No. 2536, April Term, 1913.

E. B. MOORE, Commissioner of Patents, and A. G. WILKINSON, Primary Examiner, United States Patent Office, Appellants,

vs.

UNITED STATES ex Rel. EDWARD L. CHOTT.

Appeal from the Supreme Court of the District of Columbia.

This cause came on to be heard on the transcript of the record from the Supreme Court of the District of Columbia and was argued by

counsel. On consideration whereof, It is now here ordered and adjudged by this Court that the judgment of the said Supreme Court, in this cause, be, and the same is hereby, reversed with costs; and that this cause be, and the same is hereby, remanded to the said Supreme Court for further proceedings.

Per Mr. JUSTICE VAN ORSDEL,
June 2, 1913.

40 UNITED STATES ex Rel. EDWARD L. CHOTT, Plaintiff in Error,
vs.
E. B. MOORE, *Commissioner of Patents*, and A. G. WILKINSON, *Primary Examiner*, United States Patent Office, Defendants in Error.

Petition for Writ of Error.

Honorable Joseph R. Lamar, Associate Justice of the Supreme Court of the United States:

Your petitioner, United States ex rel. Edward L. Chott, plaintiff in error in the above entitled cause, respectfully shows that the above entitled case is now pending in the Court of Appeals of the District of Columbia, and that a judgment has therein been rendered on the second day of June 1913, reversing a judgment of the Supreme Court of the District of Columbia, and that said cause is one in which the validity of an authority exercised under the United States and the existence and scope of a power and duty of an officer of the United States is drawn in question, and that said cause is not a case arising under the patent laws, the copyright laws, the revenue laws or criminal laws and that it is not an admiralty case and that it is a proper case to be reviewed by the Supreme Court of the United States upon a writ of error; and therefore your petitioner would respectfully pray that a writ of error be allowed in the above entitled case directing the clerk of the Court of Appeals of the District of Columbia to send the record and proceedings in said cause with all things concerning the same, to the Supreme Court of the United States, in order that the errors complained of in the assignment of errors herewith filed by said plaintiff in error may be reviewed, and if error be found corrected according to the laws and customs of the United States.

A transcript of the record, briefs of counsel for the respective parties and the opinion of the Court of Appeals of the District
41 of Columbia in said cause are attached hereto.

UNITED STATES EX REL. EDWARD L. CHOTT, *Plaintiff in Error.*
By JOSHUA R. H. POTTS, *His Attorney.*

The foregoing petition is granted and writ of error allowed as prayed for upon plaintiff giving bond according to law in the sum of $500.00.

J. R. LAMAR,
Associate Justice of the Supreme Court of the United States.

42 In the Court of Appeals of the District of Columbia.

UNITED STATES ex Rel. EDWARD L. CHOTT, Plaintiff in Error,

vs.

E. B. MOORE, Commissioner of Patents, and A. G. WILKINSON, Primary Examiner, United States Patent Office, Defendants in Error.

Assignment of Errors.

And now comes the plaintiff in error, United States ex rel. Edward L. Chott, by its attorney, and says that in the record and proceedings aforesaid of said Court of Appeals of the District of Columbia, in the above entitled cause, and in the rendition of the final judgment therein, manifest error has intervened to the prejudice of said plaintiff in error, in this to wit:

1. Said Court of Appeals erred in entering judgment reversing the judgment of the Supreme Court of the District of Columbia.

2. Said Court of Appeals erred in not affirming the judgment of the Supreme Court of the District of Columbia.

3. Said Court of Appeals erred in holding and deciding that the decision of the examiners in chief was not binding upon the Commissioner of Patents.

4. Said Court of Appeals erred in holding and deciding that the relator had a right of appeal to the Court of Appeals of the District of Columbia from the action of the Commissioner of Patents.

5. Said Court of Appeals erred in holding and deciding that the Commissioner of Patents had jurisdiction to pass upon the merits of an application for a patent which was not before him by appeal taken by an applicant from an adverse decision by the examiners in chief.

6. Said Court of Appeals erred in holding and deciding that the Commissioner of Patents had authority to withhold a patent after an adverse decision by a primary examiner in the Patent Office
43 had been reversed by the examiners in chief.

7. Said Court of Appeals erred in holding and deciding that the Commissioner of Patents had authority to pass upon the patentability of the claims of any application for a patent except where said application comes before him by regular course of appeal under the statutes and rules of practice of the Patent Office.

8. Said Court of Appeals erred in holding and deciding that the supervisory authority of the Commissioner extended to an application which had been held allowable by the examiners in chief.

9. Said Court of Appeals erred in holding and deciding that the Commissioner of Patents need not issue a Patent for an alleged invention which he personally considered neither novel nor meritorious.

10. Said Court of Appeals erred in holding and deciding that the Commissioner of Patents had authority to inspect and review an examination of an application after it comes back to him from another tribunal having appellate jurisdiction under the statutes and having held the application allowable.

11. Said Court of Appeals erred in holding and deciding that the decision of the examiners in chief was not a mandate to the Commissioner of Patents requiring him to issue the patent.

12. Said Court of Appeals erred in holding and deciding that the decision of the examiners in chief reversing a primary examiner is not final and binding upon the Commissioner of Patents.

13. Said Court of Appeals erred in holding and deciding that the examiners in chief are subordinate to the Commissioner of Patents under all circumstances.

14. Said Court of Appeals erred in holding and deciding that the action of the Commissioner of Patents withholding relator's patent was a proper official action.

15. Said Court of Appeals erred in failing to hold and decide that, after the primary examiner had been reversed by the examiners in chief, the duty of the Commissioner of Patents and primary examiner to issue a patent was a purely ministerial duty enforcible by mandamus.

44 16. Said Court of Appeals erred in failing to hold and decide that, after the primary examiner had been reversed by the examiners in chief, the interference with the issuance of the patent by the Commissioner of Patents under the circumstances in this case was the exercise of purely arbitrary power without legal authority or justification.

17. Said Court of Appeals erred in failing to hold and decide that, after the primary examiner had been reversed by the examiners in chief, the withholding of the patent to the relator by the Commissioner of Patents, was the illegal and invalid exercise of an authority under the United States.

18. Said Court of Appeals erred in failing to hold and decide that, after the primary examiner had been reversed by the examiners in chief, the withholding of the patent to relator by the Commissioner of Patents, was not within his power or duty as an officer of the United States.

19. Said Court of Appeals erred in failing to hold and decide that the Commissioner of Patents was bound by the rules of practice of the Patent Office.

20. Said Court of Appeals erred in failing to hold and decide that the primary examiner in the Patent Office was bound by the rules of practice of the Patent Office.

21. Said Court of Appeals erred in failing to hold and decide that the Commissioner of Patents had not followed the rules of practice of the Patent Office.

22. Said Court of Appeals erred in failing to hold and decide that the primary examiner in the Patent Office had not followed the rules of practice of the Patent Office.

23. Said Court of Appeals erred in failing to hold and decide that the Commissioner of Patents had violated rules 142 and 143 of the rules of practice of the Patent Office in reopening and rejecting relator's application for patent after the primary examiner had been reversed by the examiners in chief.

45 24. Said Court of Appeals erred in failing to hold and decide that the primary examiner in the Patent Office had violated rules 142 and 143 of the rules of practice of the Patent Office in reopening and rejecting relator's application for patent after said primary examiner had been reversed by the examiners in chief.

25. Said Court of Appeals erred in failing to hold and decide that the rules of practice of the Patent Office are as binding upon the Commissioner as upon an applicant.

26. Said Court of Appeals erred in failing to hold and decide that section 4893 of the United States statutes is mandatory upon the Commissioner of Patents.

27. Said Court of Appeals erred in failing to hold and decide that the decision of the examiners in chief was the culmination of the examination which the Commissioner of Patents is directed to cause to be made by section 4893 of the United States statutes and that when said examination culminated favorable to relator said section is mandatory upon the Commissioner of Patents to issue the patent.

Wherefore the said United States ex rel. Edward L. Chott, plaintiff in error, prays that for the errors aforesaid and other errors appearing in the record of said Court of Appeals of the District of Columbia in the above cause to the prejudice of the plaintiff in error the said judgment of the said Court of Appeals of the District of Columbia be reversed, annulled, and for naught esteemed, that said cause be remanded to the Supreme Court of the District of Columbia, with instructions to issue the writ of mandamus, as prayed for in relator's petition herein, or for such other proceedings in said cause as may be determined upon by this honorable court to the end that justice may be done in the premises.

JOSHUA R. H. POTTS,
Attorney for Plaintiff in Error.

Service of a copy of the above petition for writ of error and
46 assignment of errors acknowledged and notice thereof by citation waived.

W. S. RUCKMAN,
Attorney for Defendants in Error.

(Endorsed:) No. 2536. Court of Appeals of the District of Columbia. United States ex rel. Edward L. Chott, Plaintiff in error, vs. E. B. Moore, Commissioner of Patents and A. G. Wilkinson, Primary Examiner, Defendants in error. Petition for writ of error to Supreme Court U. S. and assignment of errors. Court of Appeals, District of Columbia. Filed Jun- 11, 1913. Henry W. Hodges, Clerk.

47 UNITED STATES OF AMERICA, *ss:*

The President of the United States to the Honorable the Judges of the Court of Appeals of the District of Columbia, Greeting:

Because in the record and proceedings, as also in the rendition of the judgment of a plea which is in the said Court of Appeals before

you, or some of you, between E. B. Moore, Commissioner of Patents, and A. G. Wilkinson, Primary Examiner, United States Patent Office, appellants, and United States ex rel. Edward L. Chott, appellee, a manifest error hath happened, to the great damage of the said appellee as by his complaint appears. We being willing that error, if any hath been, should be duly corrected, and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that then under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Supreme Court of the United States, together with this writ, so that you have the same in the said Supreme Court at Washington, within 30 days from the date hereof, that the record and proceedings aforesaid being inspected, the said Supreme Court may cause further to be done therein to correct that error, what of right, and according to the laws and customs of the United States should be done.

Witness the Honorable Edward D. White, Chief Justice of the United States, the eleventh day of June, in the year of our Lord one thousand nine hundred and thirteen.

[Seal of the Supreme Court of the United States.]

JAMES H. McKENNEY,
Clerk of the Supreme Court of the United States.

Allowed by
J. R. LAMAR,
Associate Justice of the Supreme Court of the United States.

[Endorsed:] No. 2526. E. B. Moore, Commissioner of Patents, et al. Appellants, vs. United States ex rel. Edward L. Chott. Writ of Error from Supreme Court U. S. Court of Appeals, District of Columbia. Filed Jun- 11, 1913. Henry W. Hodges, Clerk.

48 Court of Appeals of the District of Columbia.

No. 2536.

No. 12, Special Calendar.

UNITED STATES ex Rel. EDWARD L. CHOTT, Plaintiff in Error,
vs.
E. B. MOORE, Commissioner of Patents, and A. G. WILKINSON, Primary Examiner, United States Patent Office, Defendants in Error.

Know all men by these presents that we Edward L. Chott, as principal and Howard S. Austin, as surety are held and firmly bound unto E. B. Moore, and A. G. Wilkinson, in the full and just sum of $500.00 to be paid to the said E. B. Moore, his certain attorneys, executors, administrators or assigns, to which payment, well and

truly to be made, we bind ourselves, our heirs, executors and administrators jointly and severally by these presents.

Sealed with our seals and dated this 10th day of June, in the year of our Lord, One Thousand Nine Hundred and Thirteen.

Whereas lately in the Court of Appeals of the District of Columbia in a suit depending in said Court between the said E. B. Moore and A. G. Wilkinson, as appellants, and the United States upon relation of the said Edward L. Chott, as appellee, a judgment was rendered against the said United States and the said relator, and the said relator in the name of the United States having obtained a writ of error and filed a copy thereof in the clerk's office of the said court to reverse the judgment in the aforesaid suit and a citation directed to the said E. B. Moore and A. G. Wilkinson, citing and admonishing them to be and appear at the Supreme Court of the United States to be holden at Washington, within thirty days from the date thereof.

Now, the condition of the above obligation is such that if the said Edward L. Chott, in the name of the United States or otherwise, shall prosecute said writ of error to effect, and answer all costs if
49 he fail to make good, then the above obligation to be void, else to remain in full force and effect.

EDWARD L. CHOTT. [SEAL.]
HOWARD S. AUSTIN. [SEAL.]

Approved June 11, 1913.

J. R. LAMAR,
Associate Justice of the Supreme Court of the United States.

(Endorsed:) No. 2536. Court of Appeals of District of Columbia. United States ex rel. Edward L. Chott, Plaintiff in error, vs. E. B. Moore, Commissioner of Patents, and A. G. Wilkinson, Primary Examiner, Defendants in error. Bond for costs on writ of error from Supreme Court U. S. Court of Appeals, District of Columbia. Filed Jun- 11, 1913. Henry W. Hodges, Clerk.

50 UNITED STATES OF AMERICA, *ss:*

To E. B. Moore, Commissioner of Patents, and A. G. Wilkinson, Primary Examiner, United States Patent Office, Greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States, at Washington, within thirty days from the date hereof, pursuant to a writ of error, filed in the Clerk's Office of the Court of Appeals of the District of Columbia, wherein United States ex rel. Edward L. Chott is plaintiff in error and you are defendants in error, to show cause, if any there be, why the judgment rendered against the said plaintiff in error as in the said writ of error mentioned, should not be corrected, and why speedy justice should not be done to the parties in that behalf.

Witness, the Honorable J. R. Lamar, Associate Justice of the Su-

preme Court of the United States, this eleventh day of June, in the year of our Lord one thousand nine hundred and thirteen.

J. R. LAMAR,
Associate Justice of the Supreme Court of the United States.

Service accepted this 11th day of June A. D. 1913.
W. S. RUCKMAN,
Attorney for Appellants.

[Endorsed:] Court of Appeals, District of Columbia. Filed Jun- 11, 1913. Henry W. Hodges, Clerk.

51 In the Court of Appeals of the District of Columbia.

UNITED STATES ex Rel. EDWARD L. CHOTT, Plaintiff in Error,
vs.
E. B. MOORE, Commissioner of Patents, and A. G. WILKINSON, Primary Examiner, United States Patent Office, Defendants in Error.

Præcipe.

Henry W. Hodges, Clerk Court of Appeals of the District of Columbia.

SIR: Please incorporate in the transcript of record in the above entitled cause the following:

Complete transcript of the record in the Court of Appeals of the District of Columbia;
Decision of Justice Van Orsdel;
Petition for writ of error;
Order allowing writ of error;
Assignment of errors;
Acknowledgment of service and waiver of citation;
Bond;
Writ of error;
Citation;
Præcipe.

JOSHUA R. H. POTTS,
Attorney for Plainiff- in Error.

Service of copy of the above præcipe acknowledged.
W. S. RUCKMAN,
Attorney for Defendant in Error.

52 (Endorsed:) No. 2536. In the Court of Appeals of the District of Columbia. United States ex rel. Edward L. Chott, Plaintiff- in error, vs. E. B. Moore, Commissioner of Patents, and A. G. Wilkinson, Primary Examiner, United States Patent Office, Defendants in error. Designation of record on writ of error. Court of Appeals, District of Columbia. Filed Jun- 11, 1913. Henry W. Hodges, Clerk.

53 Court of Appeals of the District of Columbia.

I, Henry W. Hodges, Clerk of the Court of Appeals of the District of Columbia, do hereby certify that the foregoing printed and typewritten pages numbered from 1 to 52 inclusive contain a true copy of the transcript of record and proceedings of said Court of Appeals in the case of E. B. Moore, Commissioner of Patents, and A. G. Wilkinson, Primary Examiner, United States Patent Office, Appellants, vs. United States ex rel. Edward L. Chott, No. 2536, April Term, 1913, as the same remain upon the files and records of said Court of Appeals.

In testimony whereof I hereunto subscribe my name and affix the seal of said Court of Appeals, at the City of Washington, this 12th day of June, A. D. 1913.

[Seal Court of Appeals, District of Columbia.]

HENRY W. HODGES,
Clerk of the Court of Appeals of the District of Columbia.

Endorsed on cover: File No. 23,748. District of Columbia Court of Appeals. Term No. 194. The United States ex Rel. Edward L. Chott, plaintiff in error, vs. Thomas Ewing, Commissioner of Patents, and A. G. Wilkinson, primary examiner, U. S. Patent Office. Filed June 13th, 1913. File No. 23,748.

Office Supreme Court, U. S.
FILED
OCT 10 1914
JAMES D. MAHER
CLERK

No. 194.

IN THE

Supreme Court of the United States,

OCTOBER TERM, A. D. 1914.

THE UNITED STATES, EX REL. EDWARD L. CHOTT,
Plaintiff in Error,

vs.

THOMAS EWING, COMMISSIONER OF PATENTS, AND A. G. WILKINSON, PRIMARY EXAMINER, UNITED STATES PATENT OFFICE,
Defendants in Error.

Brief and Argument for Plaintiff in Error.

JOSHUA R. H. POTTS,
ATTORNEY FOR PLAINTIFF IN ERROR.

BARNARD & MILLER PRINT, CHICAGO

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IN THE

Supreme Court of the United States,

OCTOBER TERM, A. D. 1914.

No. 194.

THE UNITED STATES, EX REL. EDWARD L. CHOTT,
Plaintiff in Error,

vs.

THOMAS EWING, COMMISSIONER OF PATENTS, AND A. G. WILKINSON, PRIMARY EXAMINER, UNITED STATES PATENT OFFICE.
Defendants in Error.

Brief and Argument for Plaintiff in Error.

STATEMENT.

This is on writ of error to the Court of Appeals of the District of Columbia, which reversed the Supreme Court of the District of Columbia, having granted writs of mandamus against the Commissioner of Patents and a Primary Examiner in the Patent Office commanding them to issue a patent to plaintiff in error.

On or about the 24th of February, 1911, plaintiff in error filed in the Patent Office a proper application for Letters Patent on an improvement in dental broaches, paying the government fee of $15 thereon as required by the statute. (Rec., Petition,

1-2; Answer, 6.) This application was duly examined and considered by A. G. Wilkinson, one of the defendants in error herein, Primary Examiner in the Patent Office in charge of said application, and was finally rejected by him on the 23d of August, 1911. (Rec., Petition, 3; Answer, 6.) On or about October 9, 1911, appeal was duly and properly taken from this decision of the Primary Examiner to the Examiners-in-Chief in the Patent Office and the fee of $10 required by the statute was paid. (Rec., Petition, 3; Answer, 6.) As a result of this appeal the Examiners-in-Chief, on January 31, 1912, rendered a decision reversing the decision of the Primary Examiner on the ground that the references cited were from a non-analogous art. (Rec., Petition, 3; Answer, 6; Exhibit B, 12.) The application was then referred back to the Primary Examiner in accordance with Rules 142 and 143 of the Rules of Practice of the Patent Office for such action as would carry into effect the decision of the Examiners-in-Chief, but the Primary Examiner, instead of complying with these rules and passing the application to issue, proceeded to reopen the same, with the approval of the Commissioner of Patents, cited new references therein, inferentially rejected the same and withheld the patent from plaintiff in error, such action being taken by the Primary Examiner on or about February 21, 1912. (Rec., Petition, 3; Answer, 6.) Protest was made by counsel for plaintiff in error against this course of procedure and the case was referred to the Commissioner by the Primary Examiner. The Commissioner thereupon, and without granting plaintiff in error a hearing, took up said application for personal con-

sideration on its merits as to patentability, and approved of the action of the Primary Examiner, said action of the Commissioner being taken on or about March 13, 1912. (Rec., Petition, 3; Answer, 7; Exhibit B, 11 and 12.) Thereupon plaintiff in error petitioned the Commissioner requesting him to command the Primary Examiner to issue the patent and paid the final government fee of $20 on said application as required by the statute, said petition being taken on or about April 23, 1912. (Rec., Petition, 4; Answer, 7.) In response to this petition and on or about April 26, 1912, the Commissioner rendered a decision denying said petition, but, in view of protest made by counsel for plaintiff in error, appointed May 8, 1912, as a day for hearing plaintiff in error on the question of its merits as to patentability. (Rec., Petition, 4; Answer, 7; Exhibit C, 13 and 14.) Plaintiff in error filed a brief protesting against the course pursued and assailing the power and jurisdiction of the Commissioner to withhold the patent under the circumstances. (Rec., Exhibit D, 16.) Notwithstanding the protest on behalf of plaintiff in error, the Commissioner, on or about July 5, 1912, rendered a decision finally rejecting said application for patent upon the showing in the references which the Primary Examiner had inserted in the record after the reversal by the Examiners-in-Chief. (Rec., Exhibit D, 16.) On February 10, 1913, plaintiff in error filed a petition in the Supreme Court of the District of Columbia praying that writs of mandamus be granted against the said Commissioner and Primary Examiner commanding them to issue the patent on said application. (Rec., Petition, 1-6.) Respondents filed an answer and appeared by coun-

sel and fully argued the motion for the issuance of the writs. (Rec., 16.) On or about March 14, 1913, the Supreme Court of the District of Columbia, through his Honor, Mr. Justice Barnard, rendered a decision ordering the writs to issue. (Rec., 17-27.) Appeal was taken from this decision to the Court of Appeals of the District of Columbia by the Commissioner and the Primary Examiner, on March 25, 1913. (Rec., 30.) This appeal was duly argued by counsel for all of the parties hereto and on June 2, 1913, a decision was rendered by said Court of Appeals through his Honor, Mr. Justice Van Orsdel, reversing the judgment of the Supreme Court and remanding the same on the grounds that the action of the Commissioner was within his supervisory authority; that an appeal would lie from his action; and that, therefore, mandamus was not the proper remedy. (Rec., 30-35.) A writ of error to the Court of Appeals was granted and issued by this court on or about June 11, 1913, upon the following assignment of errors, reliance upon each of which is placed herein:

"1. Said Court of Appeals erred in entering judgment reversing the judgment of the Supreme Court of the District of Columbia.

2. Said Court of Appeals erred in not affirming the judgment of the Supreme Court of the District of Columbia.

3. Said Court of Appeals erred in holding and deciding that the decision of the Examiners-in-Chief was not binding upon the Commissioner of Patents.

4. Said Court of Appeals erred in holding and deciding that the relator had a right of appeal to the Court of Appeals of the District of Columbia from the action of the Commissioner of Patents.

5. Said Court of Appeals erred in holding and deciding that the Commissioner of Patents had jurisdiction to pass upon the merits of an application for a patent which was not before him by appeal taken by an applicant from an adverse decision by the Examiners-in-Chief.
6. Said Court of Appeals erred in holding and deciding that the Commissioner of Patents had authority to withold a patent after an adverse decision by a Primary Examiner in the Patent Office had been reversed by the Examiners-in-Chief.
7. Said Court of Appeals erred in holding and deciding that the Commissioner of Patents had authority to pass upon the patentability of the claims of any application for a patent except where said application comes before him by regular course of appeal under the statutes and rules of practice of the Patent Office.
8. Said Court of Appeals erred in holding and deciding that the supervisory authority of the Commissioner extended to an application which had been held allowable by the Examiners-in-Chief.
9. Said Court of Appeals erred in holding and deciding that the Commissioner of Patents need not issue a patent for an alleged invention which he personally considered neither novel nor meritorious.
10. Said Court of Appeals erred in holding and deciding that the Commissioner of Patents had authority to inspect and review an examination of an application after it comes back to him from another tribunal having appellate jurisdiction under the statutes and having held the application allowable.
11. Said Court of Appeals erred in holding and deciding that the decision of the Examiners-in-Chief was not a mandate to the Commissioner of Patents requiring him to issue the patent.

12. Said Court of Appeals erred in holding and deciding that the decision of the Examiners-in-Chief reversing a Primary Examiner is not final and binding upon the Commissioner of Patents.
13. Said Court of Appeals erred in holding and deciding that the Examiners-in-Chief are subordinate to the Commissioner of Patents under all circumstances.
14. Said Court of Appeals erred in holding and deciding that the action of the Commissioner of Patents withholding relator's patent was a proper official action.
15. Said Court of Appeals erred in failing to hold and decide that, after the Primary Examiner had been reversed by the Examiners-in-Chief, the duty of the Commissioner of Patents and Primary Examiner to issue a patent was a purely ministerial duty, enforcible by mandamus.
16. Said Court of Appeals erred in failing to hold and decide that, after the Primary Examiner had been reversed by the Examiners-in-Chief, the interference with the issuance of the patent by the Commissioner of Patents under the circumstances in this case was the exercise of purely arbitrary power without legal authority or justification.
17. Said Court of Appeals erred in failing to hold and decide that, after the Primary Examiner had been reversed by the Examiners-in-Chief, the withholding of the patent to the relator by the Commissioner of Patents, was the illegal and invalid exercise of an authority under the United States.
18. Said Court of Appeals erred in failing to hold and decide that, after the Primary Examiner had been reversed by the Examiners-in-Chief, the withholding of the patent to relator by the Commissioner of Patents, was not within his power or duty as an officer of the United States.
19. Said Court of Appeals erred in failing to

hold and decide that the Commissioner of Patents was bound by the rules of practice of the Patent Office.

20. Said Court of Appeals erred in failing to hold and decide that the Primary Examiner in the Patent Office was bound by the rules of practice of the Patent Office.

21. Said Court of Appeals erred in failing to hold and decide that the Commissioner of Patents had not followed the rules of practice of the Patent Office.

22. Said Court of Appeals erred in failing to hold and decide that the Primary Examiner in the Patent Office had not followed the rules of practice of the Patent Office.

23. Said Court of Appeals erred in failing to hold and decide that the Commissioner of Patents had violated Rules 142 and 143 of the rules of practice of the Patent Office in reopening and rejecting relator's application for patent after the Primary Examiner had been reversed by the Examiners-in-Chief.

24. Said Court of Appeals erred in failing to hold and decide that the Primary Examiner in the Patent Office had violated Rules 142 and 143 of the rules of practice of the Patent Office in reopening and rejecting relator's application for patent after said Primary Examiner had been reversed by the Examiners-in-Chief.

25. Said Court of Appeals erred in failing to hold and decide that the rules of practice of the Patent Office are as binding upon the Commissioner as upon an applicant.

26. Said Court of Appeals erred in failing to hold and decide that Section 4893 of the United States statutes is mandatory upon the Commissioner of Patents.

27. Said Court of Appeals erred in failing to hold and decide that the decision of the Examiners-in-Chief was the culmination of the examination which the Commissioner of Patents is directed to cause to be made by Sec-

tion 4893 of the United States statutes and that when said examination culminated favorable to relator said section is mandatory upon the Commissioner of Patents to issue the patent."

Since the writ was issued the said E. B. Moore has been succeeded in office as Commissioner of Patents by Thomas Ewing, and this fact has been suggested upon the record, and the title of the case changed to include the said Thomas Ewing as defendant in error. (Rec., 53.)

BRIEF.

I.

Jurisdiction.

The Judicial Code, Section 250.

U. S. ex rel. Champion Lumber Co. v. *Fisher*, 227 U. S. 445.

Albright v. *Teas*, 106 U. S. 613.

Pratt v. *Paris*, 168 U. S. 255.

Henry v. *Dick Company*, 224 U. S. 1.

II.

The Action of the Primary Examiner Reopening the Application; Citing New References; and Neglecting and Refusing to Pass the Application to Issue After He Had Been Reversed by the Examiners-in-Chief Was Beyond the Scope of His Power or Duty and Therefore Illegal.

United States Statutes:

Sec. 476 (Officers and employes.)

Sec. 481 (Duties of Commissioner.)

Sec. 482 (Duties of the Examiners-in-Chief.)

Sec. 483 (Establishment of regulations.)

Act of June 10, 1898, Ch. 423, 30 Stat. L. 440.

Sec. 2 (Additional Employes.)

Sec. 4893 (Examinaton and issuing of patents.)

Sec. 4909 (Appeals from Primary Examiners to Examiners-in-Chief.)

Sec. 4910 (From Examiners-in-Chief to Commissioner.)

Sec. 4911 (From the Commissioner to the Supreme Court, D. C.)

27 Stat. L. 436. Sec. 9. (From the Commissioner to the Court of Appeals, D. C.)

Sec. 4915 (Patents obtainable by bill in equity.)

Patent Office Rules Nos. 142-143.

U. S. v. *Eliason,* 16 Pet. 291.

In re Hirsch, 74 Fed. Rep. 931.

United States ex rel. Steinmetz v. *Allen,* 192 U. S. 543.

Caha v. *United States,* 152 U. S. 211.

Walker on Patents, 4th Ed., p. 114.

Hopkins on Patents, Vol. 1, pp. 471-473.

Webster's Dictionary, p. 461.

III.

The Action of the Commissioner of Patents in Taking up the Consideration of the Application on Its Merits, After the Primary Examiner Had Been Reversed by the Examiners-in-Chief, Was Beyond the Scope of His Power or Duty and Therefore Illegal.

U. S. ex rel. Steinmetz v. *Allen,* 22 App. C. D. C. 56.

U. S. ex rel. Steinmetz v. *Allen,* 192 U. S. 543.

Hull v. *Commissioner of Patents,* 2 McArthur 90.

Patent Act of 1836 (5 Stat. 117) Sec. 7.

Revised Statute. Sec. 4893.

IV.

Mandamus the Proper Remedy.

U. S. ex rel. Miller v. *Raum*, 135 U. S. 200.

U. S. ex rel. Dunlap v. *Black*, 128 U. S. 40.

Butterworth v. *U. S. ex rel. Hoe*, 112 U. S. 50.

United States v. *Duell*, 172 U. S. 576.

Gaines v. *Rugg*, 148 U. S. 228.

Int. Com. Com. v. *U. S. ex rel. Humboldt Steamship Co.*, 224 U. S. 474.

Lim Jew v. *United States*, 196 Fed. Rep. 736.

West v. *Hitchcock*, 19 App. Cases 333.

Moore v. *United States ex rel. Boyer*, 32 App. Cases 243.

Giant Powder Co. v. *California Powder Co., et al.*, 4 Fed. Rep. 720.

V.

Plaintiff in Error Had No Right of Appeal.

Westinghouse v. *Duncan* (1894), 2 App. D. C. 131.

Ex parte Frasch, 192 U. S. 566.

U. S. ex rel. Dunlap v. *Black*, 127 U. S. 40.

Butterworth v. *Hoe*, 112 U. S. 50.

Steinmetz v. *Allen*, 192 U. S. 543.

Lim Jew v. *United States*, 196 Fed. Rep. 736.

In re Locke, 17 App. D. C. 314.

Universal Motor Truck Co. v. *Universal Motor Co.*, 197 O. G. 533.

Universal Motor Truck Co. v. *Universal Motor Co.*, 197 O. G. 535.

In re Fullagar, 32 App. D. C. 222.

In re Mygatt, 40 App. D. C. 32.
In re Frasch, 20 App. D. C. 298.
In re Mattullath, 38 App. D. C. 497.
Revised Statutes, Sec. 4898.
Moore v. *Heany*, 34 App. D. C. 31.
Re Selden, 36 App. D. C. 428.
In re Mygatt, 26 App. D. C. 366.
Cosper v. *Gold*, 36 App. D. C. 302.
General Railway Signal Co. v. *Thullen*, 32 App. D. C. 575.
New Departure Mfg. Co. v. *Robinson*, 39 App. D. C. 504.

VI.

Plaintiff in Error Had No Right to Relief by a Bill in Equity Under Sec. 4915 Rev. Stat.

Kirk v. *Commissioner of Patents*, 37 O. G. 451.
Smith v. *Muller et al.*, 75 Fed. Rep. 612.
Westinghouse v. *Duncan*, 2 App. D. C. 131.
Hull v. *Commissioner of Patents*, 2 McArthur 90.

VII.

The Relief Afforded by an Appeal or Otherwise Must be Adequate to Bar Relief by Mandamus. Under the Circumstances in the Case at Bar a Second Appeal or a Bill in Equity Would Have Been Wholly Inadequate.

Gaines v. *Rugg*, 148 U. S. 228.
American & English Encyclopedia of Law, Volume 19, Second Edition, page 751.

L. Bucki & Son Lumber Co. v. *Atlantic Lumber Co.*, 128 Fed. Rep. 332.

Harrison v. *Clark*, 182 Fed. Rep. 765.

Universal Motor Truck Co. v. *Universal Motor Co.*, 197 O. G. 535.

VIII.

The Decision of the Court of Appeals of the District of Columbia Erroneous.

In re Drawbaugh, 9 App. D. C. 219.

Podlesak v. *McInnerney*, 26 App. D. C. 399.

Sobey v. *Holsclaw*, 28 App. D. C. 65.

Moore v. *Heany*, 34 App. D. C. 31.

In re Locke, 17 App. D. C. 314.

U. S. ex rel. Hoe v. *Butterworth*, 3 Mack. 229; 14 Sup. Ct. D. C. 229.

Butterworth v. *U. S. ex rel. Hoe*, 112 U. S. 50.

U. S. ex rel. Miller v. *Raum*, 135 U. S. 200.

U. S. ex rel. Dunlap v. *Black*, 128 U. S. 40.

U. S. ex rel. Steinmetz v. *Allen*, 192 U. S. 543.

Ex parte Frasch, 192 U. S. 566.

Gaines v. *Rugg*, 148 U. S. 228.

In re Mattullath, 38 App. D. C. 497.

Re Selden, 36 App. 428.

In re Mygatt, 26 App. D. C. 366.

Cosper v. *Gold*, 36 App. D. C. 302.

General Railway Signal Co. v. *Thullen*, 32 App. D. C. 575.

New Departure Mfg. Co. v. *Robinson* (present term), 39 App. D. C. 504.

Westinghouse v. *Duncan*, 2 App. 131.

Lim Jew v. *United States,* 196 Fed. Rep. 736.

Universal Motor Truck Co. v. *Universal Motor Co.,* 197 O. G. 533.

Universal Motor Truck Co. v. *Universal Motor Co.,* 197 O. G. 535.

In re Fullagar, 32 App. D. C. 222.

Rev. Stat., Section 4898.

ARGUMENT.

I.

Jurisdiction.

This proceeding is brought to this court under the judicial code, Section 250, which reads in part as follows:

> "Sec. 250. Any final judgment, or decree of the Court of Appeals of the District of Columbia may be re-examined and affirmed, reversed, or modified by the Supreme Court of the United States, upon writ of error or appeal, in the following cases:
>
> 5th. In cases in which the validity of any authority exercised under the United States, or the existence or scope of any power or duty of an officer of the United States is drawn in question.
>
> Except as provided in the next succeeding section the judgments and decrees of said Court of Appeals shall be final in all cases arising under the patent laws, or copyright laws, or revenue laws, or criminal laws and in admiralty cases, and, except as provided in the next succeeding section, the judgments and decrees of said Court of Appeals shall be final in all cases not reviewable as hereinbefore provided."

In the case at bar, the contention in behalf of plaintiff in error is that the action of the Commissioner of Patents and the Primary Examiner withholding the patent from plaintiff in error after the Primary Examiner had been reversed by the Examiners-in-Chief was not within the scope of their

powers or duties as officers of the United States. In the original petition for mandamus filed in the Supreme Court of the District of Columbia and appearing on pages 3 and 4 of the transcript of record herein, allegations were made as follows:

"11. That on or about the 21st day of February, 1912, the said A. G. Wilkinson, Primary Examiner, of his own motion, and without authority or jurisdiction, and contrary to the well established rules of the Patent Office, reopened said application for further consideration by him and rejected the same.

12. That afterwards and on or about the 13th day of March, 1912, at the instigation of the said A. G. Wilkinson, Primary Examiner, and without legal authority, and contrary to the rules of practice of the United States Patent Office, the said E. B. Moore, Commissioner of Patents, took up said application for personal consideration and approved the action of the said A. G. Wilkinson, Primary Examiner.

15. That, under the rules of practice of the United States Patent Office, it became and was the duty of the said A. G. Wilkinson, Primary Examiner, to allow your petitioner's said application, and to cause a patent to be issued therefore, and because of the refusal of the said A. G. Wilkinson, Primary Examiner, so to do, your petitioner was and is deprived of a legal right vested in him by the laws of the United States relating to the granting of Letters Patent for inventions and is entirely without redress or remedy in the premises, unless this honorable court by writ of mandamus shall interpose in his behalf.

16. That under the rules of practice of the United States Patent Office and the well established rules of law pertaining to such a case, it became and was the duty of the said E. B. Moore, Commissioner of Patents, to direct and command the said A. G. Wilkinson, Primary

Examiner, to allow your petitioner's said application, and to cause a patent to be issued therefore, and because of the refusal of the said C. H. Mason, Commissioner of Patents, as to do, your petitioner was and is deprived of a legal right vested in him by the laws of the United States relating to the granting of letters patent for inventions, and is entirely without redress or remedy in the premises, unless this honorable court by writ of mandamus shall interpose in his behalf."

In respondents' answer to the rule to show cause, appearing on pages 6, 7 and 8 of the transcript of record herein, it is stated as follows:

"12. Respondents deny the allegations of paragraph 12 and aver that the said A. C. Wilkinson, Primary Examiner, made an additional search, the result of which is embodied in a letter dated February 21, 1912, and that his action was made by him with the authority of the Commissioner, as shown by the said letter of the Examiner and the decision of the Commissioner dated March 11, 1912, and April 26, 1912, copies of which are annexed hereto and made a part hereof and marked, respectively, 'Respondents' Exhibits A, B and C.'

13. Respondents admit that the said C. H. Mason, Commissioner of Patents, took up the application for personal consideration and in the action dated March 11, 1912 (Respondents' Exhibit B) approved the action of the said A. C. Wilkinson, Primary Examiner, but deny that this was without legal authority and contrary to the rules of practice of the United States Patent Office, and further state that the case was taken up by the Commissioner upon reference by the Primary Examiner in view of appellant's communication filed March 2, 1912.

14. Respondents admit the allegation in this paragraph, that on April 26, 1912, the said C. H. Mason, Commissioner of Patents, refused and

declined to command the said A. G. Wilkinson, Primary Examiner, to issue said patent to petitioner as requested in relator's petition mentioned in paragraph 13, and denied said petition. (Respondents' Exhibit C.)

15. Respondents deny the allegations of this paragraph and aver that it was the duty of the said A. G. Wilkinson, Primary Examiner, to follow the ruling of the Commissioner of Patents in this matter, and that petitioner had a remedy by direct appeal from the decision of the Commissioner of Patents, as fully set forth in paragraph 16 of respondents' answer.

16. Respondents deny the allegations of this paragraph. Respondents aver that Section 481 of the Revised Statutes provides:

The Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office.

Respondents further aver that under the above statute and also Sections 483, 4883 and 4893, the Commissioner is the head of the Patent Office and is responsible for and must sign all patents issued by that bureau and that if there be any ground within the knowledge or cognizance of the Commissioner why a patent should not issue, it is his duty to refuse the patent whether or not the specific objection has been raised and acted upon by the lower tribunals and irrespective of their holding. Respondents aver that in view of the conclusion of the Commissioner of Patents that the alleged invention of relator was not new and patentable for the reason set forth in his decisions, it was his duty to reject the claims and to refuse a patent.

And for further answer respondents show that the question of whether a patent shall issue, under the law, is one within the discretion of the Commissioner of Patents subject to a direct

appeal to the Court of Appeals of the District of Columbia; that in the present case the Commissioner has not refused to act thereon; but, on the contrary, he has acted to the best of his judgment and fully set forth in his decision the reason for his action, from which action relator had a right to appeal directly to the Court of Appeals of the District of Columbia; and that under these circumstances a writ of mandamus will not lie to review and control his action.

Respondents in further answer to the rule to show cause aver that under the ruling of this court in *United States ex rel. Hodgin* v. *Simpson*, 82 O. G. 1898 C. D. 296, and inasmuch as the Commissioner of Patents is the responsible head of the patent office through whom, if any one, the relief prayed for should be obtained, while the said A. G. Wilkinson is a Primary Examiner in the Patent Office and subordinate to and subject to the official control and direction of the Commissioner of Patents, the said A. G. Wilkinson improperly has been made a party respondent and that for this reason, in addition to those heretofore mentioned, the rule to show cause should be discharged and the petition dismissed as to him."

In the action of the Commissioner, dated March 13, 1912, he stated as follows (Rec., 11-12):

"This case has been referred to me by the Primary Examiner in view of a communication by the applicant filed March 4, 1912, in which attention is directed to Rule 142, it being urged that under this rule the Examiner has no authority to reopen a case without the consent of the Commissioner upon a showing of sufficient cause, and arguing that the letter of the Examiner dated February 21, 1912, rejecting claims in view of certain patents, was therefore improper."

The Commissioner of Patents stated in his action dated April 26, 1912, and appearing on pages 12

and 13 of the transcript of record herein as follows:

> "This case has been taken up under the supervisory authority of the Commissioner for personal consideration and the additional search for prior art evidenced by the Examiner's letter of February 21, 1912, was made upon the authority of the Commissioner and approved by me on March 13, 1912. Such approval was made of record in response to applicant's communications of March 2 and March 4, 1912, and under the impression that the Examiner has specifically held that the claims were unpatentable.
>
> It is well settled that the Commissioner has authority to review a case personally and withhold a patent ever after a favorable decision by the Examiner or the Examiners-in-Chief. (*Hull* v. *Commissioner of Patents,* 2 McArthur, 90 and 125.) The Court of Appeals of the District of Columbia is on record as holding this view, in the case of *Drawbaugh* v. *Seymour, Com. of Pat.,* 77 O. G. 313, 9 App. D. C. 219, in which it is stated;"

Further the Commissioner stated in his action of July 5, 1912, appearing on page 14 of the transcript of record herein, as follows:

> "This case has been taken up by me for personal consideration of the merits of the alleged invention claimed. A date of hearing was set at which applicant might be heard upon the question of patentability, but he waived an oral hearing and filed a brief discussing only the jurisdiction of the Commissioner."

In the opinion of his honor, Mr. Justice Barnard, in the Supreme Court of the District of Columbia, appearing on pages 25 and 26 of the transcript of record herein, it was held as follows:

> "It might well be that his duties as an executive officer and superintendent of the Patent

Office, would require him to examine all patents as to form, and if frauds or mistakes were discovered, to withhold the issue of patents, and to see generally that his subordinate officers were acting in an orderly, honest and proper manner; but the whole scheme of the Patent Office tribunals, as indicated by the statutes, was to preserve independent judgment in the primary examiners, in the examiners-in-chief and in the Commissioner of Patents, when acting in a judicial capacity; and the Commissioner had no more right or authority to reverse the Board of Examiners-in-Chief in a case not appealed to him by the applicant, than would an Appellate Court have the right to reverse an inferior court in any of its judgments, when not appealed to by one or more of the parties in interest.

The duties of superintending and supervising the Patent Office are executive and administrative duties; but the duty of deciding on the merits of an application for patent is clearly a judicial duty; and in order that an applicant may have the remedy provided by Section 4915 R. S. U. S., the Commissioner must receive the case by proper appeal from the Board of Examiners-in-Chief, and must have acted upon the same so as to deny the applicant's claim for patent. Such appeal only can confer jurisdiction on him to discharge such judicial duty.

He could not by main strength take up a case that had been favorably acted upon by the proper tribunals selected for that purpose, and reverse them, and refuse to issue a patent, because, in his judgment, the claims were not patentable.

The question of patentability must in all cases depend upon the judgment of some authority, either the Primary Examiner, the Examiners-in-Chief, the Commissioner, or the Court of Appeals of the District of Columbia; and that judgment must be exercised in a legal manner by them in the order named.

If the relator in this case is to be refused

a patent under the facts shown, such patent is to be refused notwithstanding the special tribunal, selected as such because of supposed legal and scientific qualifications, has decided that it is allowable. In other words, the Primary Examiner and the Commissioner of Patents, have ignored the judgment of the Examiners-in-Chief, by assuming to take action of a judicial character, when jurisdiction was not obtained by them by any appeal or statutory authority.

If the judgment of the Board of Examiners-in-Chief can be thus ignored, why was the appeal to them provided? And why was the applicant required to pay the fee provided by statute, for such appeal?

It must be assumed, I think, from the facts in this case, that the decision of the Primary Examiner in the first instance, for whatever reason assigned, wholly rejected the applicant's claim for a patent. It must also be assumed that the decision of the Board of Examiners-in-Chief set aside that judgment and decision, because they found, in their judgment, it was wrong, and that the applicant was entitled to a patent.

Notwithstanding this judgment, the Primary Examiner, who like 'the man convinced against his will, is of the same opinion still,' cast about for additional reasons to show why his judgment, as first rendered, was correct; and by applying to the Commissioner, and the two conferring together, he secured the agreement of the Commissioner to his original judgment; and this case, while both of these officers probably acted with entire honesty of purpose, only illustrates the undesirability of having matters of a judicial character determined in an irregular way.

If a Primary Examiner and the Commissioner, for any reason, can combine in their judgment against an inventor who has applied for a patent, and has obtained a favorable decision from the Board of Examiners-in-Chief, he may never succeed in obtaining his patent.

The action, therefore, of the Primary Examiner, and of the Commissioner, seems to be unwarranted, and whether right or wrong in their judgment as to the patentability of the claims, their action so irregularly had, ought not to be sustained.

If the Primary Examiner, with or without the consent of the Commissioner, can open a case once after being reversed, may he not do so any number of times, if subsequent appeals be taken? When would a determination of applicant's claims be had if that were true?"

In the assignment of errors on behalf of respondents in the appeal taken to the Court of Appeals of the District of Columbia, appearing on page 28 of the transcript of record herein, the following assignments were made:

"2. In holding that the Commissioner of Patents had no right or authority to reverse the judgment of the Examiners-in-Chief in a case not appealed to him by the applicant.

3. In holding that the Commissioner of Patents could not lawfully take up a case that had been favorably acted upon by a Primary Examiner or the Examiners-in-Chief in the Patent Office and reverse them and refuse a patent when in his judgment the claims were not patentable.

4. In holding that the Commissioner of Patents is without jurisdiction and statutory authority to take action of a judicial character in an application which is not before him upon appeal.

5. In holding that the actions of the Primary Examiner and of the Commissioner of Patents in relator's application No. 610,571 were unwarranted and whether right or wrong in their judgment as to the patentability of the claims, their actions were irregular and ought not to be sustained.

6. In not holding that if there is any ground

> within the knowledge of the Commissioner why a patent should not issue it is within his supervisory authority and is his duty to refuse the patent, whether or not the specific objection has been raised and acted upon by the Primary Examiner or Examiners-in-Chief and irrespective of their holdings."

In the decision rendered by the Court of Appeals of the District of Columbia reversing the holding of the Supreme Court of the district, said Court of Appeals, appearing on pages 31 and 33 of the Transcript of Record herein, said as follows:

> "The questions presented are, whether the decision of the Board of Examiners-in-Chief was binding upon the Commissioner to the extent that nothing remained for him to do except to perform the mere ministerial act of issuing the patent. If this contention is correct, it disposes of the case; but, if not correct, the further question arises whether the official action of the Commissioner constituted such a final order as would have entitled relator to prosecute an appeal to this court.
>
> In *ex parte* cases, the public is represented by the Commissioner. No right of appeal is provided from the decision of the Primary Examiner or the Board of Examiners-in-Chief in behalf of the public. It cannot be that one or both of these tribunals is given final jurisdiction to an extent which forbids any review by the Commissioner; for appeal only lies from the action of the Commissioner when the Commissioner, as the executive head of the bureau, has been satisfied that an error has been committed, by which the public will be damaged."

In the assignment of errors in support of the petition for writ of error to that court, appearing on pages 36, 37 and 38 of the transcript of record herein, it is alleged as follows:

"3. Said Court of Appeals erred in holding and deciding that the decision of the Examiners-in-Chief was not binding upon the Commissioner of Patents.

5. Said Court of Appeals erred in holding and deciding that the Commissioner of Patents had jurisdiction to pass upon the merits of an application for a patent which was not before him by appeal taken by an applicant from an adverse decision by the Examiners-in-Chief.

6. Said Court of Appeals erred in holding and deciding that the Commissioner of Patents had authority to withhold a patent after an adverse decision by a Primary Examiner in the Patent Office had been reversed by the Examiners-in-Chief.

7. Said Court of Appeals erred in holding and deciding that the Commissioner of Patents had authority to pass upon the patentability of the claims of any application for a patent except where said application comes before him by regular course of appeal under the statutes and rules of practice of the Patent Office.

8. Said Court of Appeals erred in holding and deciding that the supervisory authority of the Commissioner extended to an application which had been held allowable by the Examiners-in-Chief.

9. Said Court of Appeals erred in holding and deciding that the Commissioner of Patents need not issue a patent for an alleged invention which he personally considered neither novel nor meritorious.

10. Said Court of Appeals erred in holding and deciding that the Commissioner of Patents had authority to inspect and review an examination of an application after it comes back to him from another tribunal having appellate jurisdiction under the statutes and having held the application allowable.

11. Said Court of Appeals erred in holding and deciding that the decision of the Examiners-

in-Chief was not a mandate to the Commissioner of Patents requiring him to issue the patent.

14. Said Court of Appeals erred in holding and deciding that the action of the Commissioner of Patents withholding relator's patent was a proper official action.

15. Said Court of Appeals erred in failing to hold and decide that, after the Primary Examiner had been reversed by the Examiners-in-Chief the duty of the Commissioner of Patents and Primary Examiner to issue a patent was a purely ministerial duty enforcible by mandamus.

16. Said Court of Appeals erred in failing to hold and decide that, after the Primary Examiner had been reversed by the Examiners-in-Chief, the interference with the issuance of the patent by the Commissioner of Patents under the circumstances in this case was the exercise of purely arbitrary power without legal authority or justification.

17. Said Court of Appeals erred in failing to hold and decide that, after the Primary Examiner had been reversed by the Examiners-in-Chief, the withholding of the patent to the relator by the Commissioner of Patents, was the illegal and invalid exercise of an authority under the United States.

18. Said Court of Appeals erred in failing to hold and decide that, after the Primary Examiner had been reversed by the Examiners-in-Chief, the withholding of the patent to relator by the Commissioner of Patents, was not within his power or duty as an officer of the United States.

21. Said Court of Appeals erred in failing to hold and decide that the Commissioner of Patents had not followed the rules of practice of the Patent Office.

22. Said Court of Appeals erred in failing to hold and decide that the Primary Examiner in the Patent Office had not followed the rules of practice of the Patent Office.

23. Said Court of Appeals erred in failing to hold and decide that the Commissioner of Patents had violated rules 142 and 143 of the rules of practice of the Patent Office in reopening and rejecting relator's application for patent after the Primary Examiner had been reversed by the Examiners-in-Chief.

24. Said Court of Appeals erred in failing to hold and decide that the Primary Examiner in the Patent Office had violated rules 142 and 143 of the rules of practice of the Patent Office in reopening and rejecting relator's application for patent after said Primary Examiner had been reversed by the Examiners-in-Chief.

25. Said Court of Appeals erred in failing to hold and decide that the rules of practice of the Patent Office are as binding upon the Commissioner as upon an applicant.

26. Said Court of Appeals erred in failing to hold and decide that Section 4893 of the United States statutes is mandatory upon the Commissioner of Patents.

27. Said Court of Appeals erred in failing to hold and decide that the decision of the Examiners-in-Chief was the culmination of the examination which the Commissioner of Patents is directed to cause to be made by Section 4893 of the United States statutes and that when said examination culminated favorable to relator said section is mandatory upon the Commissioner of Patents to issue the patent."

From these quotations it appears clear that the existence of the power in the Commissioner or the Primary Examiner to withhold the patent under the circumstances in this case was directly assailed by plaintiff in error and was brought forward as the chief ground of each of the decisions made herein. At the very start when the Primary Examiner reopened this case for the citation of further references, his attention was drawn to rule 142 and to

the fact that he was violating this rule and therefore acting improperly. (See Transcript of Record, pp. 11 and 12.) Then, when the Commissioner undertook to consider the application on its merits, counsel for plaintiff in error declined to discuss the merits before the Commissioner, but filed a brief assailing the jurisdiction or power of the Commissioner to make any ruling whatever affecting the merits of the application. (See Transcript of Record, p. 14.)

When the case was decided by the Supreme Court of the District of Columbia, it was specifically held that neither the Commissioner or the Primary Examiner had authority to withhold the patent under the circumstances, and that their action was therefore unwarranted and irregular and not to be sustained. In this connection it was stated as follows, as appears on page 26 of the Transcript of Record:

> "If a Primary Examiner and the Commissioner, for any reason, can combine in their judgment against an inventor who has applied for a patent, and has obtained a favorable decision from the Board of Examiners-in-Chief, he may never succeed in obtaining his patent.
>
> The action, therefore, of the Primary Examiner, and of the Commissioner, seems to be unwarranted, and whether right or wrong in their judgment as to the patentability of the claims, their action so irregularly had, ought not to be sustained."

In reversing the Supreme Court, the Court of Appeals, as appears on page 31 of the Transcript of Record, said:

> "The questions presented are, whether the decision of the Board of Examiners-in-Chief was binding upon the Commissioner to the extent that nothing remained for him to do except to

> perform the mere ministerial act of issuing the patent. If this contention is correct, it disposes of the case; but, if not correct, the further question arises whether the official action of the Commissioner constituted such a final order as would have entitled relator to prosecute an appeal to this court."

The court then proceeded to find that the Commissioner had power to withhold the patent and also that plaintiff in error had a right of appeal.

It thus appears that the main question, and the main contention appearing all the way through this proceeding, is whether or not the Commissioner or Primary Examiner had jurisdiction or power to make any ruling whatever under the circumstances, or in other words, the existence or scope of the power or duty of these two officers of the United States is drawn in question. In this connection it is desired to direct attention to a recent decision of this court in *U. S. ex rel. Champion Lumber Co.* v. *Fisher, Secretary of the Interior*, 227 U. S. 445, in which the opinion was delivered by Mr. Justice Day, who, on pages 451 and 452, stated as follows:

> "The petitioner did not challenge nor did the court pass upon the validity of any authority exercised under the United States, nor was the existence or extent of the authority or duty of an officer of the United States drawn in question in the sense in which it is used in the statute, that is, *brought forward and made a ground of the decision.* The statutes under which the officers of the United States acted were concededly valid and the authority exerted was lawful and within the powers of the officers if the facts justified their action. The petitioner's real attack upon the secretary and the commissioner was because the facts shown did not war-

> vent the exercise of the power given by law." (Italics mine.)

In the present instance, it is contended, that the question of patentability was not properly before the Commissioner or the Primary Examiner after the reversal by the Examiners-in-Chief, and that neither of them had any jurisdiction or power to make any ruling on that question whatever. In other words the existence and scope of the power of officers of the United States is directly drawn in question and has been brought forward as a ground of decision. These circumstances, it is thought, make it clear that the present case falls fairly within the statute.

It may be urged that this proceeding is a case arising under the patent laws and that therefore the decision of the Court of Appeals was final and not reviewable by this court. However, in this connection it is desired to direct attention to the decision of this court in *Albright v. Teas*, 106 U. S. 613, in which it was held as follows:

> "We search the bill in vain to find any government existing these questions. It makes no issue showing the construction of the patents granted the appellee or their validity or their infringement. *Wilson v. Sandford*, 10 How. 99; *Hartell v. Tilghman*, 99 U. S. 547; *Goodyear Rubber Co. v. Mitchell*, 62; *Mowry v. Whitney*, 14 Wall. 620; *Blanchard v. Sprague*, 1 Cliff. 288; *Hill v. Whitcomb*, 1 Holmes 227."

See also to the same effect the decision in *Pratt v. Paris Company*, 168 U. S. 255, in which it was held as follows:

> "There is a clear distinction between a case and a question arising under the patent laws. The former arises when a plaintiff in his open

> ing pleading ... for if a bill, complaint or declaration, ... sets up a right under the patent laws or a ground for recovery."

See also the comparatively recent decision of this court in *Kinsey v. Birdsell Company*, 194 U. S. 1, in which the opinion was delivered by Mr. Justice Lurton, who, on page 10, stated as follows:

> "We are unable to concur in these views. Time. We do not prescribe the jurisdiction of courts, federal or state, but only give effect to it as fixed by law. If a bill asserts a right under the patent law to sell a patented machine subject to restrictions as to its use, and charges a use in violation of the restrictions to be an infringement of the patent, which presents a question of the extent of the patentee's privilege, which, if determined one way, brings the prohibited use within the provisions of the patent law, or, if determined the other way, brings that operation only within principles of general law, obviously a suit for infringement, which must turn upon the scope of the monopoly or privilege secured to a patentee, presents a case arising under the patent law. The jurisdiction of the Circuit Court over such cases has for more than a century been exclusive, to the express terms of the statute, although, for the most part, its jurisdiction over other kinds of cases arising under the constitution and laws of the United States is only concurrent with that of the state courts." (Italics ours.)

In the present controversy there is as yet no patent and therefore no question as to the scope of the monopoly is presented in the case, but as the contract, the case arises under the general right of a resident of the United States to have rights which have been finally adjudicated in his favor enforced by mandamus. To illustrate, suppose plaintiff in

error had been paying a casual visit to the Patent Office and dropped a valuable diamond scarf pin in one of the corridors, which, on being found, was delivered to the Commissioner, and he, claiming to be the head of the bureau and to have supervisory authority over all persons and things in the Patent Office, withheld the pin from plaintiff in error. A proceeding in replevin or otherwise to recover the pin would not be a case arising under the patent laws but a case arising under the general right of private property. Looking at the matter in a different light, suppose plaintiff in error had already obtained his patent and that somebody had stolen the same from him. A proceeding in replevin in a state court would not be a case arising under the patent laws but one arising under the general right of private property. From these considerations, it is thought clear, that the present case is not a case arising under the patent laws; but, on the contrary, a case arising under the general law which gives a resident of the United States the right to have rights and interests, finally adjudicated, enforced by mandamus.

II.

The action of the Primary Examiner reopening the application; citing new references; and neglecting and refusing to pass the application to issue after he had been reversed by the Examiners-in-Chief was beyond the scope of his power or duty and therefore illegal.

The statutes, regulations and rules of practice of the Patent Office applicable to a case of this kind,

render the course to be pursued by the Primary Examiner and the applicant very clear. The statutes bearing on this case are as follows:

Sec. 476 (Officers and Employes):

"There shall be in the Patent Office a commissioner of Patents, one assistant commissioner, and three examiners-in-chief, *who shall be appointed by the President by and with the advice and consent of the Senate.* All other officers, clerks and employes authorized by law for the office shall be appointed by the Secretary of the Interior upon the nomination of the Commissioner of Patents." (Italics mine.)

Sec. 481 (Duties of Commissioner):

"The Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents *directed by law;* and he shall have charge of all books, records, papers, models, machines and other things belonging to the Patent Office." (Italics mine.)

Sec. 482 (Duties of the Examiners-in-Chief):

"The Examiners-in-Chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be on the written petition of the appellant to *revise and determine upon the validity of the adverse decisions of examiners upon applications for patents* and for reissues of patents, and in interference cases; and, when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them." (Italics mine.)

Sec. 483 (Establishment of Regulations):

"The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office."

Act of June 10, 1898, Ch. 423, 30 Stat. L. 440, Sec. 2 (Additional Employes):

> "That for the purpose of enabling the Commissioner of Patents to carry out the provisions of this act, the Secretary of the Interior is hereby authorized to appoint from time to time in the manner already provided for by law, such additional number of principal examiners, assistant examiners, first-class clerks, copyists, laborers, assistant messengers and messenger boys as he may deem necessary. * * *"

Sec. 4893 (Examination and Issuing of Patents):

> "On the filing of any such application and the payment of fees required by law, the Commissioner of Patents *shall cause an examination to be made* of the alleged new invention or discovery, and if on such examination, it shall appear that the claimant is justly entitled to the patent under the law, and that the same is sufficiently useful and important, the Commissioner *shall* issue a patent therefor." (Italics mine.)

Sec. 4909 (Appeals from Primary Examiners to Examiners-in-Chief):

> "Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference may appeal from the decision of the primary examiner, or the examiner in charge of interferences in such case, *to the board of examiners-in-chief;* having once paid the fee for such appeal." (Italics mine.)

Sec. 4910 (From Examiners-in-Chief to Commissioner):

> "If such party is dissatisfied with the decision of the examiners-in-chief, *he may,* on payment of the fee prescribed, *appeal to the Commissioner in person.*" (Italics mine.)

Sec. 4911 (From the Commissioner to the Supreme Court, D. C.):

"If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting *in banc.*"

27 Stat. L. 436, Sec. 9 (From the Commissioner to the Court of Appeals, D. C.):

"The determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the Supreme Court of the District of Columbia, in pursuance of the provisions of Sec. 780 of the Revised Statutes of the United States, relating to the District of Columbia, shall hereafter be and the same is hereby vested in the Court of Appeals created by this act; and in addition, any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said court of appeals."

Sec. 4915 (Patents Obtainable by Bill in Equity):

"Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia, upon appeal from the Commissioner, the applicant may have remedy by bill in equity, and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in the claim, or for any part thereof, as the facts in the case may appear, and such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party, a copy of the bill

shall be served on the Commissioner; and all expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not." (N. B.—A subsequent statute gives the Court of Appeals of the District of Columbia the jurisdiction in appeals provided for by the last section, but such subsequent section is not of interest here, since no question is raised as to the jurisdiction of said court in such cases.)

The regulations and rules of practice established by the Commissioner of Patents with the approval of the Secretary of the Interior, applicable to the present case, are as follows:

"142. Cases which have been heard and decided by the Commissioner on appeal will not be reopened except by his order; cases which have been decided by the examiners-in-chief will not be reheard by them, when no longer pending before them, without the written authority of the Commissioner; *and cases which have been decided by either the Commissioner or the examiners-in-chief will not be reopened by the primary examiner without like authority, and then only for the consideration of matters not already adjudicated upon, sufficient cause being shown.*"

"143. * * * *Ex parte* cases decided by an appellate tribunal will, after decision, be remanded at once to the primary examiner, subject to applicant's right of appeal, *for such action as will carry into effect the decision, or for such further action as the applicant is entitled to demand.*" (Italics mine.)

It is submitted that the above quoted statutes make it clear that an applicant for a patent has a right to appeal from an adverse decision of the Primary Examiner to the Examiners-in-Chief, and that it is the duty of the Examiners-in-Chief to revise and

correct the decision of the Primary Examiner in case in their judgment, the same is erroneous. The rules also render it clear that after a case has been decided by the Examiners-in-Chief it cannot be reopened by the Primary Examiner without express authority from the Commissioner of Patents, *"and then only for the consideration of matters not already adjudicated upon, sufficient cause being shown,"* and that the only course left open to the Primary Examiner after the reversal by the Examiners-in-Chief was to *"carry into effect the decision"* of the Examiners-in-Chief in the absence of any further action demanded *by the applicant.* The record shows, page 10, Respondent's Exhibit A, that the Primary Examiner reopened this case, with the approval of the Commissioner and against the protest of counsel for applicant (see record, page 12, Respondent's Exhibit C, and page 14, Respondent's Exhibit D), and reconsidered the same, and absolutely refused to carry into effect the decision of the Examiners-in-Chief reversing him. That the Commissioner of Patents and the Primary Examiner are bound by the statutes quoted is too well settled to require citation of authority, and that both the Commissioner of Patents and the Primary Examiner are bound by the rules of practice and must follow the same has been definitely decided by this court in an opinion rendered by Mr. Justice McKenna, in *United States ex rel. Steinmetz* v. *Allen,* 192 U. S. 543, pages 556 and 566, in which it was held as follows:

> 556. "By Sec. 486 of the Revised Statutes, the Commissioner of Patents, subject to the approval of the Secretary of the Interior, is empowered to establish from time to time regulations not inconsistent with law for the con-

duct of proceedings in the Patent Office. The Commissioner of Patents, exercising the power conferred, established among other rules of practice, Rule 41. It thereby became a rule of procedure and constituted, in part, the powers of the Primary Examiner and Commissioner. In other words, it became an authority to those officers, and, necessarily, an authority 'under the United States.'"

566. "The Commissioner of Patents is primarily charged with granting and issuing patents. Applications for patents are made to him (Sec. 4888 * * * Revised Statutes) and his superintendence should be exercised to secure the rights which the statutes confer on inventors. The first of these rights is a hearing. If that be denied other rights cannot accrue. The Commissioner justifies his decision by the rules of the Patent Office and long practice under them. If there is inconsistency between the rules and statutes, the latter must prevail. *But the Primary Examiner did not follow the rules.* The rules provide that if an appeal be *regular in form* (italics ours), he shall within five days of the filing thereof furnish the Examiners-in-Chief with a written statement of all of the grounds of his decision and of all points involved in the appeal, with copies of the rejected claims and with the references applicable thereto. The regularity of the appeal in form is not questioned in the case at bar, and *it was the duty of the Examiner to answer the appeal* by furnishing the Examiners-in-Chief the statement provided for in Rule 145. *A petition to the Commissioner was not necessary except to make the Examiner perform his duty.*" (Italics mine.)

See also the decision of this court in *United States v. Eliason*, 16 Pet. 291, 301, in which it was held as follows:

"The Secretary of War is the regular con-

stitutional organ of the President for the administration of the military establishment of the nation; and rules and orders publicly promulgated through him must be received as the acts of the executive and as such, be binding upon all within the sphere of his legal and constitutional authority. Such regulations cannot be questioned or denied because they may be thought unwise or mistaken."

See also *In re Hirsch,* 74 Fed. Rep. 931, in which it was held as follows:

> "Sec. 251 authorizes the Secretary of the Treasury to prescribe rules and regulations not inconsistent with law, to be used under and in the execution and enforcement of the various provisions of the revenue laws. *Regulations made by the head of one of the departments of the government, in pursuance of a statute authorizing them to be made, have the force of law over those to be affected thereby."* (Italics mine.)

That this court will take judicial notice of the rules of practice of the Patent Office see *Caha* v. *United States,* 152 U. S. 211-222, in which it was held as follows:

> "It may be laid down as a general rule, deducible from the cases, that wherever, by the express language of any act of Congress, power is entrusted to either of the principal departments of government, to prescribe rules and regulations for the transaction of business in which the public is interested, and in respect to which they have a right to participate, and by which they are controlled, the rules and regulations prescribed in pursuance of such authority become a mass of that body of public records of which the courts take judicial notice."

It is also desired to direct the attention of the

court to the following authorities bearing upon the same subject. In Walker on Patents, 4th edition, page 114, the rule applicable to a case of this kind is stated as follows:

> "And all appeals must be heard on the case as submitted to the Primary Examiner. No appeal, therefore, should be taken until the application is in such a condition that the patent will issue if the decision of the Primary Examiner is reversed. If that decision is reversed by the Board of Examiners-in-Chief, the Primary Examiner can require no amendment, but *must pass the case for issue.*" (Italics mine.)

See also Hopkins on Patents, Volume 1, page 471, which reads as follows:

> "Where, on appeal from an interlocutory decree amending a perpetual injunction, the court necessarily examines and determines the entire merits of the cause, its power to decree is not limited to the matter of the injunction alone, but extends to the whole merits and its decision is final and conclusive on every point actually decided. Consequently the court below has no power to modify in any respect a decree which is thus affirmed, but must give it effect in the very terms of the decree in the Appellate Court."

And further, on page 473, as follows:

> "The doctrine of *res adjudicata* rests upon the maxim that there should be an end to litigation. No doctrine rests upon sounder principles of public policy, or is more entitled to a wide application. If, under an appeal from a decree awarding an injunction, this court obtained such a record as to enable it, with justice to the parties to the appeal, to hear and consider the merits of the cause, it would be most anomalous if we have not the power to decide. *The judicial function of considering in-*

volves the function of determining. The decision of an Appellate Court is final, and no second appeal is maintainable, except as to matters reserved or proceedings subsequent to the first appeal." (Italics mine.)

Section 482 Rev. Stat., specifically provides that it shall be the duty of the Examiners-in-Chief to "revise and determine upon the validity of adverse decisions of examiners upon applications for patents." Webster's Imperial Dictionary, published by George W. Ogilvie, Chicago, 1907-8, gives the following as definitions of the word "determine," on page 461:

"1. To fix the bounds; to mark off; to settle; to fix; to establish.

5. To terminate or decide as a controverted question; an end, as, the court *determined* the cause."

It thus appears that the Examiners-in-Chief have full authority to determine upon the validity of any decision of a Primary Examiner presented to them by appeal. The duty devolved upon the Examiners-in-Chief is not for the mere expression of an opinion which the Primary Examiner may follow or not at his discretion, but the actual and final determination of the rights of the appellant, subject, of course, to his right of further appeal. A right of appeal necessarily involves the right to have the decision or ruling of the lower tribunal reversed by the appellate tribunal, and, to constitute more than a mere idle ceremony, such a reversal must be final and conclusive on the subordinate tribunal.

It is submitted that these authorities render it clear that the Primary Examiner could do nothing in the application at issue after he was reversed by

the Examiners-in-Chief, who have appellate jurisdiction over him, but allow the application and cause the same to pass to issue as a patent, except upon written authority of the Commissioner, "sufficient cause being shown," "and then only for the consideration of matters not already adjudicated upon." No such cause has been shown. The additional references cited by the Primary Examiner were merely some more references of the same general type as he cited in the first instance, and which were held by the Examiners-in-Chief to be improper references, for the reason that they came from foreign and non-analogous arts. (See record, Respondent's Exhibit A, pages 9, 10 and 11.) The arts which these new references came from were quite as foreign and non-analogous as those the Examiners-in-Chief held to be improper. Moreover the question of novelty had been already adjudicated upon by the Examiners-in-Chief, and by the express terms of Rule 142 was not open to reconsideration. It thus appears that the action of the Primary Examiner in reopening this application for the further citation of references and further consideration by him was wholly beyond the scope of his power or duty and was therefore illegal.

III.

The action of the Commissioner of Patents in taking up the consideration of the application on its merits, after the Primary Examiner had been reversed by the Examiners-in-Chief, was beyond the scope of his power or duty and therefore illegal.

It might be urged with some force, that the interference of the Commissioner in this case constituted

to some extent an excuse for the Examiner. However this may be, it is urged that there is absolutely no excuse for the Commissioner. As pointed out above, the rules of practice lay down clearly the course which is to be pursued in case the Primary Examiner is reversed by the Examiners-in-Chief, and this court held distinctly in the Steinmetz case, 192 U. S. 543, and other cases, cited above, that both the Commissioner and the Examiners *must follow these rules.* As bearing upon the power or duty of the Commissioner in a case of this kind, it is desired to direct attention also to the decision of the Court of Appeals of the District of Columbia, in the same case, reported as *United States ex rel. Steinmetz* v. *Allen,* 22 App. C., D. C., page 56, fifth paragraph of the syllabus, which is as follows:

> "The Commissioner of Patents, in all matters involving the validity and patentability of claims, and priority of invention, *exercises only an appellate jurisdiction,* but in matters of practice and procedure, *not involving the merits and final rejection of claims,* he acts in a supervisory capacity as head of the Patent Office and his act is final and not reviewable on appeal." (Italics mine.)

Following this doctrine the Court of Appeals in that case held that the question involved was a question of practice and procedure, and that, therefore, mandamus did not lie. This case was reversed by this court in *U. S. ex rel. Steinmetz* v. *Allen,* 192 U. S. 543, *supra,* on the ground that Rule 41 of the Rules of Practice of the Patent Office was invalid and that *the rules of the Patent Office were binding on the Primary Examiner and Commissioner, and that the rules had not been followed.* This particular pars-

graph of the syllabus was not directly passed upon by this court in its decision, but it is apparent from said decision that this statement of the supervisory authority of the Commissioner is even too broad and that certainly the Commissioner has no authority to pass upon the validity and patentability of claims, *unless the question comes to him by regular course of appeal*. The statutes and rules give an applicant the right to appeal to the Commissioner in person, *from an adverse decision of the Examiners-in-Chief*, but they do not give the Primary Examiner a right to appeal to the Commissioner in such a case, and the Primary Examiner in this case never attempted to take such an appeal. The Commissioner attempted to justify his action in the matter by citing a decision of the Supreme Court of the District of Columbia rendered in *Hall v. Commissioner of Patents*, 2 McArthur 30, in which a writ of mandamus in a similar case was refused. This case was decided in January, 1875, and long before the decision of this court and the Court of Appeals in the Steinmetz case, *supra*. There was a strong dissenting opinion rendered in the Hall case by Mr. Justice McArthur and concurred in by another justice, which, in view of the later decision of this court in the Steinmetz case, it is submitted, expresses the correct principle of law involved. On page 110 this dissenting opinion reads as follows:

> "The sections following this provide for an appeal where the party is dissatisfied with the decision of the Examiners-in-Chief to the Commissioner in person, and then for an appeal to the Supreme Court of this district from the decision of the Commissioner, if it is adverse to the applicant. Here we have a system judicial in

> vorable decision, and he cannot evade it without dispensing with the law itself. *He has no right to take up cases except by an appeal, overrule decisions, suspend proceedings and refuse patents at his own rule and pleasure.*
>
> Where any new fact is developed raising new grounds of objection, or where fraud is discovered, or where any gross irregularity appears, then it is competent, no doubt, for the Commissioner, by virtue of his supervisory power, to direct a re-examination of the case. In this very case there was a re-examination by order of the Commissioner and the Board affirmed their previous decision in favor of Hull. *But when a case has been regularly presented and duly examined and decided favorably to the applicant on its merits, it is the duty of the Commissioner to prepare the patent and the law, as we have seen, expressly makes it mandatory upon him in all cases.*" (Italics mine.)

No new fact has been developed in this case nor is there any charge of fraud or other irregularity, nor did the Commissioner direct a re-examination of the case, so that the case could have been again presented to the Examiners-in-Chief, but he undertook to decide this case arbitrarily when he had no authority or jurisdiction so to do. As pointed out above, the new references cited by the Primary Examiner were of the same class as had been held to be improper in this case by the Examiners-in-Chief, and, moreover, are presumed to have been before the Examiner and before the Examiners-in-Chief when they reversed the Examiner, since it is a well settled doctrine of patent law that every one has constructive notice of the issue and existence of a patent. This being so, it would seem that this case had been fully considered on its merits and finally

adjudicated and under the above noted doctrines there was no authority in the Commissioner to disturb that decision and that his action in this case was wholly beyond the scope of his power or duty and therefore illegal.

In this connection, attention is also directed to the wording of Section 7 of the Patent Act of 1836 (5 Stat. 117), which was in part as follows:

> "And be it further enacted, That on the filing of any such application, description and specification, and the payment of the duty hereinafter provided, the Commissioner *shall make, or cause to be made,* an examination of the alleged new invention or discovery, and if, on any such examination, it shall not appear *to the Commissioner* that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been published or described in any printed publication in this or any foreign country or had been in public use or on sale with the applicant's consent or allowance prior to the application, *if the Commissioner* shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. But whenever, on such examination, it shall appear *to the Commissioner,* that the applicant was not the original and first inventor or discoverer thereof, or that any part of that which it is claimed as new had been invented or discovered, or patented or described in any printed publication in this or any foreign country as aforesaid, or that the description is defective and insufficient, he shall notify the applicant thereof, giving him briefly such information and references as may be useful in judging of the propriety of renewing his application, or of altering his specification to embrace only that part of the invention or discovery which is new * * *." (Italics mine.)

This section makes it clear that everything was left directly to the discretion of the Commissioner and that any examination made by others than the Commissioner was simply to result in a report to the Commissioner and he was to exercise his discretion in issuing the patent. The statute controlling the action of the Commissioner in issuing patents has been amended to read as follows:

> "Sec. 4893. On the filing of any such application and the payment of the fees required by law, the Commissioner of Patents *shall cause an examination to be made* of the alleged new invention or discovery and if on *such examination* it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner *shall* issue a patent therefor." (Italics mine.)

This section of the statute as amended makes it clear that all discretion in the Commissioner in issuing patents under the circumstances mentioned was withdrawn. Originally the statute provided that the Commissioner was to make, *or cause to be made,* an examination, whereas the statute at present provides specifically that the Commissioner *shall cause an examination to be made,* thus rendering it clear that the power of the Commissioner to make an examination in the first instance was specifically withdrawn. Moreover, the former statute provided specifically that it was to appear "to the Commissioner" that the invention was new and of sufficient importance before he was to issue a patent therefor. The statute now specifically provides that if the examination which the Commissioner is to cause to be made shall result in a finding that the claimant

is justly entitled to a patent, the Commissioner *shall* issue the patent. The statute does not provide that he *may* issue a patent under these circumstances, but that he *must*. Thus the statute is made mandatory upon the Commissioner in the case the examination which he has caused to be made results favorably to the applicant. Other statutes provide that a part of this examination shall consist in an appeal to the Examiners-in-Chief if the decision of the Primary Examiner is adverse to the applicant. When the appeal taken by plaintiff in error in the present case resulted favorably to him, this was the culmination of the examination which the Commissioner is specifically directed to cause to be made, and when that examination made it appear that plaintiff in error was justly entitled to a patent, the statute made it mandatory upon the Commissioner to issue that patent without quibble or delay.

IV.

Mandamus the Proper Remedy.

It has been repeatedly held by this court that where a subordinate officer is overruled by a superior officer having appellate jurisdiction over him, mandamus will lie to cause said subordinate officer to obey the decision of the superior officer. In this connection see *United State ex rel. Miller* v. *Raum*, 135 U. S. 200, in which it was held as follows:

> "When a subordinate officer is overruled by his superior officer having appellate jurisdiction over him, *his duty to obey the decision of such superior is a ministerial duty which he can be compelled by mandamus to perform.*" (Italics mine.)

See, also, *United States ex rel. Dunlap* v. *Black*, 128 U. S. 40, in which it was held:

> "If the Commissioner of Pensions refuses to carry out the decision of the Secretary of the Interior * * * his superior officer * * * he may be required to show cause why mandamus should not issue for the reason that *so far as respects the matter decided, there is no discretion or exercise of judgment left.*" (Italics mine.)

Both of these cases were cases arising in the Department of the Interior, in which a superior officer having appellate jurisdiction reversed a subordinate officer, and said subordinate officer was compelled by mandamus to carry into effect the decision of his superior officer. In the present case a subordinate officer has been reversed by his superior officers having appellate jurisdiction over him, and these cases, it is submitted, are exactly in point.

The fundamental principle of law underlying the issuance of writs of mandamus has been set forth in numerous decisions, and it is desired to direct particular attention to a few of these. In the case of *Butterworth* v. *U. S. ex rel. Hoe*, 112 U. S. 50, this whole subject as bearing upon this case is reviewed extensively in a lucid and well considered opinion rendered by Mr. Justice Matthews, and it is desired to quote extracts therefrom as follows:

> Page 57. "It is the maxim of the law, admitting few if any exceptions, that the duty laid upon a public officer, for the benefit of a private person is enforcible by judicial process."
>
> Page 59. "The claim is examined in the first instance by a primary examiner assigned to the class to which it belongs; if twice rejected by him, the applicant is entitled, Rev. Stat., Sec.

No. 4909, to appeal from his decision to that of the board of examiners-in-chief, constituted a tribunal for that purpose and from their decision, *if adverse,* he may appeal to the Commissioner in person. Rev. Stat. No. 4910."

Pages 60 and 61. "It is evident that the appeal thus given to the Supreme Court of the District of Columbia from the decision of the Commissioner is not the exercise of ordinary jurisdiction at law or in equity on the part of that court, but is one step in the statutory proceeding under the patent laws whereby that tribunal is interposed in aid of the Patent Office although not subject to it. Its adjudication although not binding upon any who choose by litigation in courts of general jurisdiction to question the validity of any patent thus awarded, is, nevertheless conclusive upon the Patent Office itself, for, as the statute declares, Rev. Stat., Sec. No. 4914 it 'shall govern further proceedings in the case.'

The Commissioner cannot question it. He is bound to record and obey it. The failure or refusal to execute it by appropriate action would undoubtedly be corrected and supplied by suitable judicial process. The decree of the court is the final adjudication upon the question of right; everything after that dependent upon it is merely in execution of it; it is no longer a matter of discretion, but has become imperative and enforcible. It binds the whole Department, the Secretary, as well as the Commissioner, for it has settled the question of title so that a demand for the signatures necessary to authenticate the form of instrument and evidence the grant may be enforced. It binds the Secretary by acting directly upon the Commissioner for it makes the action of the latter final by requiring it to conform to the decree.

Congress has thus provided four tribunals for hearing applications for patents, with three successive appeals, in which the Secretary of the Interior is not included, giving jurisdic-

tion, in appeals from the Commissioner, to a judicial body independent of the Department, as though he were the highest authority on the subject within it. And to say that, under the name of direction and superintendence, the Secretary may annul the decision of the Supreme Court of the District, sitting on appeal from the Commissioner, by directing the latter to disregard it, is to construe a statute so as to make one part repeal another, when it is evident both were intended to coexist without conflict."

Page 62. "It certainly cannot be successfully claimed that, to a writ of mandamus issued out of a court of competent jurisdiction, commanding the Commissioner of Patents to record and execute the judgment of the Supreme Court of the District, reversing on an appeal from his decision refusing a patent in any case other than an interference, or the decree of a Circuit Court of the United States in any case under Rev. Stat. No. 4915, requiring a patent to be issued to the claimant, it would be a sufficient answer that he had been directed by the Secretary of the Interior not to do so. If not, it must be, and is, because the decision of the Commissioner, as originally rendered, or that correction of it required by the judicial proceedings specified in the two sections of the statutes referred to, is final and conclusive upon the department."

Page 63. "The law gives express appeals from the decision of the Commissioner, or, in cases where technical appeals are not given, other modes of review by judicial process. It gives no such appeal from him to the Secretary. If it exists, it is admited it is only by an implication which discovers an appeal in the power of direction and superintendence. That power does not necessarily, *ex vi termini* include a technical appeal; and *the principle applies that where a special proceeding is expressly ordained for a particular purpose, it is presumably exclusive.*"

Page 64. "*The true conclusion, therefore, is, that in matters of this description in which the action of the Commissioner is quasi-judicial, the fact that no appeal is expressly given to the Secretary is conclusive that none is to be implied.*"

Page 66. "The act of 1861, Ch. 88, 12 Stat. 246, created the office of the examiners-in-chief, 'for the purpose of securing greater uniformity of action in the grant and refusal of letters patent.' 'To be composed of persons of competent legal knowledge and scientific ability whose duty it shall be, on the written petition of the applicant for that purpose being filed, *to revise and determine upon the validity of decisions made by examiners when adverse to the grant of letters patent;* and also to revise and determine, in like manner, upon the validity of the decision of examiners in interference cases, and when required by the Commissioner, in applications for the extensions of patents, and to perform such other duties as may be assigned to them by the Commissioner; that from their decisions appeals may be taken to the Commissioner of Patents in person, upon payment of the fee hereinafter prescribed; that the examiners-in-chief shall be governed in their action by the rules to be prescribed by the Commissioner of Patents."

Pages 66 and 67. 'It thus appears, not only that the discretion and judgment of the Commissioner, as the head of the Patent Office is substituted for that of the head of the department, but also, *that that discretion and judgment are not arbitrary,* but are governed by fixed rules of right, according to which the title of the claimant appears from an investigation, for the conduct of which ample and elaborate provision is made, and that his discretion and judgment, exercised upon the material thus provided, are subject to a review by judicial tribunals whose jurisdiction is defined by the same statute. In no event could the direction of the

Secretary of the Interior extend beyond the terms in which it is vested, that is, to the duties to be performed under the law by the Commissioner. The supervision of the Secretary cannot change those duties nor require them to be performed by another, *nor does it authorize him to substitute his discretion and judgment for that of the Commissioner,* when by law, the Commissioner is required to exercise his own and when that judgment, unless reversed, in the special mode pointed out by judicial process is by law the condition on which the right of the claimant is declared to depend. The conclusion cannot be resisted, that to whatever else supervision and direction on the part of the head of the department may extend, in respect to matters purely administrative and executive, they do not extend to a review of the action of the Commissioner of Patents in those cases in which, by law, he is appointed to exercise his discretion judicially. It is not consistent with the idea of judicial action that it should be subject to the direction of a superior, in the sense in which that authority is conferred upon the head of an executive department in reference to his subordinates. Such a subjection takes from it the quality of a judicial act. *That it was intended that the Commissioner of Patents, in issuing or withholding patents, in reissues, interferences and extensions, should exercise quasi-judicial functions, is apparent from the nature of the examinations and decisions he is required to make, and the modes provided by law, according to which, exclusively, they may be reviewed."*

Page 68. "Some question is made as to the remedy. We think, however, that mandamus will lie, and that it was properly directed to the Commissioner of Patents. He had fully exercised his judgment and discretion when he decided that the relators were entitled to a patent. The duty to prepare it, to lay it before the Secretary for his signature, and to counter-

sign it, were all that remained and they were all purely ministerial. These duties he had failed and refused to perform merely out of deference to the claim of the Secretary to reverse and set aside the decision on the merits in favor of the relators. This we have held not to be a valid excuse. The case falls clearly within the principles acted upon in *Commissioner of Patents* v. *Whiteley*, 4 Wall. 525."

Pages 68 and 69: "It is suggested that the writ was erroneously awarded by the court below on the ground that the decision of the Commissioner of Patents, in favor of issuing the patent to the relators, was erroneous in law upon its face. *But that question does not arise upon this record. We have adjudged that it belongs exclusively to the Commissioner to decide the question for himself whether a patent ought to issue.* The statute points out the remedy for a party aggrieved by his error if he has decided erroneously. It is not by an appeal to the Secretary, nor can the question be presented in such a proceeding as the present." (Italics mine.)

In the above case the Commissioner of Patents had decided that the relators were entitled to a patent and an appeal was taken from his decision to the Secretary of the Interior, who reversed the decision of the Commissioner, and thereupon the Commissioner refused to issue the patent, but this court held that the Secretary of the Interior had no jurisdiction and that, therefore, the decision of the Commissioner of Patents must stand and mandamus would lie to compel the Commissioner to follow his own decision and issue the patent. The present case is exactly in point except that it involves different tribunals, but the principles involved are exactly the same. In the present case the Examiners-in-Chief

held that the patent should issue and this decision is binding both upon the Primary Examiner and the Commissioner himself, and, under the doctrine above enunciated, mandamus will lie to carry into effect that decision. The decision in *Butterworth* v. *Hoe* was cited and quoted with approval by this court in the later case of *United States* v. *Duell*, 172 U. S. 576.

In *Gaines* v. *Rugg*, 148 U. S. 228, this court, in a case involving the same principles, held, on page 243, as follows:

> "This court held: that it was the duty of the court below to have entered a judgment strictly in accordance with the judgment of this court, and not to add to it the allowance of interest, and that the language of the mandate of this court, 'that such execution and proceedings be had in said cause, as according to right and justice and laws of the United States ought to be had the said writ of error notwithstanding,' did not authorized the court below to depart in any respect from the judgment of this court. It further held that a mandamus would lie to correct the error, where there was no other adequate remedy, and where there was no discretion to be exercised by the inferior court, citing: *Sibbald* v. *United States*, 12 Pet. 488; *Ex parte Bradley*, 7 Wall. 364, 376; *Virginia* v. *Rives*, 100 U. S. 313, 329; and, also, *Perkins* v. *Fourniquet*, 14 How. 328, 330; *Ex parte Dubuque and Pacific Ry.*, 1 Wall, 69; *Durant* v. *Essex Co.*, 101 U. S. 555, 556; *Boyce's Executors* v. *Grundy*, 9 Pet. 275.
>
> In the present case, as we have before observed, there was no discretion to be exercised by the Circuit Court, and, although it might have been admissible to raise the question by a new appeal to the proper court, *yet in view of the delay to be caused thereby, we do not con-*

sider that such remedy would have been, or would be, fully adequate, or that a writ of mandamus is now improper.

As to the suggestion that the views adopted by this court in its decision in *McDonald* v. *Belding*, 145 U. S. 492, decided by this court after the present cases were decided, would, if applied to the present cases, have caused a different result in them, we are of the opinion that, without conceding such would have been the result, this court cannot, on well established rules and principles, permit the Circuit Court of its own motion, to go back of or subvert what was settled by the opinion and mandate in the present cases." (Italics mine.)

In this decision it would appear to be conclusively established that where an appellate tribunal definitely decides a litigation and remands the same to the lower tribunal, the carrying into effect the mandate of the appellate tribunal is purely ministerial, and will be enforced by mandamus whether the decision of the appellate tribunal is right or wrong, and whether or not an appeal would lie from the decision refusing to carry into effect the decision of the appellate tribunal.

In this connection it is desired to direct attention to the comparatively recent decision of this court, *Int. Com. Com.* v. *United States ex rel. Humboldt Steamship Co.*, 224 U. S. 474, opinion delivered by Mr. Justice McKenna, in which the seventh paragraph of the syllabus reads as follows:

"The United States Commerce Court has no jurisdiction to review the action of the Interstate Commission in refusing to entertain a complaint because the subject is beyond its jurisdiction. In such a case the remedy is by mandamus to compel the Commission to proceed and

> decide the case according to its judgment and discretion."

It is also desired to direct the attention of this court to the decision of the Circuit Court of Appeals for the Ninth Circuit, in *Lim Jew* v. *United States,* 196 Fed. Rep. 736, fourth paragraph of the syllabus, which is as follows:

> "The executive officers of the federal government when so empowered, may examine into and determine finally as to the facts on which depend the rights of aliens to enter or remain within the United States, and, when they have acted within the scope of their authority, their findings are conclusive and not subject to re-examination by *any other tribunal except as are expressly authorized by law."* (Italics mine.)

In the present case the Examiners-in-Chief were the executive officers of the federal government, and rendered their decision clearly within the scope of their authority. This being so, under the doctrine above enunciated, it was not proper for the Primary Examiner, the Commissioner of Patents, or the President himself, to interfere with their decision. The only officer or tribunal which could properly interfere with the decision of the Board in this case would have been some tribunal having appellate jurisdiction over it under the circumstances, but, as pointed out above, no tribunal has appellate jurisdiction over the Examiners-in-Chief in case their decision is favorable to the applicant. Appeal is only allowed from the decision of the Examiners-in-Chief in case that decision is *adverse* to the applicant, and the applicant is the only person who can take such an appeal. It thus appears to be clear that the decision of the Examiners-in-

Chief was not subject to review by any person or tribunal and therefore became conclusive and enforcible by mandamus.

A similar case was presented to the Court of Appeals of the District of Columbia in *West* v. *Hitchcock,* 19 App. Cases 333, in which that court held on pages 343 and 344, as follows:

> "The fact that an act which mandamus seeks to compel is the culmination of a series of proceedings of a judicial or quasi-judicial nature, or is an act in the course of such proceedings, does not exempt it from judicial control by the courts through the writ of mandamus, when the officer or person charged to perform it, arbitrarily and without just legal cause, refuses performance. This is so even in reference to strictly judicial proceedings. For a trial court to settle a bill of exception or to approve an appeal bond is a judicial function requiring the exercise of judgment and discretion, and yet, if the judge holding the trial court arbitrarily refuses to settle such bill of exceptions, when in due form it has been duly tendered to him, or arbitrarily refuses to approve such appeal bond, when it has been duly submitted to him for approval and is in all respects satisfactory and subject to no reasonable objection, it is elementary law which requires no elaboration and no citation of authority for its support, that, while his judgment may not be coerced, the performance of his duty may be required of him by means of the writ of mandamus. Indeed, it may be laid down as a general rule, that, while the judgment of a judicial officer, or of an officer charged with the performance of a judicial or quasi-judicial duty, will not be controlled through the writ of mandamus, and this writ will not be used as a means for the review of the exercise of such judgment, *yet, any act required by law to be done whether in the course of judicial proceedings or otherwise, may be*

compelled by mandamus from a superior tribunal or a tribunal of general jurisdiction as the case may be, when its performance is withheld by a mere arbitrary exercise of power without just cause. There is not a step in the course of judicial proceeding which may not be the subject of mandamus when its performance is unlawfully refused.

Now, if this be the case in strictly judicial proceedings, *it is even more so in regard to the functions of executive officers in the performance of acts where a citizen is interested.* To grant a patent for lands, for an invention in the arts, or for a discovery in the sciences, is a quasi-judicial function of the highest nature, which has been committed by congress to the executive officers of the government; and the granting or refusing of such a patent ordinarily cannot be questioned in the courts. *But, when all the proper pre-requisites have been complied with, and all the preliminary steps have been taken whereby a party has in law become entitled to a patent, and nothing remains to be done but to issue the patent, it is well settled that such patent may not then arbitrarily and without just cause be withheld and that its execution and delivery may be enforced by the writ of mandamus. Butterworth* v. *Hoe,* 112 U. S. 50; *United States* v. *Schurz,* 102 U. S. 378; *Dunlap* v. *Black,* 128 U. S. 40. *It has been well said that under our republican system of government, there is no place for the exercise of arbitrary power."*

In the present case the decision of the Examiners-in-Chief was a quasi-judicial function, and all the proper pre-requisites for the issuance of the patent had been complied with including the payment of the final government fee of $20 thereon (see record, petition page 4, paragraph 13, and answer to rule to show cause, page 4, paragraph 13), and, under

the doctrine above enunciated, such decision will be enforced with even more rigidity than the decision of an appellate court, and the refusal of the Primary Examiner and the Commissioner of Patents to comply with the decision of the Examiners-in-Chief and issue this patent was the exercise of purely arbitrary power without legal excuse or justification. Another case decided by the Court of Appeals of the District of Columbia, stating the doctrines relied upon in the present case, is the decision in *Moore* v. *United States ex rel Boyer*, 32 App. Cases 243-247, in which it was held, as follows:

> "Where an officer acting under assumed authority vested in him by virtue of his office undertakes in the performance of his official duties without due process of law to deprive a citizen of rights he has acquired by administration or judicial proceedings, the courts will afford protection either by mandamus or injunction."

In the present case, upon reversal of the Primary Examiner by the Examiners-in-Chief, plaintiff in error's right to this patent became fixed and absolute, and the Commissioner of Patents and the Primary Examiner undertook without due process of law, to deprive a citizen of rights he had acquired by judicial proceedings, and it is submitted, that, under the doctrine enunciated, mandamus will lie.

It is also desired to direct the attention of this court to the decision of the United States Circuit Court for the District of California in *Giant Powder Co.* v. *California Powder Co. et al.*, 4 Fed. Rep. 720, and particularly to the third paragraph of the syllabus thereof, which is as follows:

> "3. * * * The Commissioner of Patents, however, is an officer of limited authority, whose jurisdiction is restricted to the particular cases mentioned in the statute, and, therefore, whenever it is apparent upon inspection of the patents that he has acted without authority, or has exceeded it, his judgment must necessarily be regarded as invalid."

It thus appears that it is well settled that the rules of practice of the Patent Office are binding upon both the Primary Examiner and the Commissioner and that, if either or both of them, fail to follow these rules, mandamus will lie against either or both. It also appears to be established that both the Primary Examiner and the Commissioner failed to follow the rules. It also appears to be well settled that where any subordinate executive officer of the federal government is reversed by a superior tribunal having appellate jurisdiction, the carrying into effect of the decision of the appellate tribunal is purely a ministerial one, and will be enforced by mandamus. Either of these doctrines applies exactly to the facts in this case, and under either, it is submitted, that plaintiff in error is entitled to writs against both the Commissioner and the Primary Examiner. The rights of plaintiff in error have been fully adjudicated and determined by the only tribunal having the power to do so and it is urged that mandamus is the proper remedy to enforce rights so adjudicated.

V.

Plaintiff in Error Had no Right of Appeal.

As a ground for the reversal of this case, the Court of Appeals of the District of Columbia held that plaintiff in error had a right of appeal to that court from the decision of the Commissioner of Patents finally rejecting his application on the merits, and therefore, mandamus did not lie under the circumstances presented in this case. However, in this connection it is desired to direct the attention of the court to the decision of the Court of Appeals of the District of Columbia in *Westinghouse* v. *Duncan* (1894), 2 App. D. C. 131, in which it was held as follows:

> "The intermediate appeals under act of 1893 as under former acts, must be taken before the court has jurisdiction. Thus, from the decision of the Primary Examiner an appeal must be taken to the Examiners-in-Chief, thence to the Commissioner, and from his decision to this court."

All of the intermediate appeals mentioned are appeals to be taken *by applicants from an adverse decision* of one of the tribunals mentioned or by a party to an interference. The decision of the Examiners-in-Chief in this case was not *adverse,* but on the contrary in favor of plaintiff in error, and he, of course, could or would take no appeal from such a decision. The statutes and rules of practice do not allow the Primary Examiner to take an appeal, and even if they did he has never taken, or attempted to take, any appeal. It is submitted, therefore, that it necessarily follows that the applicant

in this case had no right of appeal to the Court of Appeals of the District of Columbia and that his only remedy is by way of mandamus.

In this connection it is also desired to direct the attention of the court to its decision in *ex parte* Frasch, 192 U. S. 566-567-568, in which Mr. Justice McKenna rendered the opinion as follows:

> "The Primary Examiner decided that 'two different subjects of invention,' were presented in the specification and claims and required a division of the claims under Rule 41 of the Patent Office. A reconsideration of the decision was requested and denied. A petition for an appeal to the Board of Examiners-in-Chief was filed. The Primary Examiner refused to allow the appeal. A petition was then presented to the Commissioner of Patents praying that he make such order or take such action that petitioner's appeal to the Examiners-in-Chief might be heard, or, if that prayer be denied, that the Commissioner himself, 'consider the various matters all and severally raised by the appeal.' Both prayers were denied and the petitioner appealed to the Court of Appeals of the District of Columbia. That court dismissed the appeal for want of jurisdiction. This petition was then filed and a rule to show cause issued. A return to the rule was duly made.
>
> We have just held in *Steinmetz* v. *Allen, ante* page 543, that Rule 41 of the Patent Office insofar as it requires a division between claims for a process and claims for an apparatus if they are related and dependent inventions is invalid. *We, however, held that mandamus to the Commissioner, not appeal to the Court of Appeals of the District, was the proper remedy. It follows, therefore, that the rule to show cause should be discharged and the petition be dismissed and it is so ordered.*" (Italics mine.)

It is also desired to direct the attention of the court to its decision in *United States ex rel. Dunlap* v. *Black*, 128 U. S. 40, page 52, where it was held as follows:

> "The appellate tribunal in the present case is the secretary of the interior, who has no power to enforce his decisions by mandamus, or any process of like nature, and therefore, a resort to a judicial tribunal would seem to be necessary, in order to afford a remedy to the party injured by the refusal of the commissioner to carry out his decision. But it is suggested that removal of the contumacious subordinate from office or a civil suit brought against him for damages would be effectual remedies. We do not concur in this view. A suit for damages if it could be maintained, would be an uncertain, tedious and ineffective remedy, attended with many contingencies and burdened with onerous expenses. Removal from office would be still more unsatisfactory. It would depend upon the arbitrary discretion of the President or other appointing power and is not such a remedy as a citizen of the United States is entitled to demand. We think that the case suggested by the petitioner is one in which it would be proper for the court to interfere by mandamus."

It is also desired, in this connection, to direct the attention of the court to some of the language employed in *Butterworth* v. *Hoe*, 112 U. S. 50, where it was held as follows:

> "The true conclusion, therefore, is, that in matters of this description, in which the action of the Commissioner is quasi-judicial, the fact that no appeal *is expressly given to the secretary is conclusive that none is to be implied.*" (Italics mine.)

The statute only gives the right of appeal in a case

of this kind from a decision of the Commissioner in a case which comes to him by way of appeal from the Examiners-in-Chief, and, inasmuch as the present case did not come to the Commissioner by way of appeal from an adverse decision of the Examiners-in-Chief, but his action in this case was the exercise of purely arbitrary power and, therefore, it is submitted, that the doctrine above enunciated applies directly to this case and no appeal lies.

It is also desired to direct attention of this court to a statement made in *Steinmetz* v. *Allen,* 192 U. S. 543-564, as follows:

> "A petition praying an appeal was filed but the Primary Examiner refused to answer the appeal and the defendant in error also refused to direct him to answer. It is manifest that if an appeal cannot be compelled from the decision of the Primary Examiner an applicant is entirely without remedy. And respondent has asserted that extreme. In *ex parte* Frasch, the Court of Appeals of the District of Columbia was persuaded that an appeal was not the proper remedy. In the case at bar it is contended that mandamus is not proper. One or the other must be. A suggestion made is that the inventor must await a decision on the merits, meaning by merits, lack of invention, novelty, or utility as provided in Rule 133. But after waiting he would encounter the arbitrary requirement of Rule 41. Besides, what would there be to review if the order of the Primary Examiner were complied with and the claims put into separate applications."

In *Lim Jew* v. *United States,* 196 Fed. Rep. 736, fourth paragraph of the syllabus, the Circuit Court of Appeals for the Ninth Circuit held, as follows:

> "The executive officers of the federal government when so empowered, may examine into and

> determine finally as to the facts on which depend the rights of aliens to enter or remain within the United States, and, *when they have acted within the scope of their authority, their findings are conclusive and not subject to re-examination by any other tribunal except as are expressly authorized by law.*" (Italics mine.)

In the present case the Examiners-in-Chief were the executive officers of the federal government, and rendered their decision clearly within the scope of their authority. This being so, under the doctrine above enunciated, it was not proper for the Primary Examiner, the Commissioner of Patents, or the President himself, to interfere with their decision.

Another case decided by the Court of Appeals for the District of Columbia which it is thought bears out applicant's contention in this regard is *In re Locke,* 17 App. D. C. 314-16, in which it was held as follows:

> "The Primary Examiner accordingly disallowed the appellant's application for a patent. The Board of Examiners-in-Chief sustained the decision; and the Commissioner of Patents affirmed the decision of the Board.
>
> If, as the appellant claims, the Commissioner had no authority to reverse the original decision of the Primary Examiner before the declaration of interference, a position which, upon the showing thus far made we cannot regard as tenable, the remedy must be found otherwise than in this appeal."

This is a strong intimation by the Court of Appeals of the District of Columbia that in case the commissioner acts without authority as in the case at bar, his action can be corrected by mandamus.

It is also desired to direct attention to a decision

of the Court of Appeals of the District of Columbia, rendered since the decision in the case at bar in which they dismissed an appeal in a similar proceeding, this decision being entitled *Universal Motor Truck Co.* v. *Universal Motor Co.*, 197 O. G. 535-536, in which it was held as follows:

> "Appeals from interlocutory orders of the Supreme Court of the District of Columbia, may, by special provision of Sec. 7 of the act organizing this court, be allowed from interlocutory orders; but no such provision is to be found in Sec. 9 which confers appellate jurisdiction over the patent Commissioner. Only final decisions of the Commissioner of Patents *in certain cases* can be appealed." (Italics mine.)

The decision of the Commissioner of Patents in question was rendered in *Universal Motor Truck Co.* v. *Universal Motor Co.*, 197 O. G. 533, in which it stated as follows:

> "This is a petition by the Universal Motor Co., that the commissioner in the exercise of his supervisory authority, review the decision of the Examiner of Interferences in this opposition rendered June 28, 1913, which was a decision denying a motion by the Universal Motor Truck Co., that the opposition be 'dissolved.'"

In the case at bar the Commissioner in taking up this application for personal consideration stated in his ruling which appears on pages 12 and 13 of the transcript of record herein, as follows:

> "This case has been taken up under the supervisory authority of the Commissioner for personal consideration, and the additional search for prior art evidenced by the Examiner's letter of February 21, 1912, was made upon the authority of the Commissioner and approved by me on March 13, 1912."

It thus appears clear that even after the Court of Appeals of the District of Columbia decided the case at bar it dismissed an appeal in a similar case. The ruling of the Commissioner objected to in the case at bar was made under his supposed supervisory authority, and even after their decision in the present case holding that an appeal would lie, the Court of Appeals of the District of Columbia dismissed an appeal taken from an order made by the Commissioner acting under his supervisory authority, on the ground that no appeal would lie from such an order. Likewise *in re Fullagar,* 32 App. D. C. 222, the Court of Appeals of the District of Columbia, speaking through Chief Justice SHEPARD said:

> "The jurisdiction of this court to entertain appeals from decisions of the Commissioner of Patents, in proceedings relating to patents, is limited to two classes of cases. The first is where the claims of an applicant for a patent, or the reissue of a patent, after having been twice rejected, have been finally rejected on an appeal to the Commissioner in due course of procedure. The second is where on an appeal to the Commissioner in an interference proceeding there has been a final decision of priority in favor of one of the parties thereto. Secs. 4909-4911, R. S. U. S.; *Westinghouse* v. *Duncan,* 2 App. D. C. 131; *Allen* v. *United States,* 26 App. D. C. 8; *Union* v. *Schneider,* 29 App. D. C. 1.
>
> Upon the return of the case to the Patent Office, Fullagar will be entitled to have his application remanded for re-examination and if again rejected, he will be entitled to his successive appeals in due course, if it should become necessary to resort thereto."

This was a case which came to the Court of Appeals of the District of Columbia from a decision

of the Commissioner of Patents rejecting certain claims, but the court held that it had no jurisdiction of the appeal because the case had not come to the Commissioner by regular course of appeals, that is, by successive appeals through the Examiners-in-Chief, and from them to him.

Also *in re Mygatt*, 40 App. D. C. 32-34-35, the Court of Appeals of the District of Columbia held as follows:

> "As has been repeatedly held, appeals do not lie from interlocutory orders of the Commissioner, or to regulate matters of practice. In *ex parte* cases the appellate jurisdiction is limited to those 'where the claims of an applicant for a patent, or the reissue of a patent, after having been twice rejected, *have been finally rejected on an appeal to the Commissioner in due course of procedure.' In re Fullager*, 32 App. D. C. 222-228, and cases there cited. *The due course of procedure, prescribed by statutes and rules is, first, an appeal to the Examiners-in-Chief and from them to the Commissioner.* It is true that, under the circumstances the applicant might have treated the action of the Examiner as in fact, a rejection of his application, he having failed to amend as required, and might have appealed to the Examiners-in-Chief therefrom as from an express rejection, and from them to the Commissioner and then to this Court." (Italics mine.)

To the same effect see *in re Frasch*, 20 App. D. C. 298-301, in which it was held as follows:

> "The motion to dismiss the appeal must be granted. The right to appeal to this court from a decision of the Commissioner of Patents is limited to two classes of cases: First, where an application for patent has been finally denied, and second, where, in an interference proceeding, there has been a final determination of

the question of priority of invention between adverse claimants."

It thus appears that the Court of Appeals for the District of Columbia has uniformly held that an order or decision of the Commissioner of Patents made under his supervisory authority and in the absence of an appeal from the Examiners-in-Chief to him, is not appealable to that Court, with the sole exception of the ruling in the case at bar.

In support of the ruling in the case at bar, the Court of Appeals of the District of Columbia cited decisions as follows:

In re Mattullath, 38 App. D. C. 497.
Moore v. *Heany*, 34 App. D. C. 31.
Re Selden, 36 App. D. C. 428.
In re Mygatt, 26 App. D. C. 366.
Cosper v. *Gold*, 36 App. D. C. 302.
General Railway Signal Co. v. *Thullen*, 32 App. D. C. 575.
New Departure Mfg. Co. v. *Robinson*, 39 App. D. C. 504.

In re Mattullath, 38 App. D. C. 497, and *re Selden*, 36 App. D. C. 428, each arose on a petition to the commissioner to revive an application which had become abandoned through failure to prosecute within the time provided by the statutes. The proceeding involved is authorized by Revised Statutes, Section 4894, which reads as follows:

"Sec. 4894. (Limitation upon time of completing applications.) All applications for patents shall be completed and prepared for examination within one year after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same

within one year after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, *unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable.*" (Italics mine.)

In each of the cases under consideration the applications had become abandoned under the above statute, and a petition to revive was denied by the Commissioner. From this ruling of the Commissioner an appeal was entertained by the Court of Appeals of the District of Columbia. But the Commissioner was not acting under his supervisory authority in these instances but by direct authority of the above quoted statute and thus had jurisdiction to make the ruling complained of. While there is grave doubt in the mind of counsel for plaintiff in error as to whether or not the Court of Appeals could properly entertain an appeal in these particular instances, nevertheless, even supposing the rulings therein were correct, these are far from holding that a ruling of a Commissioner made under his supposed supervisory authority, in the absence of an appeal to him, is an appealable ruling. In those cases there is no question but that the Commissioner had jurisdiction to make the ruling. In the present case the contention is that the Commissioner had no jurisdiction whatever to make the ruling made.

In *Moore* v. *Heany*, 34 App. D. C. 31, fraud had been discovered in the prosecution of the Heany applications and an Assistant Examiner in the Patent Office and Heany's attorney had been convicted and sentenced for this fraud. A petition was made to

the Commissioner calling his attention to these facts and requesting that the Heany applications in which such frauds had taken place, be stricken from the files. The Commissioner ordered an investigation. The Supreme Court of the District of Columbia enjoined the Commissioner from conducting this investigation and this decision of the Supreme Court was reversed on appeal by the Court of Appeals of the District. In rendering its decision the Court of Appeals, after stating in effect that the Commissioner had as yet made no ruling and was simply conducting an investigation, stated on pages 39-40, as follows:

> "Should he (the Commissioner) strike the application from the files, and it should transpire that no appeal could be prosecuted from that order, the applicant might then proceed by mandamus to compel him to vacate the order."

The decision in *Moore* v. *Heany* was fully considered by Mr. Justice Barnard in his decision in the case at bar and in regard thereto he states in his opinion on page 22 of the record, as follows:

> "I am unable to see any authority in this case for the right of appeal by the relator in the case at bar."

The Commissioner had never made any ruling and no attempt had been made to take any appeal to the Court of Appeals of the District so that it would appear clear that the ruling in that case could have no effect on the right of appeal under the circumstances of the case at bar.

In re Mygatt, 26 App. D. C. 366, the decision of the Examiners-in-Chief had been *adverse* to the ap-

plicant and applicant appealed to the Commissioner. In this connection see page 369, where it was held:

> "Applicant thereupon appealed to the Commissioner in person."

Of course if the applicant took an appeal to the Commissioner in person from an adverse decision of the Examiners-in-Chief the Commissioner had complete jurisdiction to decide the case in any way he saw fit and an appeal would lie to the Court of Appeals of the District. In the present case the decision of the Examiners-in-Chief was not *adverse* but was favorable to applicant and no appeal was taken to the Commissioner in person. The Commissioner therefore had absolutely no jurisdiction to pass upon the question already determined by the Examiners-in-Chief and consequently no appeal would lie to the Court of Appeals of the District.

Likewise in *Cosper* v. *Gold,* 36 App. D. C. 302, appeal was taken to the Commissioner after a decision by the Examiners-in-Chief. This was an interference proceeding and one of the parties thereto took the appeal to the Commissioner. The Commissioner in rendering his decision made no award of priority and for that reason the court dismissed the appeal to it. In this connection the court said on page 304:

> "Cosper appealed in turn to the Examiners-in-Chief and the Commissioner who affirmed that decision. No award of priority having been made, the court dismissed the appeal for want of final adjudication as above stated."

Later on petition the Commissioner modified his decision to render a judgment of priority and then the appeal was entertained. This case is a good

illustration of the care with which the Court of Appeals of the District exercises jurisdiction in appeal cases, and it certainly constitutes no authority for the entertainment of an appeal from the Commissioner when the Commissioner had not acquired jurisdiction by appeal from the Examiners-in-Chief.

In the case of *General Railway Signal Co.* v. *Thullen*, 32 App. D. C. 575, the case also came to the Commissioner by regular appeal from the Examiners-in-Chief, in this connection the court stating on page 579:

> "On appeal to the Examiners-in-Chief this decision was affirmed with an elaborate decision. On further appeal this decision was affirmed by the Commissioner."

Likewise in *New Departure Mfg. Co.* v. *Robinson*, 39 App. D. C. 504, cited in the decision of the Court of Appeals at *as* "present term," it appears that the case came to the Commissioner through the usual channel of appeals.

From these remarks it appears that up to and since their decision in the case at bar, the Court of Appeals of the District of Columbia has never held that an appeal to it would lie from any ruling of the Commissioner of Patents made under his supervisory authority. As far as counsel for plaintiff in error is aware the Court of Appeals of the District of Columbia has never entertained such an appeal. The case at bar, appears then, to be the only case decided by the Court of Appeals of the District of Columbia holding that an appeal would lie to it from an order of the Commissioner made under his supervisory authority, but as pointed out in the long list

of authorities above cited, it is submitted that the weight of authority is overwhelmingly to the contrary, and, as a matter of law, plaintiff in error had no right of appeal from the order entered by the Commissioner in the case at bar.

VI.

Plaintiff in error had no right to relief by a bill in equity under Sec. 4915 Rev. Stat.

In this connection it is desired to direct the attention of the court to the decision of the Supreme Court of the District of Columbia in *Kirk* v. *Commissioner of Patents*, 37 O. G. 451, in which it was held as follows:

> "So far as the interference is concerned the previous stages have been exhausted by the final refusal of the Commissioner; but so far as the *ex parte* applicant is concerned, his redress is not exhausted until after he has taken an appeal from the decision of the Commissioner. Then only arises to him the right, which has arisen already in the interference case upon the decision of the Commissioner, to apply to a court of equity for relief by an original bill according to the terms of said section."

Since the above decision was rendered the statute has been amended to give the Court of Appeals of the District of Columbia jurisdiction of such appeals and also extending the right of appeal to interference cases. In regard to the amended statute, attention is directed to the decision of the Circuit Court for the District of Delaware in *Smith* v. *Muller, et al.*, 75 Fed Rep. 612-615, in which it was held as follows:

"It was held in *Kirk* v. *Commissioner of Pat-*

> *ents, supra,* that an applicant for a patent in an *ex parte* case was not entitled to redress by a bill in equity until he had exhausted the remedy by appeal as provided in Sec. 4911, and it is urged on behalf of the demurrants that the same rule of construction applies to the law as now amended or altered, and that the plaintiff cannot prosecute his suit in this court until he has first appealed to the Court of Appeals of the District of Columbia, and exhausted his remedy there. This construction of the law appears to be reasonable."

As pointed out above, plaintiff in error has never taken any appeal from the decision of the Commissioner to the Court of Appeals of the District of Columbia, and could not take such an appeal under the decision of that court in *Westinghouse* v. *Durcan,* 2 App. D. C. 131, and other authorities cited above, and it would appear, therefore, to be conclusively established that plaintiff in error also has no right to relief by way of bill in equity. As pointed out above an appeal to the Court of Appeals of the District of Columbia is impossible, and the doctrines of law above enunciated, make such an appeal and a determination thereof a condition precedent to the filing of the bill in equity. Moreover, no appeal was ever taken from the decision of the Examiners-in-Chief to the Commissioner, so that another link in the chain of appeals necessary to give the right to relief by bill in equity is missing. In the dissenting opinion in the Hull case, above noted, Mr. Justice McArthur points out that in order to give the applicant a right to file a bill in equity, as provided by Section 4915 Rev. Stat., his application must be *adversely* acted upon by *all three tribunals in the Patent Office.* It thus appears that plaintiff

in error had neither the right to file a bill in equity for relief or the right to appeal to the Court of Appeals of the District of Columbia from the decision of the Commissioner and therefore, is entirely without remedy, unless one or both of the writs prayed for in this proceeding be granted.

VII.

The Relief Afforded by an Appeal or Otherwise Must Be Adequate to Bar Relief by Mandamus. Under the Circumstances in the Case at Bar a Second Appeal or a Bill in Equity Would Have Been Wholly Inadequate.

But even if plaintiff in error had the right to take a second appeal under the circumstances in this case, it is well settled that the relief afforded by such an appeal must be adequate to bar relief by mandamus. In this connection it is desired to direct the attention of this court to its decision in *Gaines* v. *Rugg,* 148 U. S. 228-243 in which it was held as follows:

> "In the present case, as we have before observed, there was no discretion to be exercised by the Circuit Court, and, *although it might have been admissable to raise the question by a new appeal to the proper court,* yet in view of the delay to be caused thereby, we do not consider that such remedy would have been, or would be, fully adequate, or that a writ of mandamus is now improper." (Italics mine.)

To the same effect see also American & English Encyclopedia of Law, Volume 19, Second Edition, page 751, as follows:

> "But where there is no remedy by appeal, or where such appeal, if existing, is entirely inadequate, a mandamus may issue."

The doctrine laid down in *Gaines* v. *Rugg* was followed by the United States Circuit Court of Appeals of the Fifth Circuit in *L. Bucki & Son Lumber Co.* v. *Atlantic Lumber Co.*, 128 Fed. Rep. 332-343, in which it was held as follows:

> "This long drawn out litigation will never have an end if we ignore adjudicated rights and encourage the continued wrestling with technicalities. The case of *Gaines* v. *Rugg*, 148 U. S. 228, 13 Supreme Court 611, 37 L. Ed. 432, recognizes the right of the Appellate Court to deal with obstructions to its mandate by mandamus, and we consider it decidedly in point."

The Circuit Court of Appeals for the Ninth Circuit, in *Harrison* v. *Clark*, 182 Fed. Rep. 765-768, quoted the following language with approval:

> "The trial court upon the coming down of a mandate in a cause that has been taken to an appellate court, has no discretion, but to carry into effect the judgment or decree of the appellate court. It can neither enlarge or diminish the amount adjudged or decreed by that court, and can only obey its mandate construed in the light of its opinion." (Citing *Gaines* v. *Rugg*, *supra.*)

In these cases it appears to be well settled that where a case is reversed by an appellate tribunal mandamus will lie to compel the lower tribunal to carry out the decision of the appellate tribunal, even though a second appeal would lie.

As to the adequacy of the relief afforded by an appeal in the case at bar, attention is respectfully directed to the fate of the appeal already taken here-

in. In October, 1911, plaintiff in error had a right of appeal to the Examiners-in-Chief, took such appeal and was successful. On January 31, 1912, the Examiners-in-Chief rendered a decision reversing the decision of the Primary Examiner. Since that time plaintiff in error has been buffeted about from one tribunal to another within the Patent Office and from one court to another outside of the Patent Office, in an attempt to obtain the patent to which he was held entitled by the decision of the Examiners-in-Chief, and, it is thought that these circumstances furnish a striking example of the total inadequacy of at least one appeal to afford any relief whatever.

If plaintiff in error had a right of appeal at all he had a right of a second appeal to the Examiners-in-Chief, and the Primary Examiner evidently thought so for in his action of February 21, 1912, he stated as follows, pages 10 and 11, Transcript of Record:

> "Also that in most large steel works, samples of steel are in a single long straight piece, 'with weak unions,' made by 'means of a reduced portion.' If the examiner is wrong in this he will be set right by the Honorable Board of Appeals."

It would seem strange to take an appeal to the Examiners-in-Chief after the Commissioner, who has appellate jurisdiction over the Examiners-in-chief, had made a ruling herein. However, if as plaintiff in error contends, the Commissioner had no jurisdiction to make said ruling, the ruling made is a nullity, and we will suppose that plaintiff in error had taken such an appeal. Obviously, the Examiners-in-Chief, to be consistent, would have again reversed the

Primary Examiner on the theory that these samples of "weakened unions" coming from widely different arts, did not constitute anticipations. When the case again came before the Primary Examiner, he would be at liberty to again reopen the case and cite additional references. For instance, he might say that he had neglected to mention in his previous actions that it was a well known fact that beavers were in the habit of felling trees by gnawing a notch around the base thereof and thus causing a weakened union to such an extent that the tree would fall under the force of gravity. And we will suppose that another appeal was taken from this ruling of the Primary Examiner and that he was again reversed. He would still be at liberty to reopen the case and say that it was a well known fact that ice bergs were deposited in the sea through a weakened union with the parent glacier. Reversed upon this proposition he would still be at liberty to reopen the case and say that the United States was the result of a weakened union between the thirteen original colonies and the mother country and reject the application upon reference to the American Revolution. These illustrations may seem fanciful, but nevertheless they are the bitter truth if mandamus does not lie in the present case. If the Primary Examiner is at liberty to disregard the results of one appeal, he is at liberty to disregard the results of all appeals.

But suppose the plaintiff in error had elected to take an appeal to the Court of Appeals of the District of Columbia. In the first place this appeal would in all probability have been promptly dismissed by that court. At least if it had not, it would

be the first time, as far as counsel for plaintiff in error has been able to learn, that said Court of Appeals has entertained an appeal from a ruling of the Commissioner of Patents while exercising his supervisory authority in the Patent Office. It is true that in the present case said Court of Appeals held that such an appeal would lie, but shortly after rendering that decision, and in the case of *Universal Motor Truck Co.* v. *Universal Motor Co.*, 197 O. G. 535, discussed *supra*, they dismissed an appeal taken from a ruling of the Commissioner of Patents in the exercise of his supervisory authority. But we will assume for the sake of the illustration that notwithstanding the long list of decisions to the contrary cited above, the Court of Appeals entertained such an appeal and reversed the ruling of the Commissioner of Patents. The Primary Examiner would still be at liberty to reopen the application and say that it was generally accepted by a considerable number of scientifically informed people that the mysterious disappearance of the tail of Halley's comet was due to the superior attraction of the earth which had thus detached said tail from said comet and absorbed the same into the atmosphere, and thus that the disappearance of said tail was due to a weakened union with the head of said comet, and therefore reject the application upon reference to this astronomical phenomenon. The right of appeal given by Congress to the Court of Appeals of the District of Columbia is no more solemn or effective than the right of appeal given to the Examiners-in-Chief. If the Primary Examiner is at liberty to disregard the result of one of these appeals, he is also at liberty to disregard the other. Thus an obdurate Examiner could frustrate an in-

ventor's rights indefinitely. During all this time the inventor would have the right of appeal, but the patent would be a "will-o'-the-wisp, ' ever apparently just within grasp, but ever receding. Under the circumstances, plaintiff in error is a little skeptical as to any relief he might obtain by any appeal taken under the circumstances presented in the case at bar, and it is respectfully submitted that any right of appeal which plaintiff in error had, or which the Court of Appeals of the District of Columbia might entertain, was wholly inadequate to afford relief and obtain the patent to which plaintiff in error has been held to be fairly entitled. There is no particular charm, to plaintiff in error, in a right of appeal. What he wishes is his patent to which he had been held justly entitled, and he comes to this court in all confidence seeking that patent.

As to the adequacy of any relief to be afforded by a bill in equity under Sec. 4915 Rev. Stat., attention is directed to the fact that the Primary Examiner in the case at bar has already refused to obey the mandate of one tribunal having superior jurisdiction over him, and there is no reason to presume that he would obey that of another. However, we will assume that such a proceeding had been taken and entertained by the proper court, and that a mandate was returned to the Patent Office ordering the Commissioner to issue the patent, the Commissioner in turn would be supposed to order the Primary Examiner to pass the patent to issue, but suppose the Primary Examiner took it into his head to reopen the case and say that he had forgotten to call attention on the record to the fact that death was the

result of a weakened union between the body and soul, and thus reject the application on this religious belief. If he could disregard the mandate of one superior tribunal, he could also disregard that of another.

Plaintiff in error's right to this patent has been finally adjudicated and, it is submitted that, the only relief which is adequate is the prompt issue of the patent, and that mandamus is the only means by which this can be accomplished with certainty.

VIII.

The Decision of the Court of Appeals of the District of Columbia Erroneous.

The Court of Appeals of the District of Columbia based its decision, reversing the Supreme Court of the District of Columbia on the grounds that the ruling of the Commissioner of Patents withholding the patent from plaintiff in error was within his supervisory authority as the executive head of the bureau, and that an appeal lay to the Court of Appeals of the District of Columbia from his decision.

The ruling that the Commissioner's action was within his supervisory authority was based largely on their prior decision *in re Drawbaugh,* 9 App. D. C. 219. But this was a case in which appeal had been taken to the Examiners-in-Chief from the Primary Examiner and the Examiners-in-Chief *affirmed* the decision of the Primary Examiner instead of *reversing* it, as in the case at bar. From this decision of the Examiners-in-Chief appeal was regularly taken to the Commissioner, so that the Commis-

sioner had due and proper jurisdiction in the premises. The Commissioner included additional grounds for his decision other than those given by the Examiners-in-Chief, and the contention was that this was beyond his jurisdiction and authority. Appeal was regularly taken to the Court of Appeals of the District of Columbia, and the contention made that the Commissioner had no jurisdiction to decide the question for reasons other than those given by the Examiners-in-Chief, but in this connection the court held, on page 240, as follows:

> "The Commissioner is the head of the bureau and he is responsible for the general issue of that bureau. If, therefore, there be any substantial, reasonable ground, within the knowledge or cognizance of the Commissioner, why the patent should not issue whether the specific objection be raised or acted upon by the Examiners or not, it is his duty to refuse the patent; and especially is it so when the Primary Examiner and Examiners-in-Chief have found such ground for refusal to exist."

This decision was fully considered by his Honor Mr. Justice Barnard in the Supreme Court of the District of Columbia and in regard thereto he said on pages 21 and 22 of the Transcript of Record, as follows:

> "The Chief Justice had just stated that the subordinate officers of the Patent Office, to wit: the Primary Examiner, Examiner of Interferences, and the Examiners-in-Chief, were all subject to the official direction of the Commissioner, *except in the free exercise of their judgment in the matters submitted for their examination and determination.*
>
> That case is certainly to be distinguished from the case at bar, for there can be no question but what the Commissioner had jurisdiction by

> proper and regular appeals in that case, to refuse the patent for any reason which he might deem just and proper. The case, therefore, does not help us in determining whether the relator in this case had an appeal to the Court of Appeals from the refusal of the Commissioner to grant him the patent." (Italics mine.)

It thus appears that the circumstances presented *in re Drawbaugh* were radically different from those presented in the case at bar, in that, the Commissioner had full and proper jurisdiction by an appeal taken directly to him by the applicant from an *adverse* decision of the Examiners-in-Chief, whereas in the present case no appeal was taken to the Commissioner by anybody, and no appeal could be taken because the decision of the Examiner-in-Chief was not *adverse* to the applicant.

The Court of Appeals, in support of this ruling, also cited the following cases:

Podlesak v. *McInnerney,* 26 App. D. C. 399.
Sobey v. *Holsclaw,* 28 App. D. C. 65.
Moore v. *Heany,* 34 App. D. C. 31.
In re Locke, 17 App. 314.
U. S. ex rel. Hoe v. *Butterworth,* 3 Mack. 229; 112 U. S. 50.

In *Podlesak* v. *McInnerney,* appeal was regularly taken from an *adverse* decision of the Examiners-in-Chief by the applicant. In this connection the Court said on page 401:

> "An appeal was taken by Podlesak and Podlesak to the Commissioner."

In *Sobey* v. *Holsclaw,* 28 App. D. C. 65, appeal was also taken to the Commissioner. On page 71 the Court said:

"Appeal was duly taken to the Commissioner of Patents."

In *Moore* v. *Heany* it was discovered that fraud had been practiced in the Patent Office in the Heany applications and an investigation was ordered by the Commissioner. This investigation was enjoined by the Supreme Court of the District of Columbia, but the Court of Appeals of the District of Columbia reversed the Supreme Court and dissolved the injunction. Contention was made in that case that the Commissioner did not have authority to conduct this investigation, but the Court of Appeals held in effect that he had. Whether or not the Commissioner had jurisdiction in that instance is not seen to be material in the present proceeding. The Commissioner had as yet made no ruling and for all anybody knew he might merely have suggested that the proper tribunal in the Patent Office be requested to reopen the matter involving the Heany applications for the reception of newly discovered evidence. As to the affect of the decision which the Commissioner might render, the court said, on pages 39-40, as follows:

"Should he (the Commissioner) strike the application from the files, and it should transpire that no appeal could be prosecuted from that order, the applicant might then proceed by mandamus to compel him to vacate that order."

The circumstances presented in *Moore* v. *Heany* were peculiar and novel, but it is not thought that there is any parallel presented to the circumstances in the case at bar and there is certainly no ruling to the effect that where the Primary Examiner has been reversed by the Examiners-in-Chief, the Com-

missioner has jurisdiction or authority to arbitrarily set that decision aside.

In re Locke, appeal was regularly taken to the Commissioner from an adverse decision of the Examiners-in-Chief. In this connection the court said on page 316 as follows:

> "The Primary Examiner accordingly disallowed the appellant's application for a patent; the Board of Examiners-in-Chief sustained the decision; and the Commissioner of Patents affirmed the decision of the Board.
>
> If, as the appellant claims, the Commissioner had no authority to reverse the original decision of the Primary Examiner before the declaration of interference, a position which, upon the showing thus far made we cannot regard as tenable, the remedy must be found otherwise than in the appeal."

It thus appears that this decision has no bearing upon the case at bar because the decision of the Examiners-in-Chief had been *adverse* to the appellant's claim and the Commissioner had obtained jurisdiction by regular course of appeal. However, the case does appear to constitute good authority for the course pursued in the case at bar because the court held that if the appellant wished to claim that the Commissioner of Patents had no authority to render a decision, he must raise such a question *otherwise than by an appeal, presumably by mandamus.*

In the case of *U. S. ex rel. Hoe* v. *Butterworth,* 3 Mack. 229; 14 Sup. Ct. D. C. 229, the court granted a writ of mandamus against the Commissioner because he had exceeded his authority and had attempted to interfere with an application which had been finally adjudicated. In that case the Commissioner

had held that one of the contestants in an interference proceeding was entitled to the patent. Appeal was taken to the Secretary of the Interior, who reversed the Commissioner, and the Commissioner, out of deference to his superior officer, refused to issue the patent. However, it was held that the Secretary of the Interior had no appellate jurisdiction over the Commissioner and that therefore the Commissioner's decision was a final adjudication of the controversy. In this connection the court held:

> "We hold, then, that the attempted reversal of the Commissioner's decision by the Secretary, in the case before us, was unauthorized, and therefore a nullity, and that, consequently, the Commissioner having finally adjudicated that the relators are entitled to a patent, improperly refused to issue the same. The writ of mandamus will accordingly issue as prayed for."

It appears, therefore, that instead of this case constituting authority for the ruling of the Court of Appeals in the case at bar, the principle of law involved is directly to the contrary and supports the contention of plaintiff in error herein, that his right to this patent had been "finally adjudicated" and that he is entitled to the patent, and that any interference with the issue of the patent would be corrected by mandamus.

The reference to 112 U. S. 50 is to the same case decided by this court on writ of error to the Supreme Court of the District of Columbia and upon which great reliance is placed in the case at bar. The opinion was rendered by Mr. Justice Matthews, who reviewed the statutes and principles of law relating to the practice in the Patent Office at great

length and with much lucidity. In this connection it was stated as follows:

> Page 56. "In reference to this argument from the analogy of the general relation of the heads of executive departments to their bureau officers, it may as well be observed, in this connection that, although not without force, it will be very apt to mislead, unless particular regard is had to the nature of the duties entrusted to the several bureaus and critical attention is given to the language of the statutes defining the jurisdiction of the chief and subordinates, and the special relation of subordination between them respectively; for it will be found on careful examination, too extensive and minute to be entered upon here, that the general relation between them, of superior and inferior, is varied by the most diverse provisions, so that in respect to some bureaus the connection with the department seems almost clerical and one of mere obedience to direction *while in that of others the action of the officer, although a subordinate, is entirely independent, and, so far as executive control is concerned, conclusive and irreversible.*"
>
> Page 64. "*The true conclusion, therefore, is, that in matters of this description in which the action of the Commissioner is quasi-judicial, the fact that no appeal is expressly given to the Secretary is conclusive that none is to be implied.*"
>
> Pages 66 and 67. "It thus appears not only that the discretion and judgment of the Commissioner, as the head of the Patent Office, is substituted for that of the head of the department, but also, *that that discretion and judgment are not arbitrary,* but are governed by fixed rules of right, according to which the title of the claimant appears from an investigation, for the conduct of which ample and elaborate provision is made, and that his discretion and judgment, exercised upon the

material thus provided, are subject to a review by judicial tribunals whose jurisdiction is defined by the same statute. In no event could the direction of the Secretary of the Interior extend beyond the terms in which it is vested, that is, to the duties to be performed under the law by the Commissioner. The supervision of the Secretary cannot change those duties nor require them to be performed by another, *nor does it authorize him to substitute his discretion and judgment for that of the Commissioner,* when by law, the Commissioner is required to exercise his own and when that judgment, unless reversed, in the special mode pointed out by judicial process is by law the condition on which the right of the claimant is declared to depend. *The conclusion cannot be resisted, that to whatever else supervision and direction on the part of the head of the department may extend, in respect to matters purely administrative and executive, they do not extend to a review of the action of the Commissioner of Patents in those cases in which, by law, he is appointed to exercise his discretion judicially. It is not consistent with the idea of judicial action that it should be subject to the direction of a superior, in the sense in which that authority is conferred upon the head of an executive department in reference to his subordinates. Such a subjection takes from it the quality of a judicial act. That it was intended that the Commissioner of Patents, in issuing or withholding patents, in reissues, interferences and extensions, should exercise quasi-judicial functions, is apparent from the nature of the examinations and decisions he is required to make, and the modes provided by law, according to which, exclusively, they may be reviewed.*" (Italics mine.)

Except that the particular executive officers were different from those involved in the case at bar, it is submitted that this case is exactly in point and

that, instead of constituting an authority for the refusal of the writs, is a direct authority for the granting of the same. This case was strenuously pressed upon the attention of the Court of Appeals at the hearing and was quoted with approval by Mr. Justice Barnard in rendering his decision in the Supreme Court of the District. In this connection Justice Barnard said in discussing the case of *Hull* v. *Commissioner of Patents,* 2 McArthur 90, page 24, Transcript of Record, as follows:

> "I have great respect for the judgment of the men composing this court at that time, all of whom were personally well known to me, but I think the logic of the dissenting opinion is more in harmony with the proper construction of the statute, and with the later decisions than the majority opinion, and I do not feel that this court should now be bound thereby.
>
> Perhaps the leading case on this subject, since that decision, is that of *U. S. ex rel. Hoe* v. *Butterworth,* 112 U. S. 50."

Then follows a discussion of the decision in *Butterworth* v. *Hoe,* quoting with approval part of the language quoted above.

These are all of the cases cited by the Court of Appeals as authority for their ruling in the case at bar, but, it is thought that it has been made clear that any of them which are in point are directly to the contrary. In addition the Court of Appeals entirely ignored other decisions by this court which were also strenuously pressed upon their attention and which it is thought are directly in point and control. In this connection see *U. S. ex rel. Miller* v. *Raum,* 135 U. S. 200, in which it was held as follows:

> "When a subordinate officer is overruled by his superior officer having appellate jurisdiction over him, his duty to obey the decision of such superior is a ministerial duty which he can be compelled by mandamus to perform."

See also, *U. S. ex rel. Dunlap* v. *Black*, 128 U. S. 40, in which it was held as follows:

> "If the Commissioner of Pensions refuses to carry out the decision of the Secretary of the Interior * * * his superior officer * * * he may be required to show cause why mandamus should not issue for the reason that so far as respects the matter decided, there is no discretion or exercise of judgment left."

Adopting the theory that the Commissioner of Patents had authority to interfere, as he did in the present case, and render a ruling therein, in effect reversing the Examiners-in-Chief, the Court of Appeals then proceeded to hold that plaintiff in error had a right of appeal to that court and that, therefore, mandamus was not the proper remedy. However, as pointed out above in a separate chapter devoted entirely to the discussion of the question as to whether or not plaintiff in error had a right of appeal, it is thought that it has been made clear that plaintiff had no such right of appeal.

In this connection see the following decisions, which are cited and fully discussed under the above heading:

In re Mattullath, 38 App. D. C. 497.
Re Selden, 36 App. D. C. 428.
In re Mygatt, 26 App. D. C. 366.
Cosper v. *Gold*, 36 App. D. C. 302.
General Railway Signal Co. v. *Thullen*, 32 App. D. C. 575.

New Departure Mfg. Co. v. *Robinson* (present term), 39 App. D. C. 504.

Westinghouse v. *Duncan*, 2 App. D. C. 131.

Ex parte Frasch, 192 U. S. 566.

U. S. ex rel. Dunlap v. *Black*, 128 U. S. 40.

Butterworth v. *Hoe*, 112 U. S, 50.

Steinmetz v. *Allen*, 192 U. S. 543.

Gaines v. *Rugg*, 148 U. S. 228.

Lim Jew v. *United States*, 196 Fed. Rep. 736.

In re Locke, 17 App. D. C. 314.

Universal Motor Truck Co. v. *Universal Motor Co.*, 197 O. G. 533.

Universal Motor Truck Co. v. *Universal Motor Co.*, 197 O. G. 535.

In re Fullagar, 32 App. D. C. 222.

In re Mygatt, 40 App. D. C. 32.

And

In re Frasch, 20 App. D. C. 298.

In discussing this subject, supra, it is thought that it was made clear that the Court of Appeals had never actually entertained an appeal from a ruling made by the Commissioner of Patents while acting in his supervisory capacity, and that even shortly after they rendered the decision in the case at bar they specifically refused to entertain such an appeal.

It thus appears clear that the Court of Appeals in the case at bar, while ignoring numerous decisions rendered by this court very much in point, based their decision on prior decisions of their own, not in point, and, it is respectfully submitted that plaintiff in error has just cause for feeling aggrieved thereby.

Conclusion.

In conclusion it is respectfully submitted:

First. That this court has jurisdiction.

Second. That the action of the Primary Examiner reopening the application; citing new references; and neglecting and refusing to pass the application to issue after he had been reversed by the Examiner-in-Chief was beyond the scope of his power or duty and therefore illegal.

Third. That the action of the Commissioner of Patents in taking up the consideration of the application on its merits, after the Primary Examiner had been reversed by the Examiners-in-Chief, was beyond the scope of his power or duty and therefore illegal.

Fourth. That mandamus was the proper remedy.

Fifth. That plaintiff in error had no right of appeal.

Sixth. That plaintiff in error had no right to relief by a bill in equity under Sec. 4915 Rev. Stat.

Seventh. That the relief afforded by an appeal or otherwise must be adequate to bar relief by mandamus, and that under the circumstances in the case at bar a second appeal or a bill in equity would have been wholly inadequate. And,

Eighth. That the decision of the Court of Appeals of the District of Columbia is clearly erroneous and should be reversed with other proper relief.

Respectfully submitted,

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In the Supreme Court of the United States.

OCTOBER TERM, 1914.

THE UNITED STATES EX REL. EDWARD L. Chott, plaintiff in error,
v.
THOMAS EWING, COMMISSIONER OF PATENTS, and Herbert Wright, primary examiner, United States Patent Office.
No. 194.

IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

BRIEF FOR DEFENDANTS IN ERROR.

This is a writ of error to the Court of Appeals of the District of Columbia to review a judgment denying the prayer contained in the petition of the plaintiff in error and refusing a writ of mandamus.

The prayer of the petition is in substance that a writ of mandamus may issue directing defendants in error, who are the Commissioner of Patents and a primary examiner in his office, to cause a patent to be issued on the application of Chott. (Record, p. 4.)

SUMMARY STATEMENT OF FACTS.

Chott applied for a patent. His claim was rejected by the primary examiner, but on appeal was allowed by the examiners in chief. The primary examiner then adduced additional reasons for objection which the Commissioner of Patents took under his personal consideration. Chott petitioned the Commissioner to direct the primary examiner to pass the patent to issue. This petition the Commissioner denied, on the ground that it was well settled that the Commissioner had authority to review a case personally and withhold a patent even after it had been favorably passed by examiners in chief. The Commissioner, however, offered Chott opportunity for a hearing on the question of patentability (Record, pp. 12, 13), which hearing was waived by Chott. The Commissioner then personally reviewed the claims with careful thoroughness and decided that they were not patentable, and refused to issue patent, pointing out to Chott that the latter had a right to appeal from his decision to the District Court of Appeals under the statute. (Record, pp. 14–16.) Chott declined so to appeal, and filed a petition for mandamus in the District Supreme Court, alleging that he had no right of appeal or other redress. The District Supreme Court in its opinion held that (Record p. 20):

> It seems that the first question which it is necessary for the court to determine is, Has the relator the right to appeal to the Court of

Appeals, from the decision of the Commissioner, finally rejecting his application? If there is no question about his right to such an appeal, that would be his remedy, and not by way of application for a writ of mandamus.

The court held there was no appeal, and therefore went on to consider the second question, whether the Commissioner had the power to refuse to issue the patent. It held he had not the power, and hence ordered mandamus. The Court of Appeals of the District of Columbia, on appeal from the District Supreme Court, reversed the decision; and held not only that the Commissioner had the power to refuse the patent, but also that an appeal lay for Chott directly from the Commissioner's decision to the District Court of Appeals itself; and that hence no writ of mandamus could issue. Chott now brings his case here on writ of error to the District Court of Appeals.

I.

ARGUMENT.

SUMMARY OF THE CONTENTIONS OF THE GOVERNMENT.

(1) The plaintiff in error, in order to maintain his contention that he is entitled to the issue of a writ of mandamus, must establish:

First. That this court has jurisdiction.

Second. That he did not have a right to appeal from the decision of the Commissioner of Patents finally rejecting his claim for a patent, under the provisions of Rev. Stat., sec. 4911, as amended, which

provides that every applicant for a patent, except a party to an interference, who "is dissatisfied with the decision of the commissioner," may appeal to the Court of Appeals of the District of Columbia.

Third. That he did not have a right to bring a bill in equity to establish his patent in case of a refusal by the Commissioner of Patents under the provisions of Rev. Stat., sec. 4915, as amended, which provides that "*Whenever a patent on application is refused, either by the Commissioner of Patents*" or by the Court of Appeals of the District of Columbia upon appeal from the Commissioner, * * * "may have remedy by bill in equity."

Fourth. That the Commissioner of Patents did not have discretionary power to refuse to issue the patent.

(2) The Government maintains:

(*a*) That this Court has no jurisdiction.

(*b*) That the Commissioner of Patents has by statute the authority and the duty to issue or to refuse to issue patents; that the statute providing for examiners in chief did not take away from him this power, but that the purpose of that statute was simply to provide additional machinery for examination and to make it more difficult to bring cases before the Commissioner, thus relieving him of the bulk of appeals; that a long line of authorities both in the Patent Office and in the courts establishes the power of the Commissioner after a favorable decision of a primary examiner or of the examiners in chief

to refuse to issue a patent if in his opinion it can not lawfully be issued.

(*c*) That, whether or not the Commissioner has power in any particular case to refuse a patent, a statutory appeal lies to the Court of Appeals from his final decision refusing a patent.

(*d*) That, even if an appeal does not lie, a rejected applicant has a statutory remedy by bill in equity.

(*e*) That a writ of mandamus should not issue under the circumstances of this case.

II.

THE JURISDICTION OF THIS COURT.

(1) The Government contends that this court has no jurisdiction on writ of error to the Court of Appeals of the District of Columbia over the question presented to that court, inasmuch as the case arose under the patent laws and no authority or power of an officer of the United States was drawn in question in such manner as to require determination thereof in order to dispose of the right asserted by the plaintiff in error.

This case is one arising under the patent laws; for the plaintiff in error asserts a right to obtain a patent, and bases his claim upon a construction of the patent laws.

In *United States* v. *American Bell Telephone Co.* (1895), 159 U. S., 548, this Court said (p. 553).

> Now, actions at law for infringement, and suits in equity for infringement, for interference *and to obtain patents*, are suits which

> clearly arise under the patent laws, *being brought for the purpose of vindicating rights created by those laws*, and coming strictly within the avowed purpose of the act, to relieve this court of that burden of litigation which operated to impede the disposition of cases of peculiar gravity and general importance.

And in *Pratt* v. *The Paris Gas, Light and Coke Co.* (1897), 168 U. S., 255, 259:

> The plaintiff must set up some right, title or interest under the patent laws, or at least make it appear that some right or privilege will be defeated by *one construction* or sustained by the *opposite construction* of these laws.
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> * * * * *
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> There is a clear distinction between a case and a question arising under the patent laws. The former arises when the plaintiff in his opening pleading—be it a bill, complaint or declaration—sets up a right under the patent laws as ground for a recovery.

See also *Anglo-Californian Bank* v. *United States* (1899), 175 U. S., 37, 39; *Henry* v. *Dick Co.* (1912), 224 U. S., 1, 16.

Cases like *Albright* v. *Teas* (1882), 106 U. S., 613, cited by plaintiff in error (Brief, p. 30), and like *Durham* v. *Seymour* (1896), 161 U. S., 235, were decided under prior statutes as to jurisdiction differently worded and are not in point.

Plaintiff in error argues (Brief, pp. 30–32) that this case—

> is not a case arising under the patent laws; but, on the contrary a case arising under the

general law which gives a resident of the United States a right to have rights and interests, finally adjudicated, enforced by mandamus.

The Supreme Court of the District of Columbia, by reason of its power to issue writs of mandamus, may have had jurisdiction of this case; but it is none the less true that the case arises under the patent laws as well. If the case be one "arising under the patent laws" then the decision of the District Court of Appeals is final and no writ of error lies to this Court under the last paragraph of section 250 of the Judicial Code, unless (assuming in behalf of the plaintiff in error the most favorable construction of the phraseology of that section) *at least* there is also "drawn in question," some one of propositions set forth in the first six subdivisions of said section 250.

The plaintiff in error is, therefore, forced to base jurisdiction in this Court upon the contention under the fifth subdivision that the "existence or scope of any power or duty of an officer of the United States" was actually "drawn in question" in the District Court of Appeals. He could not base jurisdiction on the sixth subdivision of section 250 for this was not a case where "the construction of any law of the United States was drawn in question *by the defendant*," since it was the plaintiff petitioner who drew the statute into question.

But a point is not "involved" or "drawn in question," in a case in the lower court, unless the court was required to pass upon it in disposing of the right

asserted. This has been held in numerous cases construing sections 24 and 128 of the Judicial Code (and their predecessors).

New Orleans v. *Benjamin* (1894) 153 U. S., 411, 431:

> We are of opinion that the case made upon bill and answer did not really and substantially involve a dispute or controversy as to the effect or construction of the Constitution, *upon the determination of which the result of the suit depended.*

Muse v. *Arlington Hotel Company* (1897), 168 U. S., 430, 435:

> Some right, title, privilege or immunity dependent on the treaty must be so set up or claimed *as to require* the Circuit Court to pass on the question of validity or construction *in disposing of the right asserted.*

Spencer v. *Duplan Silk Co.* (1903), 191 U. S., 526, 530:

> But a suit does not so arise unless it really and substantially involves a dispute or controversy as to the effect or construction of the Constitution, or validity or construction of the laws or treaties of the United States, *upon the determination of which the result depends, and which appears in the record by plaintiff's pleading.*

Shulthis v. *McDougal* (1912), 225 U. S., 561, 569:

Where a dispute arose as to the finality of a judgment of the Circuit Court of Appeals, the question being whether the original jurisdiction of the Circuit Court depended solely on diversity of citizenship or

whether the suit arose under a law of the United States, the Court said:

> A suit to enforce a right which takes its origin in the laws of the United States is not necessarily, or for that reason alone, one arising under those laws, for a suit does not so arise unless it really and substantially involves a dispute or controversy respecting the validity, construction or effect of such a law, *upon the determination of which the result depends.*

Hull v. *Burr* (1914), 234 U. S., 712, 720.

What, then, was the point necessarily determinative of this case in the courts below?

The Government contends that the pivotal question involved in the case presented to the Supreme Court of the District of Columbia and to the Court of Appeals was whether the plaintiff in error was without any other remedy or right of redress so as to warrant the court in issuing a mandamus.

The plaintiff in error based his original petition for writ of mandamus in the Supreme Court of the District of Columbia on two grounds: (1) that he was "deprived of a legal right vested in him by the laws of the United States" because of the refusal of the Commissioner of Patents to issue a patent to him; (2) that he was "entirely without redress or remedy in the premises unless mandamus should issue."

The District Supreme Court held:

> *It seems that the first question which it is necessary for the court to determine is, has the*

relator the right to appeal to the Court of Appeals, from the decision of the Commissioner, finally rejecting his application?

If there is no question about his right to such an appeal, that would be his remedy, and not by way of application for a writ of mandamus; but if no such right of appeal is given by the law, then the court must consider whether or not the writ of mandamus can issue or secure the applicant in his alleged right to receive a patent.

The court thus clearly showed at the outset of this case what it considered as determinative of the plaintiff's "right asserted"—namely, whether the statutes gave to him any other remedy; for even if the court had held that the Commissioner had no power to refuse to issue the patent, such decision would not have determined the plaintiff's right to mandamus unless the court had also held that he had no other adequate remedy.

Having decided, however, that the petitioner was without other remedy, the court then considered the question whether he had a right which should be redressed by the issue of mandamus.

The Court of Appeals reversed the Supreme Court and held that the petitioner had an adequate remedy, namely, a right of appeal directly from the decision of the Commissioner to the Court of Appeals. Right of appeal being once held to exist, mandamus could not issue (and so it was admitted on all sides), even if the court should ultimately find that the Commissioner acted either erroneously or without power

or in excess of his power. Hence it was unnecessary for the Court of Appeals to proceed to consider these further questions until the appeal should actually be taken. The court did, however, proceed to consider these latter questions on the merits, and reversed the finding of the District Supreme Court, and held that the Commissioner had ample authority to refuse to issue the patent.

The plaintiff in error, still contending that he had no right to an appeal or other remedy, comes to this Court asking a review upon writ of error under the fifth paragraph of sec. 250 of the Judicial Code.

He bases his right to this review, however, squarely upon the ground that he was not entitled to the special statutory appeal to the Court of Appeals, (Brief, pp. 63, 64).

The Government contends that, the Court of Appeals, having decided that the special statutory appeal lay to it, the plaintiff in error was remitted to that remedy; and the mandamus proceeding was at an end; that so far as that proceeding was concerned there was no necessity for the Court of Appeals to pass upon the question of the existence or scope of the power of the Commissioner of Patents in the premises, and hence that that matter is not really "drawn in question" here, in the sense in which that term is used in the fifth paragraph of sec. 250 of the Judicial Code.

The only matter which was strictly before the Court of Appeals was as follows: On the pleadings before the court, the Commissioner of Patents had

rendered a decision refusing to issue a patent after the examiners in chief had reported favorably; there were two statutes which gave remedies to an applicant whose claim for patent had been rejected by the Commissioner of Patents, viz, Rev. Stat., sec. 4911 (as modified by the Act of 1893), giving an appeal to the District Court of Appeals, and sec. 4915, giving a remedy by bill in equity; the court was simply called upon to decide whether these statutes were applicable to the case before it. When the Court of Appeals, therefore, so construed these statutes as granting to the plaintiff in error ample rights of appeal, all questions as to the rights of the applicant to a patent, and the rights of the Commissioner to refuse a patent, were matters which the Court of Appeals would have properly considered and adjudicated when the direct appeal should be taken to it from the Commissioner. The language of Judge Humphries in *Hull* v. *Commissioner of Patents* (2 MacArthur's D. C., pp. 138, 139), in the Supreme Court of the District, in 1875, rendered on the second decision of that case reaffirming the court's prior decision is extremely applicable:

> The relator asks this court to order the Commissioner to issue a patent before placing before us in a regular, judicial mode the evidence that one ought to issue. He contends that because the chief examiners have determined that a patent ought to issue, therefore the Commissioner must perform the clerical, ministerial act of doing so.
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> * * * * *

> If the whole case was before us, we might find that the primary examiner and the Commissioner were right and the board wrong, or *vice versa*. The final judgment is the action of the Commissioner. That is not appealed from, nor are its merits presented to us. We are asked to decide that he is not entitled to any judgment, but that his duties are merely clerical and ministerial. This would be an unfair interpretation of the powers, attitude, and design of a very important officer of a highly important office of a prominent Department for the orderly regulation of the interests of the country. As an appellate tribunal, we certainly have jurisdiction over the judgments of the Commissioner, but we must have his judgments before us, and the party seeking to reverse must appeal to us in the proper manner.

A decision to be appealable need not be either correct or authorized. If the statutes provide for an appeal from a tribunal, the question whether a decision of the tribunal was within its power is to be decided on the appeal and not on motion to dismiss the appeal.

The decision of the Commissioner of Patents, acting in his *quasi* judicial capacity, on the merits of an application, to be appealable, need not be necessarily such a decision as he is authorized to make. If it plainly appear, as it does in this case, that his decision was a decision in fact, was not interlocutory and was on the merits, the question whether he exceeded his power in rendering it at all may be tested only upon the special appeal prescribed.

See *Alexander* v. *Crollott* (1905), 199 U. S., 580, 581:

> The fact that the judgment may have been void will not prevent its reversal upon appeal.

See also *Baker* v. *Power* (1888), 124 U. S., 167, where upon a motion to dismiss an appeal from a judgment rendered by a district judge sitting on circuit in a case carried to a Circuit Court from his own decision, and hence where it was contended that the judge having no power the decree was utterly void, this Court said (p. 169):

> This motion is denied. If it be true, as is alleged, but which is by no means clear, that the decree appealed from was rendered by the district judge when he had no vote in the cause, we still have jurisdiction of the appeal. Although the district judge may have had no right to a vote, he was rightfully a member of the Circuit Court, *Rodd* v. *Heartt*, 17 Wall., 354, 357, and a decree of that court entered under his supervision and by his direction would be a decree of the court, good until reversed or otherwise vacated. From such a decree an appeal can be taken.

In *United States* v. *Duell* (1899), 172 U. S., 576, the Court of Appeals of the District, on the appeal provided by statute in such cases, reversed the decision of the Commissioner of Patents in an interference proceeding. The party cast on the appeal filed a petition in the District Supreme Court for mandamus to compel the Commissioner to issue him a patent, on the ground that the statute providing for appeal to the Court of Appeals was unconstitutional

and that the judgment of that court was accordingly void. Mr. Chief Justice Fuller for this Court pointed out that the applicant had his right to appeal from that judgment of the Court of Appeals.

It is respectfully submitted that the decision of the Court of Appeals of the District of Columbia that plaintiff in error had a right to appeal to it for the determination of every question involved in the rejection of his patent, was final, so far as this particular proceeding is concerned; that there is nothing left for this Court to review; and that the writ of error should be dismissed.

The fact that this Court took jurisdiction of a writ of error to the District Court of Appeals in *Steinmetz* v. *Allen* (1904), 192 U. S., 543, is not opposed to the Government's contention in the case at bar, but exactly fits in with it. Having negatived a right of appeal (instead of as in the case at bar having affirmed such a right) the Court of Appeals there, in order to dispose of and finally determine the right asserted by the plaintiff in error, had to decide the question of the authority of the Commissioner. Since the Court of Appeals sustained the Commissioner's authority and ruled against the plaintiff in error's contention, it is of course clear that the plaintiff had a right to resort to this Court for a writ of error, and hence this Court obtained jurisdiction owing to the fact that the validity of a statute of or an authority exercised under the United States was required to be determined by the lower court.

In the case at bar such are not the facts.

(2) **The Government contends further, however, that even if this Court should find that there was involved before the District Court of Appeals a question as to the existence or scope of the power or duty of an officer of the United States, no writ of error lies to this Court from decisions of the District Court of Appeals in cases arising under the patent laws, but that all such decisions are absolutely final by the express provision of section 250 of the Judicial Code.**

The Judicial Code, section 250, provides six specific cases in which writs of error lie from this court to the Court of Appeals of the District of Columbia. It then provides as follows:

> Except as provided in the next succeeding section, the judgments and decrees of said Court of Appeals shall be final in all cases arising under the patent laws, the copyright laws, the revenue laws, the criminal laws, and in admiralty cases; *and, except as provided in the next succeeding section, the judgments and decrees of said Court of Appeals shall be final in all cases not reviewable as hereinbefore provided.*

The words italicized above do not occur in the statute relating to the Circuit Courts of Appeals. (Judicial Code, Sec. 128).

It is evident that if the specific provision as to the finality of cases arising under the patent laws, etc., occurring in the first portion of this paragraph had not been made, a decision in a case arising under

the patent laws would still have been final under the provisions of the italicized portion of the paragraph, unless it was one of the cases "reviewable as hereinbefore provided" in the first six paragraphs of the section. Hence, unless this Court is to hold that the first portion of this paragraph is mere surplusage, it must hold that it is intended to have some meaning distinct from the italicized portion of the paragraph. The only meaning which can be given to it is to construe it to provide that *in every case arising under the patent laws, etc., whether the authority or existence or scope of any power or duty of an officer of the United States be involved or not,* the judgment of the District Court of Appeals is absolutely final. Such construction would leave open an appeal or writ of error to this Court only from judgments or decrees of the District Court of Appeals, *other than in patent, copyright, revenue, criminal, and admiralty cases,* provided they contained questions which were reviewable under the first six paragraphs.

Any other construction of this paragraph would seem to make the first portion thereof meaningless.

In the case of *Gompers* v. *United States* (1914), 233 U. S., 604, 606, it seems to be directly decided that a case arising under the criminal laws can not be brought to this Court by writ of error, even though it involves the "construction of a law of the United States." In that case, Gompers was prosecuted for criminal contempt, and he claimed that the prosecution was

barred by the statute of limitations, Rev. Stat., sec. 1044. Hence it was a case coming within the provisions of the sixth subdivision of section 250, "in which the construction of any law of the United States is drawn in question by the defendant."

Unless the first portion of the paragraph above cited as to the finality of decisions of the District Court of Appeals made its decision absolutely final in this criminal case, irrespective of the question whether any of the contingencies provided for in the first six subdivisions were also involved, then of course a writ of error or appeal lay to this Court. This Court, however, said "the defendants brought a writ of error and an appeal to this Court, and also petitioned for a writ of certiorari. *Of course an appeal does not lie, nor does a writ of error,* but the writ of certiorari is granted." Counsel for the Government argued that the construction of Rev. Stat. section 1044 was not involved and that the case was not a criminal one; but this Court held that the case did arise under the criminal laws, and also that section 1044 was involved. Therefore, this Court must have held that a writ of error did not lie in a case arising under the criminal laws, *even although the construction of a statute of the United States was involved* under the sixth subdivision of section 250. It can not be maintained that this Court did not regard the case as "arising under the criminal laws," for if it did not so arise, then clearly a writ of error lay (by virtue of the italicised portion of the last paragraph

of section 250), since there can be no question that the construction of a Federal statute was drawn in question by the defendant Gompers.

On analogy, this decision is equally applicable to a case arising under the patent laws, even although the existence or scope of a power or duty of an officer of the United States is involved under the fifth subdivision of section 250.

It may be thought that two cases are *apparently* opposed to the ruling in the *Gompers case: United States* v. *Duell*, (1899) 172 U. S., 576; *Steinmetz* v. *Allen*, (1904), 192 U. S., 543; in both of which apparently this Court took jurisdiction, although they were cases "arising under the patent laws," but where the validity or scope of the authority of an officer of the United States was *also* involved. These cases were decided, however, before the changes made in the District Court of Appeals statute by the Judicial Code in 1910, and arose under the wording of the prior statute, Act of Feb. 9, 1893, c. 74, sec. 8 (27 Stat., 434):

> SEC. 8. That any final judgment or decree of the said court of appeals may be reexamined and affirmed, reversed, or modified by the Supreme Court of the United States, upon writ of error or appeal, in all causes in which the matter in dispute, exclusive of costs, shall exceed the sum of five thousand dollars, in the same manner and under the same regulations as heretofore provided for in cases of writs of

> error on judgment or appeals from decrees rendered in the supreme court of the District of Columbia; and also in cases, without regard to the sum or value of the matter in dispute, wherein is involved the validity of any patent or copyright, or in which is drawn in question the validity of a treaty or statute of or an authority exercised under the United States.

It will be seen that this act of 1893, so far from making decisions in cases "arising under the patent laws" final, expressly provided for a writ of error in such cases.

This Court is inclined to construe strictly its jurisdiction under Section 250 of the Judicial Code. See *American Security & Trust Co.* v. *The District of Columbia* (1912), 224 U. S., 491.

III.

THE STATUS, POWERS, AND DUTIES OF THE COMMISSIONER OF PATENTS.

Plaintiff in error contends substantially that when once an examiner or a board of examiners in his office has rendered a favorable opinion on the claims of an applicant for a patent, the Commissioner of Patents is thereafter a mere entry clerk, a mere recording machine, with reference to that patent.

It becomes important, therefore, to picture to the Court the duties of this official whom it is thus suggested should be held to play so minor a part in his own office.

> The Commissioner of Patents is the official head and administrator of a great and impor-

> tant public office. The duties devolved upon him are both executive and judicial in their character. * * *
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> * * * As regards every application for a patent, there are two interests involved, that of the applicant and that of the public. * * * Shepard, C. J., in *Moore* v. *Heany*, (1909) 34 App. D. C., 31, 36, 37.

Sections 481 and 483 of the Revised Statutes make the Commissioner the head of the office, required to superintend or perform all duties regarding the granting and issuing of patents, with authority to establish regulations for the conduct of proceedings in the Patent Office.

In the year ending December 31, 1914, there were 70,404 applications for patents (including design patent and reissues), 10,273 applications for registration of trade-marks, labels, and prints; 41,850 patents were issued; 7,874 trade-marks, labels, and prints were registered.

The Commissioner of Patents is the administrative officer in charge of the general work of the Patent Office, and he is the supervisory officer in charge of the technical work of the examining corps. As such head, he is responsible for the work of the office and particularly to see that the work of the examining corps be made as uniform as possible.

The examining corps includes 3 examiners in chief, 1 examiner of interferences, 1 examiner of trade-marks and designs, 1 examiner in charge of the classification of patents, 7 assistant examiners of

trade-marks, 43 principal examiners, 63 first assistant examiners, 73 second assistant examiners, 88 third assistant examiners, and 110 fourth assistant examiners.

In the year 1914 there were 861 *ex parte* appeals from the primary examiner to the examiners in chief, and 145 appeals in interference cases. Appeals to the Commissioner from the examiners in chief in interference cases numbered 112 and in *ex parte* cases numbered 253. (In addition there were a large number of appeals in trade-mark cases.)

The number of petitions taken to the Commissioner during the year were 3,042, of which 2,409 were petitions to enter amendments after an application had been allowed. (See Rule 78.) These petitions almost entirely involved on the part of the Commissioner the approval of the recommendation of the primary examiner. There were also 403 petitions that application be revived under the provisions of section 4894, Revised Statutes, and 230 petitions from the actions of the primary examiners.[1]

[1] For several years the Commissioner has had one of the law examiners go over the proof of the Official Gazette each week with a view to calling to his attention any patents which, in the opinion of the law examiner, obviously should not have been granted, and in several instances the applications have been withdrawn from issue and the patent refused. notwithstanding that the examiner had passed the case to allowance and the patent been actually prepared for issue.

The statutory history of the growth of the powers and duties of the Commissioner of Patents is as follows:[1]

(1) Ever since the Act of 1836 the Commissioner of Patents has been head of the Patent Office, with power to issue patents or to reject claims for patents, having full supervisory authority over the acts of primary examiners and discretion to disallow a claim for a patent if deemed by him to be improper or unpatentable, even when determined favorably by the examiners or by the examiners in chief.

Prior to the Act of July 4, 1836, c. 357 (5 Stat., 117), no provision was made for a Commissioner of Patents, the duty of granting patents being delegated (Act of April 10, 1790, c. 7 [1 Stat., 109]), first

[1] *List of Patent Statutes.*

Act of April 10, 1790, c. 7 (1 Stat., 109).
Act of February 1, 1793, c. 11 (1 Stat., 318).
Act of July 4, 1836, c. 357 (5 Stat., 117).
Act of March 3, 1837, c. 45 (5 Stat., 191).
Act of March 3, 1839, c. 88 (5 Stat., 353).
Act of August 29, 1842, c. 263 (5 Stat., 543).
Act of May 27, 1848, c. 47 (9 Stat., 231).
Act of March 3, 1849, c. 108 (9 Stat., 395).
Act of March 3, 1851, c. 32 (9 Stat., 617).
Act of August 30, 1852, c. 107 (10 Stat., 75).
Act of March 3, 1855, c. 175 (10 Stat., 670).
Act of August 18, 1856, c. 129 (11 Stat., 91).
Act of March 2, 1861, c. 88 (12 Stat., 246).
Act of March 3, 1863, c. 102 (12 Stat., 796).
Act of March 29, 1867, c. 17 (15 Stat., 10).
Act of July 23, 1868, c. 227 (15 Stat., 168).
Act of March 3, 1869, c. 121 (15 Stat., 293).
Act of July 8, 1870, c. 230 (16 Stat., 198).
Act of February 9, 1893, c. 74 (27 Stat., 434).

jointly to the Secretary of State, the Secretary of War, and the Attorney General, and later (Act of Feb. 21, 1793, c. 11 [1 Stat., 318]) to the Secretary of State alone, upon the certificate of the Attorney General. No examination as to the novelty of the invention was made under the Act of 1793, and the number of patents issued was comparatively few, numbering 9,957 prior to July 8, 1836. By the Act of 1836 the entire patent system was reconstructed upon substantially its present basis. It created the Patent Office as a bureau of the State Department.

The discretion previously vested in the three heads of departments by the Act of 1790 was now vested in the Commissioner of Patents as the "chief officer" of the bureau. (*Butterworth* v. *Hoe*, 112 U. S., 50-64.)

> SEC. 1. * * * whose duty it shall be, under the direction of the Secretary of State, to superintend, execute, and perform, all such acts and things touching and respecting the granting and issuing of patents for new and useful discoveries, inventions, and improvements, as are herein provided for, or shall hereafter be, by law, directed to be done and performed, and shall have the charge and custody of all the books, records, papers, models, machines, and all other things belonging to said office.

Some of the "acts and things touching and respecting the granting and issuing of patents * * * herein provided for" were specified in section 7.

This section provided that when an application is filed "*the Commissioner shall make, or cause to be*

made, an examination" thereof, and if, on such examination, "it shall not *appear to the Commissioner*" that the same has been invented or discovered by another, etc., and "if the *Commissioner shall deem it to be sufficiently useful and important*, it shall be his duty to issue a patent therefor." But, "whenever on such examination, it shall appear *to the Commissioner* that the applicant was not the original and first inventor, * * * he shall notify the applicant thereof, giving him, briefly, such information and references as may be useful in judging of the propriety of renewing his application, or of altering his specification. * * * And if the specification and claim shall not have been so modified as, in the *opinion of the Commissioner*, shall entitle the applicant to a patent," the applicant may appeal, etc.

In other words, the Commissioner was the final judge throughout as to whether the patent should issue.

That under this section the Commissioner was to be satisfied of the applicant's right to a patent at the very last moment is clearly set forth in the opinion of Attorney General Reverdy Johnson, rendered December 22, 1849. 5 Op. Atty. Gen., 220–224, 225.

Upon revision of the patent laws in 1870 by the Patent Act of July 8, 1870, the authority and duties of the Commissioner remained the same as to the issue of patents as under the Act of 1836. That no change in the constitution of the Patent Office or in the duties of the Commissioner or other officials was intended is to be seen from the report of the Chairman

of the Committee. The bill (H. R. 1714) was reported to the House of Representatives from the Committee on Patents by Congressman Thomas A. Jenckes, of Rhode Island, April 7, 1870 (See Cong. Globe, 41st Cong., 2nd Sess., 1869–1870, Part 3, p. 2502), who in explaining the provisions of the bill regarding the organization of the Patent Office, said (*ibid*, pp. 2680–2681):

> The first portion of the bill, entitled "chapter first," relates to the constitution of the Patent Office. In this respect, so far as as the number of officers is concerned, their titles, their duties, no change is made. * * * * * * The only other new feature in the organization of the office is the proposed authority on the part of the Commissioner to establish rules. This authority was asked by the Commissioner and objected to by some of those who do business in the office. The committee finally agreed that authority to establish rules should be granted to the Commissioner, subject to the approval of his official chief, the Secretary of the Interior; and to this all parties have agreed. No other change is proposed in the constitution of the Patent Office. * * *

The provisions of sections 1 and 7 of the Act of 1836, relative to the duties of the Commissioner of Patents as to issue of patents, were considerably condensed, but no change or abridgment of his authority was made.

Act of 1836, section 1.

. . . whose duty it shall be, under the direction of the Secretary of State, to *superintend, execute, and perform,* all such acts and things touching and respecting the granting and issuing of patents for new and useful discoveries, inventions, and improvements, as are herein provided for, or shall hereafter be, by law, directed to be done and performed, and shall have the charge and custody of all the books, records, papers, models, machines, and all other things belonging to said office.

Act of 1870, section 7.

. . . it shall be the duty of the Commissioner, under the direction of the Secretary of the Interior, to *superintend or perform* all the duties respecting the granting and issuing of patents which herein are, or may hereafter be, by law directed to be done; and he shall have charge of all books, records, papers, models, machines, and other things belonging to said office.

Act of 1836, Section 7.

. . . on the filing of any such application, description, and specification, and the payment of the duty hereinafter provided, the Commissioner shall make or cause to be made. an examination of the alleged new invention or discovery; and if, on any such examination, it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or

Act of 1870, Section 31.

. . . on the filing of any such application and the payment of the duty required by law, the commissioner shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the commissioner shall issue a patent therefor

any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, if the Commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor.

These sections make the Commissioner the head of the Patent Office and responsible for all patents issued.

That the judgment and discretion vested in the Commissioner as to the issue of patents by the provisions of the Act of 1836, section 7 (Act of 1870, sect. 31) remained unimpaired and "is continued in him by section 4893, Revised Statutes" was expressly held by this Court in *Butterworth* v. *Hoe* (1884), 112 U. S., 50.

The Act of 1870 further emphasized the complete authority and responsibility of the Commissioner in the issue of patents in the following provisions:

> SEC. 19 (now Revised Statutes, sec. 483). That the Commissioner, subject to the approval of the Secretary of the Interior, may from time to time establish rules and regulations, not inconsistent with law, for the conduct of proceedings in the patent office.
>
> SEC. 23 (now Revised Statutes, sec. 4885). That every patent shall date as of a day not later than six months from the time at which *it was passed and allowed*, and notice thereof was sent to the applicant or his agent; and if the final fee shall not be paid within that period, the patent shall be withheld.

The above words "passed and allowed" clearly indicate that not only must the claim be "passed"—a function appropriate for an examiner on examination, but that the patent must be "allowed"—a function of supervisory power which could only be exercised by the head of the office.

> SEC. 42 (now Revised Statutes, sec. 4904). That whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. *And the Commissioner may issue a patent* to the party who shall be adjudged the prior inventor, unless the adverse party shall appeal from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe.

The above provision that the "Commissioner may issue a patent" on the determination of the primary examiner as to priority of invention clearly implies discretionary power in the Commissioner which he is not obliged to exercise and which is not controllable by writ of mandamus. It clearly indicates that Congress never contemplated that the Commissioner should be bound to follow the affirmative decision of his examiners in favor of a patent.

It may be noted that the headship of the Commissioner over the Patent Office has been further emphasized by the Act of April 11, 1902 (32 Stat., 95), which amended Section 21 of the Act of 1870 (Rev. Stat., 4883) so as to strike out the words appearing in brackets in the following:

> SEC. 21. That all patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the [Secretary of the Interior and countersigned by the] Commissioner of Patents, and they shall be recorded, together with the specifications, in the Patent Office, in books to be kept for that purpose.

The plaintiff in error's contention that the Commissioner is bound as matter of law to issue a patent in case of a favorable decision thereon by the board of examiners-in-chief, would make the Commissioner *not* the head of the office, but the tail of the office.

Such an anomalous position for the chief official of a great Government office must be far from the intent of statutes. The more accurate view is that of the Court of Appeals of the District of Columbia in the case at bar, as well as in the case of *Drawbaugh* v. *Seymour, Commissioner* (1896), 9 App. D. C., 219, in which it was held "that the one who is to be satisfied, as a result of the examination here provided for, that the claimant is entitled to a patent under the law is the Commissioner of Patents, and that if he knows of any ground why a patent should not issue it is his duty to refuse the patent, whether or not the

specific objection has been raised and acted upon by the lower tribunals of the Patent Office and irrespective of their holding."

The power of the Commissioner was accurately portrayed by this Court, in 1873, in *Mitchell* v. *Tilghman*, 19 Wall., 287, 390:

> Power to issue letters patent is conferred upon the Commissioner of Patents. * * * Application for a patent is required to be made to the Commissioner appointed under authority of law, and inasmuch as that officer is empowered to decide upon the merits of the application, his decision in granting the patent is presumed to be correct.

And as stated in the second opinion in *Hull* v. *Commissioner of Patents* (1875), 2 MacArthur's, p. 139 (supra):

> In the very inception of a matter for a patent the Commissioner controls the application by express enactment, and he is the officer to cause an examination to be made, *and could even do it himself.* (Sec. 4893.)

This statement is the short and complete answer to the plaintiff in error's contention. There is nothing in the statute to compel the Commissioner to cause any examination to be made by any examiner. If he had the time and the physical strength and were not bound by the ordinary mortal limitations of a human being, he might examine himself each of the 70,000 applications.

Plaintiff in error contends (Brief, pp. 47–48) that a distinction lies between the Commissioner's power

under the Act of 1836 and under the Revised Statutes (or Act of 1870) because the former states that he "*shall make or cause to be made* an examination of the alleged new invention or discovery," whereas Rev. Stat., sec. 4893, provides that he "*shall cause an examination to be made*," etc.

It is submitted, however, that this change in the language of the statute did not take away from the Commissioner the authority to make an examination personally, if he deemed it necessary, or deprive him of the authority to refuse to grant a patent whenever in his opinion the alleged invention was not patentable; for it was still the Commissioner who should be satisfied whether the invention was "sufficiently useful and important," and it was the Commissioner who, as the head of the office, must issue the patent (sec. 4883, R. S.), and if on examination the claim was rejected, it was the Commissioner who was required to notify the applicant of the reasons of rejection. Sec. 4903, R. S. Moreover, the plaintiff in error fails to notice that Revised Statutes, sec. 481, provides that it should be the duty of the Commissioner to "*superintend or perform*" all duties relating to granting and issuing of patents. This clearly implied an alternative of action in the Commissioner either to perform the duties himself or superintend their performance.

Plaintiff in error also refers to Rules 142 and 143 of the Rules of Practice of the United States Patent Office as showing that no action can be taken in an application which has been allowed by the examiners

in chief, except to pass that application to issue. Rule 142 refers to reopening the application for further prosecution at the instance of the applicant, as is evident from its reference to Rule 68, which provides that where a proper showing is made the case may be reopened by the primary examiner after it is in condition for appeal, but before appeal has been taken. Rule 143 provides for the usual case, but this rule in no way abridges the supervisory authority of the Commissioner over the affairs of the Patent Office, which is provided for in Rule 212, which reads as follows:

> 212. All cases not specifically defined and provided for in these rules will be decided in accordance with the merits of each case under the authority of the Commissioner, and such decision will be communicated to the interested parties in writing.

IV.

THE EFFECT OF THE ACT OF MARCH 2, 1861, PROVIDING FOR A BOARD OF EXAMINERS IN CHIEF.

(1) The provisions of the Act of March 2, 1861, establishing examiners-in-chief did not take away from the Commissioner of Patents his authority to reject an application or to refuse to issue a patent if he decided the invention to be nonpatentable or a patent otherwise unwarranted. This Act simply created additional subordinate officials and a system of departmental appeals, in order to make it more difficult to bring a case before the Commissioner, and thus to relieve him of the great bulk of appeals—a burden which between 1836 and 1861 had become

excessive, rendering efficient administration of the office impossible. The Act was passed on recommendations of successive Commissioners of Patents, was intended to legalize by statute a departmental practice already in force, and was never intended or contemplated as a reduction of the authority of the Commissioner or in derogation of his previous powers.

The Act was directed solely to one special end, viz, to provide a system of appeals in case of adverse decisions on an application. It did not purport to deal in any way with the case of a favorable decision by Patent Office officials on an application.

The plaintiff in error practically bases his whole case on the assumption that the Act of March 2, 1861 (12 Stat., 246), providing for three examiners-in-chief, whose duty it was "to revise and determine upon the validity of decisions made by examiners when adverse to the grant of letters patent," deprived the Commissioner *by implication* (for such provision is nowhere expressly made) of all power to pass finally upon the question of whether the patent should issue. Such an implication would, it is admitted, produce the extraordinary and anomalous condition of a Commissioner, on whom the responsibility for the issue was placed, having no power to review acts of his subordinate officers. Clearly a statute should contain very strong language to warrant such an implication.

If it was intended that the Commissioner should be governed absolutely by the findings of a subordinate

tribunal in the Patent Office, why was it not also specified in the law? The idea is sufficiently anomalous to require specification. Inference would seem clearly to point the other way; yet inference is the only basis for the plaintiff in error's interpretation of the law.

The section of the act in question is as follows:

> SEC. 2. * * * For the purpose of securing greater uniformity of action in the grant and refusal of letters patent, there shall be appointed, by the President, by and with the advice and consent of the Senate, three examiners in chief, at an annual salary of $3,000 each, to be *composed of* persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the applicant for that purpose being filed, to revise and determine upon the validity of decisions made by examiners when adverse to the grant of letters patent; and also to revise and determine in like manner upon the validity of the decisions of examiners in interference cases, and when required by the commissioner in applications for the extension of patents, and to perform such other duties as may be assigned to them by the commissioner; that from their decisions appeals may be taken to the Commissioner of Patents in person, upon payment of the fee hereinafter prescribed; that the said examiners in chief shall be governed in their action by the rules to be prescribed by the Commissioner of Patents.

Sections 10 and 47 of the Patent Act of 1870 (now Revised Statutes, sections 482 and 4910) specifying the duties of the examiners in chief are substantially the same as the above:

> SEC. 10. The examiners in chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for reissues of patents, and in interference cases; and when required by the commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them.
>
> SEC. 47. If such party is dissatisfied with the decision of the examiners in chief, he may, on payment of the duty required by law, appeal to the Commissioner in person.

The Act of 1861 provided a special system of appeals within the Patent Office in case of an adverse decision by the primary examiner or examiners in chief on patent applications. It did not apply to any other subject and did not repeal the existing provisions of law as to the Commissioner's power to exercise independent judgment in case of a FAVORABLE *decision on a patent application by subordinate officials in the Patent Office.*

Repeals by implication not being favored, it is incumbent on plaintiff in error to call this Court's attention to some subsequent provision of law clearly taking away this general supervisory power. Revised Statutes, section 482, evidently does not do so; nor

does the fact that the Act of 1861 (now sections 4909 and 4910, R. S.) gave a jurisdiction on appeal to the examiners in chief *in certain cases* have the effect to repeal the supervisory power of the Commissioner *in other cases*. Because an appeal is given to the examiners in chief and from them to the Commissioner in the event of an *adverse* decision on the application by the primary examiner, it does not at all follow that the Commissioner's power in the case of a *favorable* decision has been taken away.

The result of the plaintiff in error's argument is this: If the primary examiner decides in the applicant's favor, well and good; the Commissioner, like an automaton, must issue the patent. If the decision is adverse, the applicant may appeal to the examiners in chief. If their decision be favorable, again well and good; the Commissioner must respond. If their decision be adverse, the applicant may appeal to the Commissioner, on whose favorable decision, of course, the patent issues. If this decision be adverse, the applicant may appeal to the Court of Appeals of the District. The applicant thus has three appeals; but the public, which is interested in seeing that a monopoly is not improperly or inadvertently fastened upon it, has none. It is submitted that such a grotesque construction of the patent laws can not be sound.

(2) **The Act of 1861 simply embodied in statutory form a departmental practice which had grown up in the Patent Office in order to relieve the Commissioner of pressure of work.**

A detailed consideration of the conditions in the Patent Office prevailing between 1836 and 1861, and of the reports and debates in Congress setting forth the reasons for the enactment of the Act of 1861 clearly prove that the implication read into the latter Act and its legal effect as claimed by the plaintiff in error are both absolutely without warrant.

From 1836 to 1853, as the business of the Patent Office grew, various statutes were passed providing for additional examiners and assistant examiners. In 1848 there was a force of eight, the applications numbering 1,628 and the patents granted 660—the entire Patent Office then, therefore, being about the size of one of the present 43 examining divisions and the relation of the Commissioner then to his force being comparable to the present relation of a principal examiner of a division to his assistant examiners. Until about 1854 the Commissioner endeavored to exercise a personal supervision over the action of the examiners whether favorable or adverse to the grant of a patent.

The Commissioner's Annual Report for 1857 says (pp. 7, 8):

> Whatever might be the capabilities of the Commissioner for physical and mental labor, it would be impossible for him to discharge the administrative duties of his office, and hear, in person, all the appeals brought before him from the decisions of examiners. The usage has hence grown up of referring the investigation of most of these appeals to a board, constituted

> for the occasion, consisting of two or more examiners, who make their report to the Commissioner. As these boards lack permanence and from necessity, indeed, have been constantly changing without a critical examination of each report by the Commissioner—which is not practicable—uniformity in action and in the assertion of principle can not be maintained. *To prevent in future that conflict, which has been so often deplored in the past, it has been recommended that there shall be appointed a permanent board of three examiners in chief, who shall be charged with the duty of hearing and determining upon all appeals from the judgment of the primary examiners.*

See also his Report for 1860 (p. 6):

> Each board had its own principle of action, and in many instances this differed from the rules prescribed by the Commissioner. As a corrective, it was at length determined by Commissioner Holt to establish a permanent board of appeal within the office, whose members, three in number, should be taken from the examining corps, and whose duty it should be to examine all *ex parte* rejected cases, and submit their report and recommendation, as to their final disposal, to the Commissioner for his approval. *This board has now been in existence for over three years, and the wisdom of its creation is a matter placed beyond all doubt.*

Concerning the procedure in the Patent Office and the authority of the Commissioner, the opinion of Justice Morsell, of the Circuit Court of the District of

Columbia, rendered in 1857 in the case of *In re Hebbard* (MacArthur's Patent Cases 543, No. 6314 Federal Cases), contains the following extract from the statement of the Commissioner in that case:

> The language of the law in regard to the examination of applications is that "the Commissioner shall make or cause to be made an examination," etc. Every examination is in the eye of the law the act of the Commissioner, and the result is always signed by him. The matter of referring a case to an examiner, and its subsequent revision by the Commissioner himself, is only a thing of internal administration. Legally the acts are all acts of the Commissioner, and there can be no doubt of his right to review and modify in any respect at his pleasure any decision refusing a patent.

V.

LEGISLATIVE HISTORY OF THE ACT OF 1861.

A review of the debates in Congress upon the bill proposing to create this board of examiners in chief clearly develops that its chief purpose was to recognize by statute a previous departmental practice, and not to diminish the powers of the Commissioner.

The bill (S. 10), which subsequently became the Patent Act of March 2, 1861 (12 Stat., 246), was introduced in the Senate during the first session of the Thirty-sixth Congress on December 22, 1859 (Cong. Globe, v. 50, p. 214), and reported by Senator Bigler, Chairman of the Committee on Patents, January 24, 1860 (*ibid.*, v. 50, p. 560), and again with an

amendment in the nature of a substitute, March 20, 1860. (*Ibid.*, v. 51, p. 1217.) When taken up for consideration, section by section, on April 16, 1860 (*ibid.*, v. 51, p. 1731), the necessity for the passage of the second section (which provided for the appointment of a board of three examiners in chief to whom appeals could be taken from the adverse decisions of primary examiners; for appeals from that board to the Commissioner; and made the decision of the Commissioner final in all respects), was explained by Senator Bigler (*ibid.*, p. 1732):

> The second section is made necessary by the rapid increase of business in the office. It was organized, I think, in 1836. Up to 1847 the business was of a very limited amount, and I can find no record; but in 1847 the applications were over seven hundred. Since then, they have been increasing with wonderful rapidity, and for the last year exceeded five thousand, and are estimated for the present year at six thousand two hundred. In consequence of the multiplicity of business, owing to the fact that after cases are examined many appeals are taken from the primary examiners, there is a necessity for this reorganization. The Commissioner is utterly unable to hear the appeals which are carried before him under the organization as it now stands, and he has been forced to select three of the principal examiners, and detail them to hear appeals from the primary examiners—a duty which the original law imposed upon the Commissioner, and which he was able to perform so

long as the business was very limited; but now it is utterly out of the question.

As to this necessity, there is a concurrence of opinion, I think, amongst the Commissioners, or at least the four who have last filled the place. Judge Mason, Mr. Holt, and Mr. Bishop, all concur, as does the present incumbent, that it is utterly impossible for any one man to hear the appeals from the primary examination. This section constitutes a board of principal examiners, who are to hear the appeals from the primary examiners. It allows an appeal from this board to the Commissioner. * * *

In support of his statement, Senator Bigler read an extract from the report of Commissioner Holt for 1858, *ibid.*, p. 1732:

Since the month of November, 1857, a board temporarily organized, and consisting of three examiners, specially detailed for this duty, have been occupied in the examination of appeals from the decisions of the primary examiners to the Commissioner. During the past year they investigated and disposed of five hundred and thirty-five cases, in most of which they have submitted elaborately prepared reports. The results of their action have been eminently satisfactory, and have commanded, it is believed, the entire confidence of the country. The withdrawal of these officers from their respective classes has practically reduced the examining corps to nine instead of twelve, the number at which it was fixed in 1856. The applications of that

year amounted to four thousand nine hundred and sixty; those of 1858 amounted to five thousand three hundred and sixty-four; so that with a reduced force there is a heavy increase of labor to be performed. This is unfortunate and to be deplored, in reference alike to the public and the inventor. The former has a deep interest in that thorough and faithful examination of applications contemplated by the patent laws in order that rights which belong to all may not be unjustly monopolized by one; the latter has the same interest, lest a patent, hastily and incautiously granted, should prove in his hands but a lure to draw him into harassing and impoverishing litigation. The legalization of this board, and the restoration of examiners to the three classes now virtually deprived of them, would furnish at once the relief required.

Since the establishment of this temporary board of appeals, the classes from which its members were respectively withdrawn have been in charge of those who have the rank and pay of assistant examiners only. In the new position, however, assigned them, they have had imposed upon them the responsibilities of examiners in chief, and it is due to them to say that they have discharged their duties with zeal and fidelity. In my judgment, it is but just that they should be compensated according to the character of the services they have rendered.

Later on, discussing section 3, providing for appeals to the proposed board, and an objection that

the procedure was cumbersome, the chairman of the committee said:

> I placed this bill mainly on the fact that it had been year after year, for I believe six years, *presented here by the Department* and urged as a measure essential to its operations * * *. I prefer very much to rest my support of it upon the opinion of three or four Comm' sioners, * * * *all of whom concur in this bill throughout.* (*Ibid*, v. 52, p. 2364.)

In the entire discussion, there was nowhere disclosed the slightest purpose to curtail the existing power of the Commissioner to finally approve or reject applications for patent. In view of the statement by the chairman of the committee that the four Commissioners last holding the office had recommended and presented the bill, it can not reasonably be assumed that they would voluntarily seek to divest the Commissioner of the supervisory power of final decision, so far as the Patent Office was concerned, which had been lodged in him since the position had been created. Placing the final decision in the hands of the board proposed to be created would have left to the Commissioner (the directing head of the office) the mere ministerial and clerical function of signing his name and affixing the seal of the office, in certain cases. Clearly, no such idea would have been entertained by the Commissioners and just as clearly it was not entertained by the Senate.

There is not the slightest intimation in the entire debate of a purpose to vest the proposed board of examiners with any exclusive jurisdiction whatever.

VI.

THE OFFICE PRACTICE OF THE COMMISSIONER OF PATENTS SINCE 1861.

(1) The various Commissioners of Patents since 1861 have invariably ruled that they had authority to make an examination of the application themselves and to refuse a patent even though the claims may have been allowed by the primary examiner or the examiners in chief.

In re Stephen Hull, (1869) C. D., 68.

Abraham v. Fletcher, (1869) C. D., 50.

In re Morris & Watson, (1870) C. D., 71.

Disston v. *Traut*, 1 O. G., 305; (1872) C. D., 64.

In re Clymer & Riley, 6 O. G., 505; (1874) C. D., 73.

In re Smoot, 11 O. G., 1010; (1877) C. D., 51.

In re Neale, 15 O. G., 511; (1879) C. D., 11.

Smith v. *Perry*, 9 O. G., 688; (1876) C. D., 12.

In re Hunt, 15 O. G., 831; (1879) C. D., 53.

In re Strong, 57 O. G., 274; (1891) C. D., 175.

Riley v. *Barnard*, 59 O. G., 1921; (1892) C. D., 134.

Anderson & Dyer v. *Lowry*, 89 O. G., 1861; (1899) C. D., 230.

Walsh v. *Hallbauer*, 94 O. G., 223; (1901) C. D., 9.

Allfree v. *Sarver*, 122 O. G., 2391; (1906) C. D., 214.

Hess v. *Joerissen* v. *Felbel*, 131 O. G., 1419; (1907) C. D., 369.

In re Heany, 171 O. G., 983; (1911) C. D., 138.

The Hull and the Morris & Watson cases, *cited supra*, are of especial importance, in view of the fact that they were decided by Commissioner Fisher, who took a conspicuous part in framing the Revised Patent Act of 1870, and regarding whom this Court, in *Bates Refrigerator Company* v. *Sulzberger*, (1895) 157 U. S., 1–26, held that his decisions derived some importance from the fact "that they were rendered while the changes made by the Act of 1870 were fresh in the minds of those who, like himself, took special interest in legislation affecting patent rights." As Fisher's decision in the *Morris & Watson case*, after the passage of the Act of 1870, agreed precisely with that in the Hull case decided by him in 1869, it is of significance as showing that his opinion of the duty and power of the Commissioner underwent no change as the result of the passage of that Act.

In the first of these cases, Hull, (1869) C. D., 68, Commissioner Fisher said (pp. 69, 70):

> Prior to the passage of the act of 1861, a board of appeal, consisting of three principal examiners, had been appointed by the Commissioner for the purpose of relieving him from the labor of hearing appeals, whose decisions, when affirmed or reversed by the Commissioner, became the action of the office. It was to make permanent provision for this board that the act of 1861 was passed.
>
> * * * * *
>
> Except as to the manner of their appointment, that is substantially the old appeal board.
>
> * * * * *

As the head of the office, responsible for its management, and for the acts of his subordinates, charged by law with the execution of all acts and things touching the granting and issuing of letters patent, it is his right, it is his duty, when he has reason to believe that, by the action of any of his subordinates, a patent is about to issue which ought not to be granted, to arrest such issue, and to take such steps as in his judgment may be necessary to correct the error and secure the public from imposition. To say that any examiner, or board of examiners, refusing to be guided by his decisions, or to obey his rules, might issue patents broadcast to those who were not entitled to them, and that, because there is no appeal as against the lucky applicant, the Commissioner is by law made powerless to avert the evil—nay, more, must himself sign the patents which he knows ought not to issue, is to force upon this act a construction which is, in my opinion, the very reverse of that intended by the legislature.

* * * * *

In the absence of other light upon this subject than that afforded me by the statute and the practice of the office, I have no hesitation in holding that I have the power to withhold a patent at any stage of its progress, whenever facts arise which, in my judgment, constitute a bar to its issue.

This was the view of the law taken by Commissioner Foote, my immediate predecessor. In his annual report for 1868 he says: "I have

> endeavored to provide some means for reviewing briefly favorable decisions before patents were issued upon them, but found that the force in the office was inadequate to such work in addition to the performance of other indispensable duties."

In *Stone* v. *Greaves*, 17 O. G., 397; (1880) C. D., 70, it is said:

> * * * Thus, with the single exception of a particular course to be observed when an application is rejected in the first place by the primary examiner, the Commissioner has full control of an application, and as it can not be presumed, in the absence of express enactment having that effect, *that the law would impose imperative duties upon an officer and at the same time remove from him the power to perform those duties, or to superintend and control the actions of others in their performance*, it must be concluded that the Commissioner can and should stay the grant or issuance of a patent at any time before its delivery if convinced that such issuance would be contrary to any requirement of law.

In *ex parte Hunt*, 13 O. G., 771, a petition was made to the Secretary of the Interior for an order directing the Commissioner to deliver a patent which he had withheld after it had been signed, but had not received the seal. The decision of Secretary Schurz states:

> *Where, as in this case, it appears that the patent, erroneously allowed by one of your subordinates, contains claims which are neither*

novel nor meritorious and are manifestly old, although no fraud has been practiced, I am of the opinion that it is your duty, although the patent may have been signed, to withhold the seal of your office.

VII.

DECISIONS OF THE COURTS AND THE TEXT-BOOKS SUSTAIN THE GOVERNMENT'S CONTENTION IN THIS CASE.

(1) The cases hold that the Commissioner has authority to make an examination of the application himself and to refuse a patent even though the claims may have been allowed by the primary examiner or the examiners in chief.

The precise question decided by the District Court of Appeals in the case at bar was involved and decided in the same way in a case which arose in the Supreme Court of the District of Columbia in 1875. Hull v. *Commissioner of Patents,* 2 MacArthur's (D. C.), 90.

In that case, as in the case at bar, a petition was filed for a writ of mandamus to compel the Commissioner to issue a patent which he withheld after a favorable decision by the examiners in chief. The court, in a long and careful opinion, decided precisely as the Court of Appeals has now decided, and held, per Wylie, J. (two judges dissenting), that a favorable decision of an examiner or of the board of examiners in chief upon an application for patent is not conclusive upon the Commissioner of Patents, but that he is bound in duty under the statute not to issue the patent, should it appear to him that the alleged invention is neither novel nor meritorious; also that it is the

duty of the Commissioner alone to say whether a patent shall issue. The case was later reargued and an elaborate additional brief filed by Hull's council, Charles Mason. The court, per Humphreys, J., reaffirmed its decision, in a new opinion, 2 MacArthur's, 137, in which it said (p. 140):

> Counsel have been heard at length a second time, after full opportunity for preparation. This case presented facts somewhat novel on the first impression for the application of well-known principles. The majority of the court is of the opinion that this is not a case proper for a mandamus to issue; and, so far as I am concerned, I am much better satisfied of the correctness of this conclusion than on former hearings.

This case settled the law for the courts of the District of Columbia, and now, 40 years later, has been reaffirmed by the District Court of Appeals.

It is submitted that this Court should not now reverse what has been the settled law and practice in the Patent Office and the courts of the District of Columbia for so long a period, except on the most compelling reasons.

It is to be noted that in the case at bar, Judge Barnard in the District Supreme Court (Record. p. 24) in his decision (reversed by the Court of Appeals) said as to the *Hull case:*

> I have great respect for the judgment of the men composing this court at that time, all of whom were personally well known to me, but I think the logic of the dissenting opinion is

> more in harmony with the proper construction of the statutes, and with the later decisions, than the majority opinion, and I do not feel that this court should be now bound thereby.

As this is an admission that Judge Barnard sought to overrule the opinion of 40 years prior, and as he does not, in his own opinion, cite any other case which he claims expressly overrules the *Hull case*, his action should be viewed with careful scrutiny. The cases which he cites as out of harmony with the *Hull case* were not cases in which the point was in any way involved or decided, and in fact are cited on the Government's brief now in support of the present decision by the Court of Appeals.

The fact that the *Hull case* is a leading authority, justifies liberal citation from the opinion. The court said (p. 105):

> But by the same section (31) it is declared that it is the Commissioner who is to cause the examination to be made. The examination, when made, with its results, is then to be reported to the Commissioner, and if, "on such examination"—that is, on the face of the examination—"it shall appear," etc., the Commissioner shall issue the patent. But suppose it should "appear" to the Commissioner on his own inspection of the report, that the alleged invention is neither novel nor meritorious, *he would be bound, in duty, under this section, not to issue the patent.* Certainly there is nothing in this section which excludes this superintending authority of the Commissioner.

> Had Congress intended that the decision of the examiners, when favorable to the applicant, should be final and conclusive, *we would suppose so great an anomaly in executive administration would have been introduced into the law by the use of terms of the clearest import.* A certified copy of the decision would have been a mandate to the Commissioner, requiring him to issue the patent by authority, it might be, of a second assistant examiner, who had been appointed at his instance, and subject to removal in the like manner. * * *

(p. 106):

> If the decisions of the examiners, when favorable to applicants, leave nothing to be done by the Commissioner but the ministerial act of writing his name at the left-hand corner of the parchments and directing the seal to be affixed, how vain are the words of the law which declare that it shall be his duty "to superintend or perform all the duties respecting the granting and issuing of patents which herein are, or hereafter may be, by law directed to be done."

After commenting on section 52 of the Act of 1870 (now Rev. St., sec. 4915), the decision of the court concludes as follows (p. 108):

> In that this section recognizes the authority of the Commissioner to withhold a patent in any case, for any reason satisfactory to himself, it shows that the decisions of the examiners are in no case obligatory as to his action. In that it supplies a remedy under which his judgment

> in withholding the patent may be revised, it is decisive against the remedy by mandamus applied for in the present instance; for this writ will not lie where the law furnishes the party with any other adequate specific remedy.

See also per Olin. J. (p. 108):

> The relator's counsel has dwelt upon the fact that the law does not expressly give the Commissioner the right of appeal from the decision of the examiners in chief, and has urged this as proof that such action is final. This does not seem to me to be the proper inference. *I think the right of appeal was omitted because it was unnecessary to confer it; for the Commissioner's supervisory power over acts of the subordinates in the office is such as to preclude any necessity of his "appealing" from the examiners in chief. He can refuse to grant the patent.*

There is even less reason why a mandamus should be granted in the case at bar than in the Hull case, for in the latter case the Commissioner, without giving any reason for his action, made the following order: "Further action in this case is suspended until the further order of the Commissioner." In the case at bar, on the contrary, the Commissioner rendered a decision (Record, pp. 14–16), setting forth in full the reasons for his refusal of a patent and placing the case in condition for appeal to the Court of Appeals.

The following cases, while not involving the precise facts of the case at bar, distinctly uphold the complete authority of the Commissioner over the issue

or refusal to issue patents, under his general supervisory power. *Commissioner of Patents* v. *Whiteley* (1866), 4 Wall., 522: In this case, this Court recognized that the Commissioner of Patents is not merely an appellate tribunal, but that he has power to himself examine an application and refuse a patent. The Commissioner having held "the applicant, not being the assignee of the whole interest in the patent, was not entitled to the reissue asked for," a writ of mandamus was granted by the Supreme Court of the District of Columbia requiring him "to send the application to an examiner to be acted upon by him as though made by the patentee." This Court reversed the decision and held that the Commissioner acted within the scope of his authority, that mandamus would not lie to control his discretion, and that the applicant's remedy was by appeal and not by mandamus.

Butterworth v. *Hoe* (1884), 112 U. S., 50, 66, 67, 68: The Supreme Court of the District of Columbia had held that the authority to grant patents was vested in the Commissioner of Patents and not in the Secretary of the Interior, and directed the Commissioner to issue a patent in accordance with his own holding, notwithstanding the adverse decision of the Secretary. On appeal to this Court, the decision was affirmed and it was held that it belongs exclusively to the Commissioner to decide for himself whether a patent ought to issue. The Court said:

> It will be observed that the *judgment and discretion* vested by the original patent law of

1790, in a majority of the three executive officers, the Secretary of State, the Secretary for the Department of War, and the Attorney General, who were authorized to cause letters patent to issue, "if they shall deem the invention or discovery sufficiently useful and important," *was transferred by the act of 1836 § 7 to the Commissioner of Patents,* it being made his duty to issue a patent for the invention, "if he shall deem it sufficiently useful and important;" *and is continued in him by Rev. Stat. § 4893,* the language being that he shall cause an examination to be made of the alleged new invention, "and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor."

* * * * *

That it was intended that the Commissioner of Patents, *in issuing or witholding* patents, in reissues, interferences and extensions, should exercise quasi-judicial functions, is apparent from the nature of the *examinations and decisions he is required to make,* and the modes provided by law, according to which, exclusively, they may be reviewed.

* * * * *

We have adjudged that it belongs exclusively to the Commissioner to decide the question for himself, whether a patent ought to issue.

Drawbaugh v. *Seymour, Commissioner of Patents* (1896), 9 App. D. C., 219: The facts in this case differ

from those in the case at bar in that the claims had been refused by both lower tribunals, but are similar in that on appeal to the Commissioner the latter cited new reasons for rejection not advanced by the lower tribunals. After quoting section 4893 and other sections of the Revised Statutes, the court said (pp. 239 and 240):

> The patent should not issue as an experiment upon the public, nor to embarrass or infringe the use of other inventions having just priority. To every application for a patent the public is a party in an important sense, more than that of mere formal grantor. It is substantially interested in preventing the people from being harassed by the claims of a monopoly when in fact, there may be no just grounds for such claims. It is the duty of the Commissioner of Patents, representing the public, and also the private rights of the inventor involved in the pending application, as well as all other inventors having the sanction of the Patent Office, to see that entire justice be done to all concerned. The law has provided certain official agencies to aid and advance the work of the Patent Office, such as the primary examiners, the examiners of interferences, and the examiners in chief; but they are all subordinate, and subject to the official direction of the Commissioner of Patents, except in the free exercise of their judgments in the matters submitted for their examination and determination. The Commissioner is the head of the bureau, and he is responsible

for the general issue of that bureau. *If, therefore, there be any substantial, reasonable ground within the knowledge or cognizance of the Commissioner why the patent should not issue, whether the specific objection be raised and acted upon by the examiners or not, it is his duty to refuse the patent; and especially is it so, when the primary examiner and the examiners in chief have found such ground for refusal to exist.*

It is argued by the plaintiff in error that the above is not applicable because in the case at bar the Commissioner had not acquired jurisdiction of the case by regular appeal from the examiners in chief. No such distinction is made by the court in the *Drawbaugh case;* and it is submitted that the Commissioner is not only an appellate tribunal before whom the party litigates his claim, but he is also the head of the Patent Office and as such has jurisdiction over all pending claims, with a duty to protect the public against the issue of a patent giving a monopoly to one not entitled to such as against the public.

Moreover, in the case at bar, even if the Commissioner has not acquired jurisdiction in the case at bar by regular appeal from the examiners in chief, he has acquired it regularly upon a petition by the applicant, asking for a definite action by the Commissioner. On such petition, on the principles of the *Drawbaugh case,* it was clearly the right and the duty of the Commissioner to refuse a patent if "there be any substantial reasonable ground within his knowledge or cognizance" against its issue.

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Sobey v. *Holsclaw* (1906), 28 D. C. App., 65: In this case the primary examiner had rendered a decision on an interference case that the issues were patentable; appeal was taken to the examiners in chief who decided that they had no jurisdiction, whereupon an appeal was taken to the Commissioner. The Court said in its opinion:

> The primary examiners, who are given statutory authority to decide questions of patentability, are under the supervision of the commissioner; and it would seem to be not only his right, but his duty, to correct any manifest error committed by any of the primary examiners relative to the patentability of a supposed invention, or of the right of an applicant to claim it, whenever such error was called to his attention (pp. 74, 75).
>
> When an interference is returned to the Patent Office after we have decided the question of priority, *it is within the power of the Commissioner of Patents to withhold a patent from the successful interferant* (p. 82).

In re Locke (1900), 17 App. D. C. 314, 316, and *Podlesak et al.* v. *McInnerney* (1906), 20 App. D. C. 399, 404 (cited in the opinion of the Court of Appeals, Record, p. 33), though interference cases, also contain expressions denoting recognition by the court of the Commissioner's supervisory power in relation to decisions of a primary examiner.

(2) **The standard text books on Patent Law sustain the authority of the Commissioner.**

Robinson on Patents, vol. 2, p. 205:

> The allowance of an application by the examiner, or by the examiners in chief upon appeal, does not oblige the Commissioner to grant the patent for which it prays. The law empowers him to withhold a patent whenever in his judgment the invention is not patentable, or the issue of the patent is forbidden by the statutes, or the patent if granted would probably be held invalid by the courts.

Walker on Patents, 4th ed., p. 114:

> And the Commissioner may, at any time before the issue of a patent, reverse his own or any other favorable Patent Office action thereon, except that of a predecessor of himself, or of a predecessor of the Assistant Commissioner, and may thereupon reject the application.

(3) **Analogous case under the immigration statutes.**

The case of *Pearson* v. *Williams* (1906), 202 U. S., 281, is particularly in point here, upon the proposition that the Commissioner of Patents, under the general power vested in him under article 4893 to issue patents when "it shall appear that the claimant is justly entitled to the patent under the law," and conversely his power to refuse a patent, has the right to make a personal examination of an application and act upon it, notwithstanding a favorable decision of the Board of Commissioners in Chief thereon.

The *Pearson case* arose in the matter of the deportation of immigrants. Section 25 of the Act of March

3, 1903, 32 Stat., 1218–1220, provided for the appointment of boards of three members, to be selected from the immigrant officials in the service, who should have authority to determine "whether an alien who has been duly heard shall be allowed to land or be deported." The section further provided "The decision of any two members of the board shall prevail and be final," subject to appeal by the alien or a dissenting member.

Section 21 of the Act provided:

> That in case the Secretary of the Treasury shall be satisfied that an alien has been found in the United States in violation of this act, he shall cause such alien, within the period of three years after landing or entry therein, to be taken into custody and returned to the country whence he came.

The case arose upon the right of the Secretary to direct a second hearing and make an order of deportation under section 21, when there had been an inquiry by the board provided for in section 25, unanimous decision in favor of the immigrants and no appeal to the Secretary.

The plaintiffs in error strenuously contended in an elaborate brief that under section 25 appeals would lie to the Secretary only upon the motion of the immigrant where there had been an adverse decision by the board, or at the instance of a dissenting member thereof; that as the decision had been favorable and was final under express terms of the statute, it could not be further reviewed upon the order of the Secre-

tary, whose power did not extend to a review of favorable and unanimous decisions of the board.

The contentions set up in that case are strikingly analogous to those in the case at bar.

This Court, after reciting that the board was made up of immigrant officials in the service, subordinate to the Commissioner of Immigration (just as the members of the Board of Examiners in the Patent Office are subordinate to the Commissioner of Patents), held that the contentions were not well founded; and that the Secretary, as the superior officer and head of the Department had full authority, under the general power conferred upon him under section 21, to order a reexamination whenever, in his opinion, the facts were sufficient to justify it.

> The board is an instrument of the executive power, not a court. * * * Decisions of a similar type long have been recognized as decisions of the executive department, and can not constitute *res judicata* in a technical sense (pp. 284–285).

VIII.

GENERAL CONSIDERATIONS.

(1) **The proceedings in the Patent Office are not in the nature of appeal from a lower to a higher judicial tribunal.**

A fundamental defect in the theory on which the plaintiff in error and the District Supreme Court based their contention lies in the assumption that the relation existing between the examiner, the

examiners in chief, and the Commissioner in the Patent Office were simply those existing between inferior and appellate courts. The analogy is true only to a very limited extent.

The Patent Office is a bureau of one of the executive departments of the Government and the Commissioner of Patents is primarily an executive officer, some of whose duties, however, are judicial in character. The subordinate officials and the system of appeals, culminating in the Commissioner as the head of the office, were provided from time to time to assist him in his work as the business of the office increased, but without taking from him any of his original power or authority over applications for patents. The answer to the inquiry as to why an appeal was provided and a fee required if the judgment of the examiners in chief may be ignored by the Commissioner is clear, namely, they were provided to assist the Commissioner and to make it more difficult for the applicant to reach him in person.

The primary examiner and the examiners in chief of the Patent Office do not occupy the relative positions of a trial court and an appellate court. The primary examiner has no authority to issue a patent. Even though the board of examiners in chief decides that the invention is patentable, the primary examiner can only indicate on the file that the application is in condition to send out a notice of allowance. This notice is, however, sent out in the name of the Commissioner and the Commissioner alone has the

authority to issue the patent. In other words, the decision of the examiners in chief is not a mandate of an appellate tribunal directing the examiner to allow a patent, but is a part of the examination which under the statute the Commissioner has caused to be made and upon which the Commissioner may issue the patent—i. e., it is part of the proceedings of an executive or administrative nature over which the Commissioner has final supervisory authority subject to appeal to the courts.

Further points of difference between the Patent Office tribunals and the courts are pointed out in *In re Drawbaugh*, 9 App. D. C., 219–257:

> * * * Their methods of procedure, and the nature of the evidence and means of reaching facts upon which they may act, are altogether different from those prevailing in the ordinary courts of the country. They are supposed to be not only learned in the law that pertains to their offices, but skilled and expert in the various branches of science and art and fully learned in the history of inventions and able always to determine, in the interest of the public as well as in that of the applicant, whether the invention is new and useful and not before known or used by others. To ascertain these facts, the officials of the Patent Office are not confined to technical evidence, such as may be required in a court of justice. They may resort and do constantly resort to official gazettes, journals of science and art, and to books and publications of all

kinds and descriptions for information that may enlighten them in their investigations, as well as to the files of the Patent Office itself. Any source that brings to them intelligence upon which they can reasonably and safely act may be consulted and made the basis of their judgment.

(2) **Proper protection to the public requires that the Commissioner of Patents shall have the final power in the administration of his office to refuse a patent in cases where in his judgment such statutory monopoly is not warranted by reason of nonpatentability of the invention or for other causes.**

The courts have repeatedly held that the Commissioner is the guardian and representative of the public, and that it is his duty to safeguard their interests. *In re Drawbaugh*, (1896) 9 App. D. C., 219; *Butterworth* v. *Hoe*, (1884) 112 U. S., 50; *United States* v. *Duell*, (1899) 172 U.S., 576. Obviously, should a lower tribunal allow an application, the application will not reach the Commissioner on appeal unless it is involved in an interference; but should the Commissioner discover a plain error on the part of the primary examiner or the examiners in chief, it is his duty to correct the same.

Again, a patent is in the nature of a contract between the inventor and the public, in which the inventor is given a monopoly of the invention for the period of 17 years in return for a complete disclosure of the same, provided the invention is novel and useful. *Robinson on Patents*, vol. 1, par. 41. The appli-

cation for the patent is made to the Commissioner, and the contract is signed and executed by him on the part of the Government. If he finds that the alleged invention is not new and useful or otherwise not patentable, as required by the statutes, it is a part of his duty to see that the public are not harassed or defrauded by the issuance of a void patent. *In re Drawbaugh*, (1896) 9 App. D. C., 219.

It is very important in the conduct of the affairs of the Patent Office that the Commissioner have this supervisory authority. In many instances, cases come before him on appeal where certain claims have been allowed by the examiner or the examiners in chief and in considering the appealed claims it is found that there is no proper patentable distinction between them and the claims which have been allowed. In such cases, the Commissioner should not be bound by the previous allowance of certain claims but should have authority to examine the whole case. Furthermore, in an interference, it not infrequently happens that the attention of the Commissioner is called to certain prior patents or to questions of public use which show that the claims which have been allowed by one of the lower tribunals and put in issue in the interference are in fact not patentable. In such cases, the Commissioner should not be bound by the prior holding of patentability, but should have general supervisory authority to review the question of the allowance of the claims in either or both of the applications.

The very fact that such a large number of applications is filed each year—about 70,000—renders it important that the Commissioner as the head of the office should have the authority to review exceptional cases which may be called to his attention, in order to unify the practice of the office as much as possible. If the Commissioner has no authority to review a favorable decision of the examiners in chief, on the same theory he would have no authority to review a favorable decision of one of the principal examiners, since the statute provides for an appeal to the examiners in chief only from their adverse decisions. At the present time, there are 43 principal examiners, and the result of such a conclusion would be the creation of 43 separate patent offices, each with authority to compel the Commissioner of Patents to issue patents regardless of his own opinion as to the applicant's right thereto. The diversity and lack of uniformity in the Patent Office which would result from such a decision by this court should in itself give the court serious cause to reflect. If such be the meaning of the law, it should at once be amended so as to provide the further step requiring each examiner to sign and be responsible for his own patents.

If the favorable decision of the primary examiner may not be disturbed, not only would the recommendations of examiners in chief be useless, but the Commissioner would be without power to correct mistakes or to reopen the case when his attention

had been called to the existence of a statutory bar, as for example, public use shown by evidence taken in an interference proceeding.

The importance and far-reaching effect of a reversal by the Court of the decision by the Court of Appeals is apparent. It would revolutionize the practice that has existed in the Patent Office from the beginning. The principle frequently stated that where a practice has existed for a long time in an executive department, it should not be disturbed by the courts, unless clearly in conflict with some statute, eminently applies to the present case. *Allen* v. *Lowry*, 26 App. D. C., 8.

Moreover, there is no instance in the reported cases where this Court has required by mandamus the Commissioner of Patents to issue a patent on a claim found by him to be unpatentable.

IX.

RIGHT OF THE PLAINTIFF IN ERROR TO APPEAL TO THE COURT OF APPEALS OR TO FILE A BILL IN EQUITY.

(1) The plaintiff in error had a right to appeal from the decision of the Commissioner to the Court of Appeals, under Revised Statutes, section 4911. This statute makes provision for an appeal from any final decision of the Commissioner rejecting an application for a patent.

The defect in the argument of the plaintiff in error lies in the assumption that the statutory right of appeal given to an applicant whose claims have been

rejected was confined merely to a decision of a Commissioner rendered by him after the intermediate appeals provided for in the Act of 1861.

The legislative history of the appeal section and the decided cases prove this assumption unfounded.

Originally, under the Act of 1836, "if the specifications and claims shall not have been so modified as, in the opinion of the Commissioner, shall entitle the applicant to a patent," the applicant might appeal from the Commissioner's decision to a "board of three disinterested persons" appointed for the purpose by the Secretary of State. By section 11 of the Act of 1839, c. 88, the appeal from the Commissioner's decision in all such cases of rejection by him lay to the Chief Justice of the Supreme Court of the District of Columbia. By the Act of 1852 appeal lay also to the associate justices of said court. Thus, from 1836 up to 1861, an appeal lay from the Commissioner's decisions to *some* appellate tribunal (board, chief justice, or justices) in every case where the Commissioner found the applicant not entitled to a patent. In 1861, the statute providing for examiners in chief was enacted. That statute, however, contained not a single provision regarding appeals from the decision of the Commissioner. Hence it did not in any way repeal the appeal provisions of the Acts of 1836, 1839, and 1852. Accordingly, from 1861 to 1870, as theretofore, appeals continued to lie in every case where the Commissioner found the applicant not entitled to a patent. Then

came the Act of 1870, revising the patent laws, Section 48 of which provided that every applicant for a patent or the reissue of a patent, except a party to an interference, who was "dissatisfied with the decision of the Commissioner" might appeal to said court sitting in banc. (See also Revised Statutes, Sec. 4911.) It is clear that this provision simply reenacted in condensed form the right of appeal which had existed from 1836 to 1870.

By the Act of February 9, 1893 (27 Stat., 434), the right of appeal was transferred from the Supreme Court of the District of Columbia to the Court of Appeals of the District, and an appeal was provided in addition for "any party aggrieved by a decision of the Commissioner of Patents in any interference case."

The plaintiff in error claims that under the Act of 1870 and the Revised Statutes, appeals were confined merely to cases where adverse decisions had been originally made by the primary examiner and later by the examiners in chief, and that no appeal lay in other cases. That this was not so under the previous Act of 1836 has been expressly held by this Court in *Commissioner of Patents* v. *Whiteley* (1866), 4 Wall., 522. In that case the Commissioner had refused a reissue of a patent on the ground that the applicant was not an assignee of the entire interest. The case had not been referred to the examiner or the examiners in chief, but the Commissioner himself had made the decision. A writ of mandamus was granted by

the Supreme Court of the District of Columbia, requiring the Commissioner "to send the application to the examiner to be acted upon as though made by the patentee." In its decision reversing the decision of the lower court, this Court said (p. 532):

> Here an assignee applied for *the reissue* of a patent. *It was clearly competent for the commissioner, and it was his duty,* to decide whether the applicant was an assignee at all, and, if so, whether he was an assignee with such an interest as entitled him to a reissue within the meaning of the statutory provision upon the subject.
>
> * * * * *

(P. 533):

> The Commissioner found the question, whether the assignee was such a one as the law entitled to a reissue, lying at the threshold of his duties. It required an answer before he could proceed further. His decision was against the appellant. His examination of the subject was thorough, and his conclusion is supported by an able and elaborate argument. It was made a part of his reply to the rule, and is found in the record.
>
> *From this decision, whether right or wrong, the relator had a right, under the statute, to appeal.*

There is no reason to believe that it was the intention of Congress when it revised the patent laws by the Act of 1870 to abrogate rights of appeal which previously existed from a decision of the Commis-

sioner adverse to issue of the patent, regardless of the manner in which the question was brought before him. No such change was mentioned in the report of the bill. Clearly, the right of appeal remained as broad as it was prior to 1870.

In accordance with this view are decisions of the Court of Appeals of the District of Columbia:

In re Mygatt, (1905) 26 App. D. C., 366, 368, 369.

Moore v. *Heany*, (1909) 34 App. D.C., 31, 39, 40.

In re Selden, (1911) 36 App. D. C., 428, 431–433.

In re Mattullath, (1912) 38 App. D. C., 497.

Cosper v. *Gold* (1911) 36 App. D. C., 302, 307.

New Departure Mfg. Co. v. *Robinson* (1913) 39 App. D. C. 504.

Plaintiff in error attempts (Brief, pp. 71–74) to distinguish these cases. It is submitted, however, that the Court of Appeals, having cited these cases in its decision in the case at bar (Record, p. 34), must be deemed to know the meaning of its own previously rendered opinions. In each of the cases cited, an appeal had been taken from some decision of the Commissioner rendered not after intermediate appeals to the examiners in chief. On the plaintiff in error's theory of the construction of Rev. St., sec. 4911, an appeal could not lie; yet the court held the contrary.

The distinction which has been made by the Court of Appeals, as is apparent from all of its decisions, is

that interlocutory decisions by the Commissioner of Patents are not appealable to that court, but that final decisions rejecting claims whether in interferences or in ex parte cases, are appealable to that court. This is the basis for the holding both in the *Selden case* and in the *Mattullath case.* And this is the actual point decided in *Westinghouse* v. *Duncan,* (1894) 2 App. D. C., 131, a case relied on by plaintiff in error in his brief (p. 63). The case came up not on an appeal as given by Revised Statutes, section 4911, but on the additional provision in the Act of February 9, 1893, which transferred such appeals from the District Supreme Court to the Court of Appeals, and which provided that in addition "any party aggrieved by a *decision* of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals."

The actual decision was as follows (p. 135):

> In our opinion, it was not the intention of Congress, in the employment of the general terms of the statute, to grant the right of appeal to this court from mere interlocutory or preliminary orders or rulings in interference proceedings. By such rulings no definite determination of the merits of the case is made. The ultimate determination in such cases by the Commissioner of Patents is of the question of priority of invention, and that is the only decision from which an appeal will lie to this court in such cases. The refusal of the motion in this case is not such a decision by the Commissioner of Patents as will justify an appeal.

The language quoted by the plaintiff in error in his brief (p. 63) does not anywhere appear in the printed opinion of the court. There is a dictum, however, in the printed decision, as follows (p. 135):

> An appealable decision of that officer can only be made after the finding of the primary examiner, and the determination of the board of examiners in chief upon appeal, and thence upon appeal, to the Commissioner of Patents.

This statement, thus broadly made, is not sustained by the court's later decisions.

The doctrine settled in the Court of Appeals is set forth in *In re Frasch* (1902), 20 App. D. C. 298, 301:

> The motion to dismiss the appeal must be granted. The right to appeal to this court from a decision of the Commissioner of Patents is limited to two classes of cases: first, where an application for patent has been finally denied; and, second, where, in an interference proceeding, there has been a final determination of the question of priority of invention between adverse claimants. R. S. secs. 4911, 4912, 4913, 4914; R. S. D. C., sec. 780; act creating Court of Appeals, D. C., approved February 9, 1893, sec. 9.

The Court held that as there had been no final denial of the application by the Commissioner, his ruling was merely an interlocutory order, and hence that no appeal lay from it to the Court of Appeals, and hence the court granted the motion of the Commissioner to dismiss the appeal.

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The case came before the United States Supreme Court on a petition for writ of mandamus to compel the District Court of Appeals to take jurisdiction of the appeal. *Ex parte Frasch* (1904), 192 U. S., 566. This Court held that mandamus should not issue *because the case was not one where appeal to the Court of Appeals was the proper remedy* for the applicant, but that his remedy was a mandamus to the Commissioner to perform the statutory duty as defined in the recent case of *Steinmetz* v. *Allen*, 192 U. S., 543. This Court did not in any way, either in the *Frasch case* or the *Steinmetz case*, modify the statement of law of appeals laid down by the District Court of Appeals. In the *Steinmetz case* it held (p. 563) that since no appeal lay from the decision of the Commissioner to the Court of Appeals, and since the denial by the primary examiner of the right to join claims in one application was in fact a rejection of the application and since the applicant was entitled as of right to appeal to the examiners in chief, that a refusal by the primary examiner of the applicant's petition praying for an appeal was a refusal of a statutory right possessed by the applicant, and hence that, when the Commissioner was petitioned by the applicant to direct the examiner to forward said appeal to the examiners in chief, the Commissioner was bound so to direct, and that mandamus could be issued against him to compel him so to do.

The grounds for redress asserted by the petitioners in the *Steinmetz case* as stated on their brief in this

Court was (p. 71) that the right of an applicant to invoke the decision of the examiners in chief "can not be throttled and taken away by any possible action of a primary examiner, of a Commissioner of Patents, or by anybody else so long as the courts of the country are open to him. * * * Any interference with a right of appeal is never tolerated and mandamus is the proper remedy to remove any obstruction to the exercise of the right." This Court agreed with that statement.

But the case at bar is essentially of a different character. So far from the right of appeal being "throttled," and so far from there being an "obstruction of the exercise of the right," the Commissioner of Patents expressly pointed out to the petitioner that he had a clear right of appeal and the Court of Appeals has expressly held that such right existed. How, therefore, can the *Steinmetz case* be adduced in any way in support of the present petitioner, when the facts in the two cases are fundamentally diverse?

Judge Barnard in the lower court in the case at bar states (Record, p. 26):

> As already indicated, there seems to be no right of appeal to the Court of Appeals from such decision of the Commissioner. (*In re Frasch*, 192 U. S., 566.)

But the *Frasch case* decided no such thing, as above pointed out. The Court of Appeals in that case held that no appeal lay to it because the Commissioner's

decision was an interlocutory and not a final decision; this Court held that no appeal lay to the Court of Appeals because the Commissioner's decision was not only interlocutory but erroneous, as depriving applicant of a statutory right, and hence being interlocutory and unappealable, the only remedy left for the applicant was a mandamus.

There is nothing in the actual decision of the case of *In re Fullagar*, (1908) 32 App. D. C., 222, cited in the plaintiff in error's brief (p. 69), which sustains his contention, although it may be admitted that certain language of the court quoted is not in accord with the other cases. Plaintiff in error states that case was an appeal from a decision of the Commissioner "rejecting certain claims, but the court held that it had no jurisdiction of the appeal because the case had not come to the Commissioner by regular course of appeals." Close examination of the case shows that this statement is incorrect. Fullagar's application for reissue and Emmet's original application were involved in interference proceedings. The Commissioner sustained a ruling of the examiners in chief dismissing Emmet's motion to dissolve on the ground that Fullagar failed to show a right to a reissue, but as he made no award of priority to Emmet, *he failed to make any final decision on the validity of the application for patent of either. Hence no appeal lay;* but as the court said (p. 229):

> If the Commissioner had decided that Fullagar was not entitled to make the claims under

> his application, and had, in consequence, awarded priority to Emmet, Fullagar would have a right to appeal, bringing Emmet up for a final adjudication of the question of priority in this court.

So, too, the actual point decided in the case of *In re Mygatt*, (1913) 40 App. D. C., 32, cited by the plaintiff in error (Brief, p. 20) does not sustain in any way his his contention. The court held, per Shepard, C. J. (p. 34):

> After citing certain rulings of the Commissioner, the petition concluded as follows: "It is therefore requested that the examiner be directed to either allow or reject the application." As the Commissioner agreed with the examiner that the amendment had been properly required, it would have expedited matters had he directed the examiner to reject the claim upon failure of amendment within a reasonable time. The Commissioner, however, denied the petition, thereby leaving the applicant to deal with the examiner. His decision was not upon the merits of the application, for they were not involved, but interlocutory merely. From it this appeal has been prosecuted. As has been repeatedly held, appeals do not lie from interlocutory orders of the Commissioner, or to regulate matters of practice.

The broad statement as to the limits of appellate jurisdiction cited by plaintiff in error (Brief, p. 20) was repeated by Judge Shepard from his dictum in the Fullagar case, but was neither necessary to the

decision nor in accord with the other cases decided by his court and cited *supra*.

The plaintiff in error cites on his Brief (p. 69), the case of *Universal Motor Truck Co.* v. *Universal Motor Co.*, (1913) 41 App. D. C., 261; and says:

> It thus appears that even after the Court of Appeals of the District of Columbia decided the case at bar, it dismissed an appeal in a similar case.

That case, however, was in no sense similar to the case at bar; the *Motor Truck case* was an appeal from "an interlocutory decision of the Commissioner" (so stated by the court), and it was held on well-settled principles of that court that only final decisions could be appealed; whereas in the case at bar, the court found this precise distinction, namely, that the decision of the Commissioner was a final decision, considering and adjudicating upon the patentability of the claims, and rejecting them and refusing to issue a patent, and hence the court took jurisdiction of the appeal from his action.

It thus appears that the decision of the Court of Appeals in the case at bar was in conformity with the doctrine followed by it for twenty years, viz, to entertain an appeal from every decision of a Commissioner where its effect was the final disallowance of the patent, regardless of the manner in which the question reached the Commissioner, whether by successive departmental appeals or by petition for redress by an applicant. Cases cited by plaintiff in error as not in accord with

the above were based entirely on the point that the Commissioner's decision involved was interlocutory.

(2) Even if it should be held that the plaintiff in error had no right of appeal under Revised Statutes, section 4911, it can not be doubted that he had a clear right to a bill in equity under Revised Statutes, section 4915, which may be maintained "whenever a patent on application is refused."

The remedy by bill in equity (Rev. St., sec. 4915) is a remedy wholly independent and distinct from the proceeding by appeal provided for an applicant for a patent.

> *Butterworth* v. *Hoe* (1884), 112 U. S., 50, 61;
> *Gandy* v. *Marble* (1887), 122 U. S., 432, 439;
> *Durham* v. *Seymour* (1896), 161 U. S., 235, 237.
> *In re Hien* (1897), 166 U. S., 432, 439.
> The one is in the exercise of original, the other of appellate jurisdiction.

The legislative history of the section in question makes it plain that the intention was to afford to the applicant a remedy in equity in every case where a patent was refused by the Commissioner.

Section 16 of the Act of 1836 (5 Stat., p. 123) provided an applicant should "have remedy by bill in equity" in two cases:

> (*a*) "Whenever there shall be two interfering patents."
> (*b*) "Whenever a patent on application shall have been refused on an adverse decision of a board of examiners on the ground that the

> patent applied for would interfere with an unexpired patent previously granted." (Note: This "board of examiners" was the board provided for in section 7, to which appeals were to be taken from decisions by the Commissioner. It should not be confused with examiners or boards of examiners appointed by or acting under the Commissioner.)

By the Act of 1839 (5 Stat., p. 354) sections 11 and 12, this special board of examiners on appeal was abolished and an appeal to the Chief Justice of the District Court of the United States for the District of Columbia was provided in its place; at the same time, it was further provided (sec. 10) that the remedy by bill in equity established in the 16th section of the Act of 1836 should extend—

> *to all cases where patents are refused for any reason whatever*, either by the Commissioner of Patents or by the Chief Justice of the District of Columbia, upon appeals from the decision of the said Commissioner, as well as where the same shall have been refused on account of, or by reason of, interference with a previously existing patent.

The result of the act was that whereas, before, a bill in equity would lie in interference cases, now it lay in "all cases where *patents are refused for any reason whatever* by the Commissioner of Patents." *United States* v. *Duell*, (1899) 172 U. S., 576, 584. Certainly, no broader language could be used to grant a right in equity to an applicant, in case he was aggrieved by a refusal by the Commissioner to grant his patent

in any case whatever, *and in addition to his right of appeal.*

That this was the actual effect of the Act of 1839 was stated by Thomas A. Jenckes in reporting the bill for revision of the patent law in 1870 (Cong. Globe, 41st Cong., 2d Sess., 1869–1870, Part III, p. 2682):

> * * * the *law had already provided a remedy in this class of cases other than this by appeal to a single judge, but which has seldom been resorted to.* That remedy is provided in the original patent law, the act of 1836, authorizing any person aggrieved where there were two interfering patents to apply to any circuit court, including the Supreme Court of the District of Columbia, for relief against the other patentees or any person claiming under them. *By the tenth section of the Act of 1839 the provision of the sixteenth section of the act of 1836 was extended to all cases where patents were refused for any cause whatever.* But in practice, appeal to a single judge has been the shorter mode, and the business being conducted by solicitors of patents, whose occupation ends with the obtaining of the patent, they have more frequently resorted to that remedy, and have been satisfied with it.

The Committee on Patents of the House of Representatives were so much impressed with the effectiveness of this remedy in equity that they proposed to strike out entirely the right of appeal. The Senate, however, retained both remedies.

The Patent Act of 1870, section 52, therefore, reproduced the Acts of 1836 and 1839, as follows:

> *That whenever a patent on application is refused, for any reason whatever,* either by the Commissioner, or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity.

In condensed form, the above section is reproduced in Revised Statutes, section 4915:

> *Whenever a patent on application is refused,* etc., etc.

As stated in the above Jenckes report, the two remedies, one by appeal, the other by bill in equity, were both open to an applicant for a patent (other than in interference cases). They were not alternative remedies, but either might be resorted to.

The appeal to the court of the District of Columbia is described in *Butterworth* v. *Hoe*, 112 U. S., 50, 60, 61, as follows:

> [It] is not the exercise of ordinary jurisdiction at law or in equity on the part of that court, but is one step in the statutory proceeding under the patent laws whereby that tribunal is interposed in aid of the Patent Office. * * *

The bill in equity is described as follows:

> As already stated, the case of interferences is expressly excepted by sec. 4911 from the appeals allowed to the Supreme Court of the District. *Further provision, covering such and*

also all other cases in which an application for a patent has been refused, either by the Commissioner of Patents or by the Supreme Court of the District, is found in Rev. Stat., section 4915. It is thereby provided that the applicant may have remedy by bill in equity. This means a proceeding in a court of the United States having original equity jurisdiction under the patent laws, according to the ordinary course of equity practice and procedure. It is not a technical appeal from the Patent Office, like that authorized in section 4911, confined to the case as made in the record of that office, but is prepared and heard upon all competent evidence adduced and upon the whole merits.

The two remedies were not coextensive. In cases brought on appeal, only the record before the Commissioner is brought before the court of the District; whereas, on the bill in equity, parties may produce additional evidence and have the entire case determined on such evidence as is produced.

The contention made by the plaintiff in error (Brief, pp. 76, 77) that an applicant for patent rejected by the Commissioner must first appeal to the Court of Appeals of the District before he can maintain a bill in equity is entirely contrary to the express provisions of the statute that such bill in equity shall be open "whenever a patent on application is refused either by the Commissioner," etc., and contrary to the express language of the Court in the *Butterworth case:* "Further provision covering such and also all other cases in which an application for a patent has

been refused either by the Commissioner * * * is found in Rev. Stat., section 4915."

In behalf of his theory, the plaintiff in error cites (Brief, p. 76) a decision of Merrick, J., in the Supreme Court of the District of Columbia in 1886 (*Kirk* v. *Commissioner of Patents*, 37 O. G., 451), holding that an applicant for patent refused by the Commissioner can not have remedy by bill in equity until he shall have first exhausted his remedy by appeal. As to this decision, it may be said, first, that the passage cited was a pure dictum, the case being decided on the point that the bill was barred by failure to file in time; second, that the doctrine attempted to be thereby set up was pure judicial legislation, for it read into the statute qualifications on the right to a bill in equity which nowhere appeared therein expressly or by any necessary or reasonable implication.

The other case cited by plaintiff in error in the Circuit court for the District of Delaware (*Smith* v. *Muller*, 75 Fed., 612) was decided by District Judge Wales in 1896 entirely on the authority of the *Kirk case, supra*, the other cases cited in the opinion not having expressly decided the question, but leaving it open.

There are two other cases (not cited by plaintiff in error) which support his contention—*McKnight* v. *Metal Volatilization Co.* (1904), 128 Fed., 51, and *Prindle* v. *Brown* (1905), 136 Fed., 616; but both of these cases are practically founded on the decision

in the *Kirk case*, and their reasoning can not be supported in view of the history and plain phraseology of the statute.

But if the plaintiff in error's contention be correct that a bill in equity can not lie until the applicant shall have exhausted any other remedy given him, then it follows conclusively that the bill in equity must lie in the case at bar; because if, as the plaintiff in error contends, he had no right of appeal to the Court of Appeals of the District, then of course he had no other remedy to exhaust, and hence had an immediate right to maintain a bill in equity. And so it is expressly decided in *Hull* v. *Commissioner of Patents* (1875), 2 McArthur (D. C.) 90, p. 107, *supra*. Moreover, prior to the act of 1893 creating the Court of Appeals of the District of Columbia, no appeal lay to that court from the decision of the Commissioner as against an applicant in an interference case; but it was uniformly held that the defeated applicant in an interference case had a right under section 4915 to bring a bill in equity to force the issue of a patent to him.

SUMMARY.

It is submitted, therefore, that either by direct appeal to the Court of Appeals of the District of Columbia or by a bill in equity under section 4915 of the Revised Statutes, plaintiff in error had a speedy and efficient remedy. That where such a remedy exists, mandamus will not lie is too well settled to require the citation of authorities.

X.

WRIT OF MANDAMUS WILL NOT LIE AGAINST THE PRIMARY EXAMINER.

It is submitted that the primary examiner was improperly made a party respondent, since he is an employee of the Patent Office and subordinate to and subject to the official control and direction of the Commissioner of Patents.

That mandamus will not lie against one of the examiners was held by Justice Cox of the Supreme Court of the District of Columbia in the case of *United States ex. rel. Hodgkins* v. *Simpson*, 82 O. G., 190.

In his decision granting the petition in the case at bar, Judge Barnard in the Supreme Court of the District of Columbia said (Record, p. 27):

> It may be that this could be fully accomplished by issuing the writ against the Commissioner alone, for as to the ministerial duty of having the patent prepared and signed, he would have control of the other subordinate officers in the Department; but the primary examiner, having been made a respondent and having answered, the court can see no objection to allowing the writ to be directed to both the respondents.

It is submitted that under the ruling of the Court of Appeals of the District of Columbia in *West* v. *Hitchcock* (1902), 19 App. D. C., 333, the primary examiner was compelled to file an answer. In that case, the court held that the return to the rule to show cause

should be an answer or a statement of facts showing the ground upon which the respondent had acted or refused to act and that a demurrer has no proper place in the proceedings prior to the coming in of the return to the rule. Therefore, it is submitted that the fact that the primary examiner answered is immaterial upon the question whether a mandamus should be issued against him.

CONCLUSION.

The decision of the Court of Appeals of the District of Columbia should be affirmed.

CHARLES WARREN,
Assistant Attorney General.

R. F. WHITEHEAD,
W. S. RUCKMAN,
Attorneys.
FEBRUARY, 1915.

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SUPREME COURT, U. S.
FILED
MAY 8 1915
JAMES D. MAHER
CLERK

No. 194

IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, A. D. 1914.

THE UNITED STATES, ex rel EDWARD L. CHOTT,
Petitioner,
vs.
THOMAS EWING, Commissioner of Patents, and HERBERT WRIGHT, Primary Examiner, United States Patent Office,
Respondents.

PETITION FOR WRIT OF CERTIORARI.

JOSHUA R. H. POTTS,
ATTORNEY FOR PETITIONER.

BARNARD & MILLER PRINT, CHICAGO.

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THOMAS EWING, Commissioner of Patents, and HERBERT WRIGHT, Primary Examiner, United States Patent Office,
Respondents.

PETITION FOR WRIT OF CERTIORARI.

To the Honorable the Supreme Court of the United States:

The petitioner, United States *ex rel.* Edward L. Chott, respectfully shows to this Honorable Court as follows:

That on or about the 24th day of February, 1911, petitioner filed in the Patent Office a proper application for Letters Patent on an improvement in Dental Broaches, paying the government fee of $15 thereon as required by the statute.

That this application was duly examined and considered by A. G. Wilkinson, then Primary Examiner in the Patent Office in charge of said application, and

was finally rejected by him on the 23d day of August, 1911.

That on or about October 9, 1911, appeal was duly and properly taken from this decision of the Primary Examiner to the Examiners-in-Chief in the Patent Office, and the fee of $10 required by the statute was paid.

As a result of this appeal the Examiners-in-Chief on January 31, 1912, rendered a decision reversing the decision of the Primary Examiner on the ground that the references cited were from a non-analagous art.

The application was then referred back to the Primary Examiner in accordance with Rules 142 and 143 of the Rules of Practice of the Patent Office for such action as would carry into effect the decision of the Examiners-in-Chief, but the Primary Examiner, instead of complying with these rules and passing the application to issue, proceeded to reopen the same, with the approval of the Commissioner of Patents, cited new references therein, inferentially rejected the same and withheld the patent from petitioner, such action being taken by the Primary Examiner on or about February 21, 1912.

Protest was made by counsel for petitioner against this course of procedure and the case was referred to the Commissioner by the Primary Examiner. The Commissioner thereupon, and without granting petitioner a hearing, took up said application for personal consideration and approved of the action of the Primary Examiner, said action of the Commissioner being taken on or about March 13, 1912.

Thereupon petitioner petitioned the Commissioner

requesting him to command the Primary Examiner to issue the patent and paid the final government fee of $20 on said application as required by the statute, said petition being taken on or about April 13, 1912.

In response to this petition and on or about April 26, 1912, the Commissioner rendered a decision denying said petition, but, in view of protest made by counsel for petitioner, but without any appeal being taken to him and without payment of the $20 required by statute for such appeal, appointed May 8, 1912, as a day for hearing petitioner on the question of its merits as to patentability.

Petitioner filed a brief protesting against the course pursued and assailing the power and jurisdiction of the Commissioner to consider the application on its merits in the absence of appeal or withold the patent under the circumstances. Notwithstanding the protest on behalf of petitioner the Commissioner, on or about July 5, 1912, rendered a decision finally rejecting said application for patent upon the showing in the references which the Primary Examiner had inserted in the record after the reversal by the Examiners-in-Chief.

On February 10, 1913, petitioner filed a petition in the Supreme Court of the District of Columbia praying that writs of mandamus be granted against the said Commissioner and Primary Examiner commanding them to issue the patent on said application. Respondents filed an answer and appeared by counsel and fully argued the motion for the issuance of the writs.

On or about March 14, 1913, the Supreme Court of

the District of Columbia, through his Honor, Mr. Justice Barnard, rendered a decision ordering the writs to issue.

Appeal was taken from this decision to the Court of Appeals of the District of Columbia by the Commissioner and the Primary Examiner, on March 25, 1913. This appeal was duly argued by counsel for all of the parties hereto and on June 2, 1913, a decision was rendered by said Court of Appeals through his Honor, Mr. Justice Van Orsdel, reversing the decision of the Supreme Court and remanding the same on the grounds that the action of the Commissioner was within his supervisory authority; that an appeal would lie from his action; and that, therefore, mandamus was not the proper remedy. A writ of error to the Court of Appeals was granted and isued by this court on or about June 11, 1913, and on April 12, 1915, this writ of error was dismissed by this court for want of jurisdiction.

That the said decision and judgment of the Court of Appeals of the District of Columbia is erroneous for the reasons set forth in the assignments of error made in support of the writ of error granted in Case No. 194 of the present calendar and should be reviewed by this court, said assignments of error appearing on pages 36, 37 and 38 of the Transcript of Record filed on the writ of error herein and are hereby made a part hereof.

That the petitioner believes the invention set forth in the said application is of great value but at this time is unable to state the full extent of its value.

That the last annual report or the Commissioner of Patents discloses that in 1903, there were approxi-

mately 50,000 applications for Letters Patent filed in the Patent Office, and that in 1913, there were approximately 70,000 such applications filed, an increase in the 10 years of approximately 40 per cent.; that said report also discloses that approximately 1,600 appeals on the merits were taken in the Patent Office during the year of 1913, and petitioner believes that this number of appeals will gradually increase as time goes on.

That the decision of the Supreme Court of the District of Columbia in *Hull* v. *Commissioner of Patents,* 2 MacArthur 90, was decided in January, 1875, approximately 40 years ago, and as far as petitioner is aware is the only case other than the present case in which this precise question has been adjudicated.

That petitioner is informed and believes that the said erroneous decision of the Court of Appeals of the District of Columbia if permitted to stand for 40 years without judicial determination as was the Hull case, *supra,* and if the same rate of increase in the number of applications filed continues, a total of other 7,000,000 applications for patents will be injuriously affected by said decision and petitioner belives that said rate of increase will continue.

That petitioner believes out of this vast number of applications for patents, many will be for inventions of great merit and vast commercial value, to such an extent that the commercial interests injuriously affected by such erroneous decision will literally total billions of dollars.

That if the said erroneous decision is permitted to stand all appeals in the Patent Office will be mere idle ceremonies and of no legal or binding effect.

That as shown by the decision of this court rendered on April 12, 1915, on the writ of error herein, there is a conflict between the statutes governing the jurisdiction of this court in a case of this kind; that the writ of error in the present case was granted on June 11, 1913, whereas the decision in *Gompers* v. *The United States,* 233 U. S. 604, upon which the decision on the writ of error in the present case was in part based, was not decided until May 11, 1914.

That the erroneous decision of the Court of Appeals of the District of Columbia in this case, should be reviewed by this court for the following reasons:

First: Because of the fact that such erroneous decision will injuriously affect the interests of millions of citizens of the United States and commercial interests totaling billions of dollars.

Second: Because the question involved in this case has never before been decided by this court.

Third: Because of the great prospective commercial value of the invention involved herein to petitioner.

Fourth: Because of the prolonged and expensive litigation which has already been conducted by petitioner to establish his rights in the matter and settle this question to the general advantage of the public.

Fifth: Because of the conflict found by this court to exist in the statutes relating to jurisdiction of this court of the writ of error sued out herein which is alleged as an excuse for the delay in presenting this writ.

Whereas in view of the premises petitioner prays that this Honorable Court will grant this writ of cer-

tiorari and direct that the copies of the record heretofore filed under the writ of error in Case No. 194 of the present calender shall be taken and deemed as a sufficient return of the certiorari, and that this Honorable Court will thereupon proceed and correct the errors complained of, reverse the said judgment of the Court of Appeals of the District of Columbia and remand the said cause, stay the mandate on the writ of error pending the disposition of this petition, and give to your petitioner such other and further relief as the nature of the case may require and to the court may seem proper in the premises.

U. S. ex rel. EDWARD L. CHOTT,

Joshua B. H. Howe
.....,
Attorney.

CERTIFICATE.

I hereby certify that I have examined the foregoing petition and that in my opinion the petition is well founded as to matters of fact, and as to matters of law, and that the case identified thereby is one, and is such, that the prayer of the petition should be granted by this Honorable Court.

Joshua B. H. Howe
.....,

BRIEF IN SUPPORT OF PETITION.

I.

ENORMOUS NUMBERS OF APPLICATIONS FOR PATENTS ARE FILED EACH YEAR AND THE NUMBER FILED IS GRADUALLY INCREASING.

Annual Report of Commissioner of Patents, 1913, pp. IV-V.

II.

LARGE NUMBERS OF APPEALS ON THE MERITS ARE TAKEN IN THE PATENT OFFICE EACH YEAR.

Annual Report of Commissioner of Patents, 1913, p. III.

III.

MANY PATENTS HAVE ENORMOUS COMMERCIAL VALUE.

United States v. *Bell Telephone Co.*, 128 U. S. 315-370.

Tilghman v. *Proctor*, 125 U. S. 136.

IV.

THE DECISION OF THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA IS OBVIOUSLY ERRONEOUS.

Ballinger v. *Frost*, 216 U. S. 240-250.

V.

A WRIT OF CERTIORARI WILL BE GRANTED IN A CASE OF SUFFICIENT PUBLIC IMPORTANCE.

Montana Mining Co. v. *St. Louis M. & M. Co.*, 204 U. S. 204.

Lou Ow Bew v. *United States*, 144 U. S. 47.

VI.

A WRIT OF CERTIORARI WILL, IN A PROPER CASE, BE GRANTED AFTER DISMISSAL OF A WRIT OF ERROR AND THE RECORD FILED UNDER THE WRIT OF ERROR WILL BE ACCEPTED AS A PROPER RETURN ON THE CERTIORARI.

Security Trust Co. v. *Dent*, 187 U. S. 237-239.

Respectfully submitted,

JOSHUA R. H. POTTS,
Attorney for Petitioner.